

# BULKY DOCUMENTS

(Exceeds 100 pages)

Proceeding/Serial No: 91161819

Filed: 11-15-05

Title: Nettel Communications Inc. / with Exhibits  
U  
CD Rom  
Motorola Inc.

Part 1 of 2



## EXHIBITS

Proceeding/Serial No: 91161817

Filed: 11-15-05

Title: Nexfel Communications, Inc.

V.

Motorola, Inc

CD Rom

TTAB

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BRINKS  
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Law Worldwide

November 11, 2005

**Box: TTAB/NO FEE**  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**Re: Opposer: Nextel Communications, Inc.**  
**Applicant: Motorola, Inc.**  
**Opposition No.: 91/161,817**  
**Mark: Sensory Mark (911 Hz tone)**  
**Our Ref.: 7717/138**

Dear Sir or Madam:

Enclosed for filing is:

1. Applicant's Motion For Summary Judgment;
2. Memorandum in Support of Applicant's Motion For Summary Judgment; and
3. Return receipt postcard.

The Commissioner is hereby authorized to charge any filing fees which may be required to Deposit Account No. 23-1925. If you have any questions regarding this matter, please contact the undersigned.

Very truly yours,



Thomas M. Williams

TMW:sh  
Enclosure



11-15-2005

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on Nov. 11, 2005

Date of Deposit

Thomas W. Han

Name of applicant, assignee or  
Registered Representative

Thomas W. Han

Signature

Nov. 11, 2005

Date of Signature

Our Case No. 7717/138

**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

NEXTEL COMMUNICATIONS, INC., )

Opposer, )

v. )

MOTOROLA, INC., )

Applicant. )

Opp. No.: 91/161,817

App. No.: 78/235,618

Mark: Sensory Mark  
(911 Hz tone)

Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-1451

**APPLICANT'S MOTION FOR SUMMARY JUDGMENT**

Applicant Motorola, Inc., by its undersigned attorneys, hereby moves the Board, pursuant to Rule 56 of the Federal Rules of Civil Procedure and Section 528 of the Trademark Trial and Appeal Board Manual of Procedure, to grant summary judgment in its favor, on the ground that there exists no genuine issue of material fact regarding the



registrability of Applicant's applied-for mark. Consequently, Applicant is entitled to judgment as a matter of law. In support of its motion, Applicant relies upon its supporting memorandum submitted herewith.

Respectfully submitted,

Dated: Nov. 11, 2005

Motorola, Inc.

By




John T. Gabrielides  
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Attorneys for Applicant

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of APPLICANT'S MOTION FOR SUMMARY JUDGMENT was served on counsel for Opposer on Nov. 10, 2005, via First Class Mail, postage prepaid:

Michael H. Jacobs  
Crowell & Moring LLP  
1001 Pennsylvania, Avenue, N.W.  
Washington D.C. 20004



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Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

on Nov. 11, 2005

Date of Deposit

Thomas Gillan

Name of applicant, assignee or  
Registered Representative

Alan Hill

Signature

Nov. 11, 2005

Date of Signature

**Our Case No. 7717/138**

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(911 Hz tone)

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**MEMORANDUM IN SUPPORT OF APPLICANT'S  
MOTION FOR SUMMARY JUDGMENT**

**I. SUMMARY**

Nextel has opposed Motorola's application to register a sound mark on the grounds that it has not been used as a mark and that it is not distinctive. However, as discussed below, discovery is closed and Nextel has failed to produce any evidence in the form of

documents, interrogatory responses, deposition testimony, or otherwise, that supports either of its opposition grounds.

Motorola can meet its summary judgment burden by pointing out that there is an absence of evidence to support Nextel's case. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986). Motorola has satisfied its summary judgment burden based on Nextel's lack of evidence and the arguments set forth below. Consequently, allowing these proceedings to move forward to trial would be a waste of time and resources.

## **II. STATEMENT OF FACTS**

### **A. Motorola's Sound Mark**

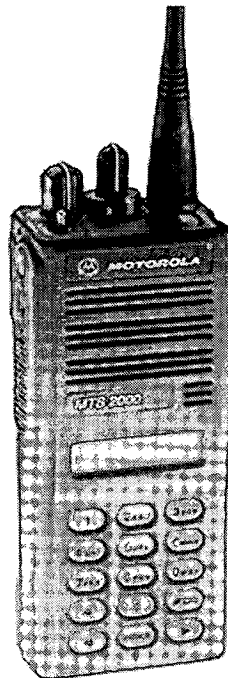
Motorola's sound mark consists of a 911 Hz tone played at a cadence of 25 milliseconds ("ms") ON, 25 ms OFF, 25 ms ON, 25 ms OFF, 50 ms ON. A recording of the sound mark can be heard from the audio CD attached at Exhibit 1.

Motorola created the sound mark in 1983-1984 and selected the mark for its aesthetic quality. (Testimony of Motorola's 30(b)(6) deposition designee, David Klein ("Klein Dep."), at pp. 51, 53, 57-60. A copy of the Klein Dep. transcript is attached at Exhibit 2) Motorola first used the sound commercially as early as May 6, 1991, when it was used in connection with Motorola's two-way radios. (Sensory Mark Application Serial No. 78/235,618.) Motorola has used the sound mark on two-way radios continuously since then. (Ex. 2, Klein Dep. at pp. 12-13, 68.)

The sound is heard when a channel is available for a two-way radio user to communicate with another two-way radio user. (Ex. 2, Klein Dep. at pp. 28, 44-45, 102-103.) Typical users of Motorola's two-way radios include personnel in public safety (e.g.,

fire, police, and emergency medical technicians), critical infrastructure sectors (*e.g.*, utility companies), and federal government groups (*e.g.*, Dept. of Defense, Dept. of Justice). (Ex. 2, Klein Dep. at pp. 89-90, 123, 129-132.)

Motorola trains end users of its radios to recognize the sound as coming from Motorola radios. For example, the sound is described in Motorola's user manuals and user guides. It is also heard through a "on-line method" that "actually plays the tone." It is also heard at trade shows where Motorola displays and promotes its two-way radios. In addition, Motorola's two-way radios that emit the sound are prominently marked with the MOTOROLA word mark and design marks. (Ex. 2, Klein Dep. at pp. 45-46, 109-110, 117-118.) A photograph of a Motorola two-radio that emits the sound mark is shown below:



Motorola ensures the consistency of its sound among its two-way radios by, for example, having requirements for the particular pitch and cadence and conducting verification testing of products. (Ex. 2, Klein Dep. at pp. 13-14, 28.)

Motorola's recent annual advertising and promotional budget for its two-way radios that emit the sound includes \$100,000 for user groups in the public safety and critical infrastructure sector; \$160,000 for materials and presentations for federal government groups; and \$600,000 for trade shows for fire and police chiefs and related public safety organizations. (Ex. 2, Klein Dep. at pp. 129-132.)

#### **B. Motorola's Trademark Application**

Motorola filed an application to register its sound for use in connection with two-way radios on April 9, 2003 (Ser. No. 78/235,618). Only one Office Action was issued. On October 17, 2003, the Examiner required a revised description of the mark and a substitute specimen, along with a declaration that the substitute specimen was in use in commerce at least as early as April 9, 2003. No other issues were raised.

Motorola addressed the informalities in a response that was received in the Trademark Office on October 20, 2003. Motorola's sound was approved for publication on February 4, 2004, and was published in the *Official Gazette* on February 24, 2004.

#### **C. Nextel's Opposition**

Nextel filed its Notice of Opposition on August 23, 2004. The Notice alleges only two grounds for opposition: non-use and lack of distinctiveness. More specifically, Nextel alleges that:

Upon information and belief, Applicant has not used the 911 Hz tone in commerce in connection with the goods listed in the 911 Hz Tone Application,

in derogation of Sections 1 and 45 of the Lanham Act (Ex. 3, Notice of Opposition at Para. 9); and

Upon information and belief, the 911 Hz tone is not inherently distinctive and has not acquired distinctiveness as to the goods listed in the 911 Hz Tone Application, in derogation of Sections 1, 2, and 45 of the Lanham Act (Ex. 3, Notice of Opposition at Para. 10).

(A copy of Nextel's Notice of Opposition is attached at Ex. 3.)

After Motorola answered the Notice, the parties began taking discovery. Motorola served interrogatories, document requests, and a notice of deposition under Rule 30(b)(6) of the Federal Rules of Civil Procedure, all directed specifically to the two grounds alleged in Nextel's Notice of Opposition.

**1. Motorola's Interrogatories**

Through interrogatories, Motorola asked Nextel to:

1. Describe in detail all facts relating to Opposer's contention that Applicant has not used Applicant's Mark in commerce in connection with two-way radios (§ 9 of Notice of Opposition), and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

After interposing a number of objections, Nextel answered that "it is unaware of any instances in which Applicant has used the 911 Hz tone as a mark in commerce in connection with two-way radios." (Nextel's Interrogatory Responses at Para. 1. A copy of Nextel's Interrogatory Responses is attached as Exhibit 4.) No other substantive answer was provided.

Motorola also requested that Nextel identify the facts that support its allegation that Motorola's sound is not distinctive. Specifically, Motorola requested that Nextel:

2. Describe in detail all facts relating to Opposer's contention that Applicant's Mark is not inherently distinctive in connection with two-way radios (§ 10 of Notice of Opposition), and identify the three individuals

employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

3. Describe in detail all facts relating to Opposer's contention that Applicant's Mark has not acquired distinctiveness in connection with two-way radios (§ 10 of Notice of Opposition), and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

Nextel provided no substantive response to Interrogatory No. 2, choosing instead only to object:

In addition to the General Objections set forth above, Opposer objects to this interrogatory as it invades the attorney client privilege and/or attorney work product doctrine. Opposer further objects to the user of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Opposer further objects that the phrase "inherently distinctive" calls for a legal conclusion. (Ex. 4, Nextel's Interrogatory Responses at Para. 2.)

In response to Interrogatory No. 3, Nextel simply repeated its response to Interrogatory No. 1; Nextel "is unaware of any instances in which Applicant has used the 911 Hz tone as a mark in commerce in connection with two-way radios." (Ex. 4, Nextel's Interrogatory Responses at Para. 3.)

## **2. Motorola's Document Requests**

Motorola issued Document Requests that track its Interrogatories. Motorola requested production of all documents that refer or relate to Motorola's alleged non-use of the sound with two-way radios. After interposing a number of objections, Nextel stated that "it will produce all non-privileged documents and things responsive to this Request." (Nextel's Document Responses at Para. 7. A copy of Nextel's Document Responses is attached at Exhibit 5.)



Motorola also requested that Nextel produce all documents relating to the alleged absence of distinctiveness in Motorola's sound. After again interposing several objections to each Request, Nextel stated that "there are no non-privileged documents responsive to this Request." (Ex. 5, Nextel's Document Responses at Paras. 8-11.)

Motorola also requested that Nextel produce all documents that Nextel identified or referred to in answering Motorola's Interrogatories. Nextel agreed to produce all non-privileged documents and things responsive to these Requests. (Ex. 5, Nextel's Document Responses at Paras. 26 and 27.)

On April 29, 2005, Nextel produced a total of 25 (twenty-five) pages of documents in response to Motorola's Document Requests. The documents, which are attached at Exhibit 6, consist solely of the file history for Motorola's trademark application. Nextel also produced a CD-ROM with a .wav file of the tone. (Exhibit 7.) Nextel has not produced any other documents or things in response to Motorola's discovery requests.

### **3. Motorola's Deposition of Nextel (Rule 30(b)(6))**

On July 26, 2005, Motorola took Nextel's deposition under Rule 30(b)(6) to discover the matters known or reasonably available to Nextel on the following topics, among others:

1. The facts on which Opposer bases its contention that Applicant has not used Applicant's Mark in commerce in connection with two-way radios (¶ 9 of Notice of Opposition).
2. The facts on which Opposer bases its contention that Applicant's Mark is not inherently distinctive in connection with two-way radios (¶ 10 of Notice of Opposition).
3. The facts on which Opposer bases its contention that Applicant's Mark has not acquired distinctiveness in connection with two-way radios (¶ 10 of Notice of Opposition).

...

17. Surveys, polls, research, or investigations made conducted by, on behalf of, or for the benefit of Opposer that refer or relate to Applicant's Mark or Applicant's two-way radios that use Applicant's Mark.

(A copy of Motorola's Notice of Rule 30(b)(6) Deposition is attached at Exhibit 8.)

Nextel identified Ms. Allison O'Reilly as its designee under Rule 30(b)(6). Ms. O'Reilly is Nextel's Director of Promotions and Retail Marketing. (Testimony of Nextel's 30(b)(6) deposition designee, Allison O'Reilly ("O'Reilly Dep."), at p 6. A copy of the O'Reilly Dep. transcript is attached at Exhibit 9.) When Ms. O'Reilly was asked about Motorola's alleged non-use of the sound, she testified that Nextel has not researched, has not done market studies or focus groups, and has not conducted customer interviews or survey work on whether Motorola has used the sound in commerce. (Ex. 9, O'Reilly Dep. at p. 32.) She also testified that Nextel does not have any documents or correspondence relating to its allegation that Motorola has not used its sound in commerce. (Ex. 9, O'Reilly Dep. at p. 33.)

With respect to Nextel's allegation that Motorola's sound mark is not distinctive, Ms. O'Reilly testified that Nextel has not researched, has not done market studies or focus groups, and has not conducted customer interviews or survey work on whether Motorola's sound is inherently distinctive or has acquired distinctiveness. (Ex. 9, O'Reilly Dep. at pp. 34-37.) She also testified that Nextel has no documents or correspondence relating to the distinctiveness of Motorola's sound. (Ex. 9, O'Reilly Dep. at p. 37.)

Ms. O'Reilly also testified that Nextel does not offer two-way radios. (Ex. 9, O'Reilly Dep. at pp. 27, 46-47.)

Finally, Ms. O'Reilly admitted that she has never heard Motorola's sound. (Ex. 9, O'Reilly Dep. at p. 28.)

Discovery in this case closed on September 13, 2005.

### III. ARGUMENT

#### A. Summary Judgment Is Required Where The Nonmovant Cannot Meet Its Burden Of Proof

Summary judgment is appropriate where there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); T.B.M.P. § 528.01; *Sweats Fashions Inc. v. Pannill Knitting Co., Inc.*, 4 U.S.P.Q.2d 1793, 1795-96 (Fed. Cir. 1987). It is against the public interest to conduct useless trials, and where the time and expense of a full trial can be avoided by summary judgment, such action is favored. *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 222 U.S.P.Q. 741, 743 (Fed. Cir. 1984).

Where the summary judgment movant does not bear the burden of proof at trial, the movant does *not* have the burden to produce evidence showing the *absence* of a genuine issue of material fact. *See Sweats Fashions Inc.*, 4 U.S.P.Q.2d 1795-96. Instead, “the burden of the moving party may be met by showing (that is, pointing out) ‘that there is an absence of evidence to support the nonmoving party’s case.’” TBMP § 528.01 (*quoting Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986)).

For example, in *Kellogg Co. v. Pack'em Enter., Inc.*, 21 U.S.P.Q.2d 1142, 1144-45 (Fed. Cir. 1991), the Federal Circuit affirmed the Board’s grant of summary judgment in applicant’s favor because opposer “did not offer any facts relating to the sole issue upon which [applicant] based its motion for summary judgment....” Thus, the Federal Circuit held that “[applicant] carried its burden as a movant under Rule 56 of the Federal Rules of Civil Procedure.” *Id.* at 1145 (citing *Celotex*, 477 U.S. at 325). *See also Hornblower & Weeks*

*Inc. v. Hornblower & Weeks Inc.*, 60 U.S.P.Q.2d 1733, 1739 (T.T.A.B. 2001) (granting summary judgment where no evidence was produced).

Mere denials or conclusory assertions by the nonmovant are insufficient to avoid summary judgment. *See* Fed. R. Civ. P. 56(e); *Sweats Fashions Inc.*, 4 U.S.P.Q.2d at 1795.

**B. Nextel Cannot Meet Its Burden Of Showing That Motorola Has Not Used Its Sound Mark In Connection With Two-Way Radios**

Nextel alleges that Motorola has not used the sound at issue in commerce in connection with two-way radios. (Ex. 3, Nextel's Notice of Opposition at Para. 9.) Nextel has the burden of proving non-use by a preponderance of the evidence. *See generally Cervceria Centroamericana S.A. v. Cervceria India Inc.*, 13 U.S.P.Q.2d 1307, 1309-10 (Fed. Cir. 1989) (holding that preponderance of the evidence is the proper standard in Board proceedings). Nextel cannot meet its burden.

Motorola served discovery requests on Nextel directed specifically to Nextel's allegation of non-use. In response to Motorola's Interrogatory No. 1, Nextel responded that "it is unaware of any instances in which Applicant has used the 911 Hz tone as a mark in commerce in connection with two-way radios." (Ex. 4, Nextel's Interrogatory Responses at Para. 1.) The issue, though, is not whether Nextel is aware of any such use but whether Nextel can show that Motorola has never commercially used the sound as a mark in connection with two-way radios. Nextel's unawareness, even if true, does not establish non-use. At most, it establishes Nextel's unawareness of Motorola's trademark use.<sup>1</sup>

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<sup>1</sup> Nextel's unawareness is explained by the fact that Nextel is not in the two-way radio market. (Ex. 9, O'Reilly Dep. at pp. 27, 46-47.)

Motorola also asked that Nextel produce all documents (including things) that refer or relate to Motorola's alleged non-use of the sound with two-way radios. Nextel has produced all non-privileged documents responsive to Motorola's request. However, the only documents that Nextel produced are copies of the documents from the file history of Motorola's application and a .wav file of the sound. (Exs. 6 and 7.) Those documents clearly do not establish non-use of the mark. In fact, they establish the opposite: Motorola's trademark application states that, "The applicant is using the mark in commerce ... on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended." (Ex. 6 at Nextel 0010019.)

Motorola also requested that Nextel provide a witness to testify on, among other things, the facts on which Nextel bases its allegation of non-use. (Ex. 8, Motorola's Notice of Rule 30(b)(6) Deposition at Para. 1.) Nextel's witness, however, was unable to provide any facts or information or to identify any documents that support or even relate to Nextel's contention. The most the witness could say was that she has never heard Motorola's sound mark. (Ex. 9, O'Reilly Dep. at p. 28.) This is insufficient to establish Motorola's alleged non-use of the sound, for the same reason as discussed above with respect to Nextel's answer to Motorola's Interrogatory No. 1: Nextel's unawareness does not establish non-use.

Discovery is closed. By its responses to Motorola's discovery requests and deposition questions directed specifically to the issue of use, Nextel had ample opportunity – indeed, it had the obligation – to fill the record with evidence supporting its allegation of non-use. But Nextel has produced no supporting evidence whatsoever. The complete absence of evidence of non-use requires entry of summary judgment against Nextel on the issue, as the burden of proof of non-use lies exclusively with Nextel. *See* T.B.M.P. § 528.01

(“The burden of the moving party may be met by showing (that is, pointing out) ‘that there is an absence of evidence to support the nonmoving party’s case.’”) (*quoting Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986)).

**C. Nextel Cannot Meet Its Burden Of Showing That Motorola’s Sound Mark Lacks Distinctiveness**

Nextel also alleges that Motorola’s sound is not distinctive; that is, that it is merely descriptive of two-way radios. (Ex. 3, Nextel’s Notice of Opposition at Para. 10.) Nextel has the burden of making a *prima facie* showing that Motorola’s sound mark is merely descriptive as applied to two-way radios. *See Omnicom Inc. v. Open Sys. Inc.*, 19 U.S.P.Q.2d 1876, 1878 (T.T.A.B. 1989). If, and only if, Nextel satisfies this burden, then Motorola must demonstrate either that its mark is not, in fact, merely descriptive or that it has acquired distinctiveness. The Board would then decide the mere descriptiveness/acquired distinctiveness issue based on the entire record presented. *Id.*

Nextel cannot meet its burden. Motorola served discovery requests on Nextel directed specifically to Nextel’s allegation of non-distinctiveness. Nextel’s only substantive response is that “it is unaware of any instances in which Applicant has used the 911 Hz tone as a mark in commerce in connection with two-way radios.” (Ex. 4, Nextel’s Interrogatory Responses at Para. 3.) But Nextel’s unawareness, even if true, does not establish that Motorola’s sound is not distinctive. That is a *non sequitur*.

Motorola also asked that Nextel produce all documents and things that refer or relate to the alleged non-distinctiveness of Motorola’s sound. Nextel responded that it has no non-privileged documents responsive to Motorola’s requests. (Ex. 5, Nextel’s Response to Document Requests at Paras. 8-11.)

Motorola also requested that Nextel provide a witness to testify on, among other things, the facts on which Nextel bases its allegation of non-distinctiveness. (Ex. 8, Motorola's Notice of Rule 30(b)(6) Deposition at Paras. 2 and 3.) Nextel's witness, however, was unable to provide any facts or information or to identify any documents that support or even relate to Nextel's contention. (Ex. 9, O'Reilly Dep. at pp. 34-37.)

By its responses to Motorola's discovery requests and deposition questions directed to the issue of distinctiveness, Nextel had ample opportunity – indeed, it had the obligation – to fill the record with evidence supporting its allegation of non-distinctiveness. But Nextel has produced no supporting evidence whatsoever. The complete absence of evidence requires entry of summary judgment against Nextel on the issue of distinctiveness, as the burden of proof of non-distinctiveness lies exclusively with Nextel. *See* T.B.M.P. § 528.01 (“The burden of the moving party may be met by showing (that is, pointing out) ‘that there is an absence of evidence to support the nonmoving party’s case.’”) (*quoting Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986)).

**D. Motorola Has Uncontradicted Evidence That Its Sound Mark Is Distinctive And In Use By Motorola**

As discussed, Nextel has failed to meet its burden of proving that Motorola's sound mark is merely descriptive of two-way radios. But even if Nextel were somehow able to meet its burden, Motorola has uncontradicted evidence establishing that its sound mark is inherently distinctive and/or has acquired secondary meaning. *See Omnicom*, 19 USPQ2d at 1878.

Simply by playing the sound from the CD attached at Ex. 1, it is clear that Motorola's sound is unique or different, and therefore inherently distinctive. *See In re General Elec.*

*Broad. Co., Inc.*, 199 USPQ 560, 563 (T.T.A.B. 1978). It is not a commonplace sound to which listeners have been exposed under different circumstances (in which case a showing of secondary meaning would be required). *Id.* It is, instead, similar to other unique or different sounds that have been registered without proof of acquired distinctiveness. For example:

“A series of five chirps similar to the chirping sound of a cricket” registered for “software for notifying consumers of live weather conditions, weather forecasts, weather alerts, and other weather related information by means of a global computer network.” Reg. No. 2,827,972. (Exhibit 10)

“The sound of a kiss made when, for example, one is ‘blowing a kiss’ to another person” for “commercial and residential building construction; building repair; installation of siding.” Reg. No. 2,524,758. (Exhibit 11)

In the alternative, even if Motorola’s sound were considered commonplace, there is uncontradicted evidence that the sound has acquired distinctiveness. Acquired distinctiveness may be shown by direct and/or circumstantial evidence such as consumer surveys, length of use, and extensive sales and advertising. *See, e.g., In re Owens-Corning Fiberglas Corp.*, 227 U.S.P.Q.2d 417, 422-24 (Fed. Cir. 1985); *In re Instant Transactions Corp. of Am.*, 201 U.S.P.Q. 957, 958 (T.T.A.B. 1979); T.M.E.P. § 1212.06(a)-(d). Motorola’s evidence establishes consumer association between the sound and a single source.

As discussed earlier, Motorola first used the sound commercially as early as May 6, 1991, when it was used on two-way radios. Motorola has used the sound on two-way radios continuously since then. (Ex. 2, Klein Dep. at 12-13, 68.) Indeed, Motorola’s trademark application states that Motorola “is using the mark in commerce ... on or in connection with the identified goods and/or services.” (Ex. 6 at Nextel 0010019.)



In addition, Motorola trains end users of its radios to recognize the sound as coming from Motorola radios. For example, the sound is described in Motorola's user manuals and user guides. It is also heard through a "on-line method" that "actually plays the tone." It is also heard at trade shows where Motorola displays and promotes its two-way radios. In addition, Motorola's two-way radios that emit the sound are prominently marked with the MOTOROLA word mark and design marks. (Ex. 2, Klein Dep. at pp. 45-46, 109-110, 117-118.)

Motorola ensures the consistency of its sound among its two-way radios by, for example, having requirements for the particular pitch and cadence and conducting verification testing of products. (Ex. 2, Klein Dep. at pp. 13-14, 28.)

Motorola's annual advertising and promotional budget for its two-way radios that emit the sound includes \$100,000 for user groups in the public safety and critical infrastructure sector; \$160,000 for materials and presentations for federal government groups; and \$600,000 for trade shows for fire and police chiefs and related public safety organizations. (Ex. 2, Klein Dep. at pp. 129-132.)

In addition, in September 2005, Motorola, through undersigned counsel, commissioned RL Associates to design and carry out a fair and unbiased test of the extent to which (if any) Motorola's sound is associated with a single source. (Expert Report of Michael Rappeport ("Rappeport Report") at MOT 004677. A copy of the Rappeport Report is attached at Exhibit 12.) In-person interviews were conducted with police officers, fire fighters, and emergency medical technicians (EMTs) at their workplaces. (Ex. 12, Rappeport Report at MOT 004679.) The interviews were geographically distributed throughout eight of

the nine census regions of the United States. (*Id.*) The survey was “double blind.” (Ex. 12, Rapoport Report at MOT 004682.)

After respondents heard the sound at issue, they were asked whether they knew what the sound was. If a respondent answered that he or she recognized the sound, the respondent was asked whether he or she was thinking of one company who makes the sound or more than one company who makes the sound. (Ex. 12, Rapoport Report at MOT 004681.)

One hundred and sixty four (164) respondents were interviewed. After accounting for “noise” through the use of three different controls (Ex. 12, Rapoport Report at MOT 004680), RL Associates concluded that 42% of the respondents recognized Motorola’s sound as coming from a single source. (Ex. 12, Rapoport Report at MOT 004686.) This is legally sufficient to establish that Motorola’s sound has acquired distinctiveness. *See Textron, Inc. v. Int’l Trade Comm’n*, 224 U.S.P.Q. 625, 628 (Fed. Cir. 1985) (noting that 40% and 37% respondent recognition levels have been held to be sufficient to establish acquired distinctiveness).

Nextel has not run its own survey on the issue of distinctiveness. Nor has Nextel presented any expert testimony that responds to the survey run by RL Associates. Motorola’s survey thus stands uncontradicted.

#### IV. CONCLUSION

For the foregoing reasons, Motorola respectfully requests that summary judgment be entered against Nextel and that Motorola's Application Serial No. 78/235,618, issue to registration in due course.

Respectfully submitted,

Dated: Nov. 11, 2005

MOTOROLA, INC.

By  \_\_\_\_\_

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Attorneys for Applicant

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of MEMORANDUM IN SUPPORT OF  
MOTOROLA, INC'S MOTION FOR SUMMARY JUDGMENT was served on counsel for  
Opposer on Nov. 11, 2005, via First Class Mail, postage prepaid:

Michael H. Jacobs  
Crowell & Moring LLP  
1001 Pennsylvania, Avenue, N.W.  
Washington D.C. 20004



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# EXHIBIT 1

Nextel Communications, Inc., Opposer, v. Motorola, Inc., Applicant  
Opposition No.: 91/161,817  
Application No.: 78/235,618  
Mark: Sensory Mark (911 Hz Tone)

Exhibit 1 in Support of Applicant's Motion for Summary Judgment

# EXHIBIT 2

Nextel Communications, Inc., Opposer, v. Motorola, Inc., Applicant  
Opposition No.: 91/161,817  
Application No.: 78/235,618  
Mark: Sensory Mark (911 Hz Tone)

Exhibit 2 in Support of Applicant's Motion for Summary Judgment

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

**COPY**

NEXTEL COMMUNICATIONS, INC., )

Opposer, ) Opp. No. 91/161,817

vs. ) App. No. 78/235,618

MOTOROLA, INC., ) Pot. Mark: SENSORY MARK

Applicant. ) (911 Hz tone)

The videotape deposition of DAVID ERIC KLEIN,  
called by the Opposer for examination, taken before  
RICHARD H. DAGDIGIAN, CSR No. 084-000035, a notary public  
within and for the County of Cook, State of Illinois, and a  
Certified Shorthand Reporter of said State, at the offices  
of Brinks Hofer Gilson & Lione, 455 North Cityfront Plaza  
Drive, Suite 3600, on the 19th day of Jul 2005, commencing  
at 10:15 a.m.

1 APPEARANCES:

2 CROWELL & MORING

3 BY: JOHN I. STEWART, ESQ.

4 KAREN C. HERMANN, ESQ.

5 1001 Pennsylvanie Avenue, NW

6 Washington, D.C. 20004-2595

7 (202) 624-2685

8 on behalf of the Opposer;

9  
10 BRINKS HOFER GILSON & LIONE

11 BY: THOMAS M. WILLIAMS, ESQ.

12 455 N. Cityfront Plaza Drive, Suite 3600

13 Chicago, Illinois 60611-5599

14 (312) 321-4717

15 on behalf of the Applicant.

16  
17 ALSO PRESENT:

18 CAROLYN E. KNECHT, ESQ.

19 Senior Counsel Trademarks,

20 and

21 KRISTEN POGGENSEE, Paralegal Associate,

22 Corporate Law Department

23 Motorola, Inc.

24  
25 DEAN MARIS, Legal Videographer



## I N D E X

THE WITNESS

EXAMINATION BY COUNSEL FOR

OPPOSER

APPLICANT

DAVID ERIC KLEIN

(By Mr. Stewart)

6

## E X H I B I T S

KLEIN DEPOSITION EXHIBIT

FOR IDENTIFICATION

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1 THE VIDEOGRAPHER: Here begins the video deposition  
2 of David Klein, Tape One, Volume One, in the Matter of  
3 Nextel Communications, Inc. versus Motorola, Inc, in the  
4 United States Patent and Trademark Office before the  
5 Trademark Trial and Appeal Board, Opposer Number 91/161,817  
6 and Application Number 78/235,618.

7 Today's date is Tuesday, July 19, 2005, and the  
8 time on the video monitor is 10:15 a.m.

9 The video operator today is Dean Maris of  
10 Thompson Court Reporters located at One South Wacker Drive,  
11 Suite 1616, Chicago, Illinois 60606, and the phone number is  
12 312-346-3377.

13 The court reporter is Richard Dagdigian of  
14 Thompson Court Reporters.

15 Today's deposition is being taken on behalf of  
16 the opposer, and it is taking place at Brinks Hofer Gilson &  
17 Lione at 454 North Cityfront Plaza Drive, Suite 3600,  
18 Chicago Illinois, 60611.

19 Counsel will now introduce themselves and state  
20 the parties they represent after which the court reporter  
21 will administer the oath.

22 MR. STEWART: Good morning. I'm John Stewart, and  
23 this is my colleague, Karen Hermann. We are here from  
24 Crowell & Moring in Washington D.C., and we are here  
25 representing Nextel Communications.

1 MR. WILLIAMS: I'm Thomas Williams from the law firm  
2 Brinks Hofer Gilson & Lione, and I'm here on behalf of  
3 Motorola, Incorporated, the applicant.

4 DAVID ERIC KLEIN,  
5 called as a witness, having been first duly sworn by  
6 the Notary Public, was examined and testified as  
7 follows:

8 MR. WILLIAMS: I have a brief statement. Motorola  
9 objects to this discovery deposition being recorded on  
10 videotape.

11 First of all, the Board rules, <sup>T3MP</sup> ~~TMMP~~ 703.01I  
12 states that, "A deposition must be submitted to the Board in  
13 written form. The Board does not accept videotape  
14 depositions".

15 Second, it was unclear from the notice of  
16 deposition which used the language "and/or" that this  
17 discovery deposition would be videotaped.

18 And, third, much of this witness' testimony will  
19 relate to confidential material.

20 We designate the entire videotape and the written  
21 transcript as "Confidential, Attorneys' Eyes Only" until we  
22 have had the opportunity to carefully review the testimony,  
23 including the videotape, and to modify any confidentiality  
24 designations appropriate.

1 MR. STEWART: Thank you for that statement.

2 EXAMINATION

3 BY MR. STEWART:

4 Q Good morning, Mr. Klein. Have you ever been  
5 deposed before?

6 A No, sir.

7 Q Well, then I'm sure that you have talked with  
8 your counsel about what will transpire today, but let me  
9 just describe to you a bit.

10 I'm going to be asking you questions with respect  
11 to issues that are -- that we have raised in our notice of  
12 deposition. And you are to provide me answers. Your  
13 answers are under oath.

14 I would ask that if you do not understand any  
15 question that I ask, please let me know that and I will see  
16 what I can do to clarify it for you.

17 If you need a break at any time, please let me  
18 know at the end of an answer to a question. And if you can  
19 do that, then we will see what we can do to accommodate you.

20 If you ever need to talk to your counsel, please  
21 finish a response to a question, if you are in the middle of  
22 a response, and then we can take a break for you to talk  
23 with your counsel, if that's necessary.

24 Please make sure that you provide your answers in  
25 an audible fashion. This is being recorded both by the

1 stenographer and on videotape.

2 A Okay.

3 Q Is there anything that we should know about that  
4 would make it -- that would hamper your ability today to  
5 answer questions completely and fully?

6 A Not that I'm aware of.

7 Q Okay. Then let's get started. Would you state  
8 your full name, please.

9 A My full name is David Eric Klein.

10 Q What is your position at Motorola?

11 A I am a marketing manager.

12 Q And how long have you been in that position?

13 A My current position I've been in for  
14 approximately three years.

15 Q And before that, were you with Motorola?

16 A Yes, sir.

17 Q How long have you been with Motorola?

18 A I've been with Motorola since May 22nd, 1995.

19 Q And what was your position prior to marketing  
20 manager?

21 A My position immediately prior to marketing  
22 manager was a marketing portfolio planner.

23 Q And how long were you a marketing portfolio  
24 planner?

25 A For two years.

1 Q And how about before that?

2 A Before that, I was an engineer in product  
3 development.

4 Q I see. And how long were you in that position?

5 A I was in that position or that former position  
6 for five years.

7 Q For five years. And that takes you back to 1995?

8 A Correct.

9 Q Okay. And where were you before Motorola?

10 A University of Florida.

11 Q What kinds of degree program?

12 A I got a bachelor's of science in electrical  
13 engineering specializing in digital design.

14 Q So you came directly -- was Motorola your first  
15 employment after receiving that bachelor of science in  
16 engineering?

17 A Yes, it was.

18 Q Okay. While you were an engineer in product  
19 development, was there a particular type of product that you  
20 worked on?

21 A During my stay as a product engineer, I developed  
22 the tools that were used to place information within the  
23 radio -- customer information, customized information.

24 Q And was that with respect -- was that with  
25 respect to a lot of different Motorola products or one

1 particular product line?

2 A It was specific to Motorola's Type 2 Trunking for  
3 Analog and their APCO Digital Trunking, in addition to  
4 variants of their conventional offering.

5 Q Now, currently, as a marketing manager, is that  
6 with respect to a particular product line?

7 A I'm currently a marketing manager for what is  
8 referred to as our High Tier Products; these products that  
9 do our Motorola Type 2 trunking, our APCO trunking and APCO  
10 Project 25 trunking, and variants of conventional  
11 operation.

12 Q Okay. Now, we are here today to take your  
13 deposition -- to take the deposition of Motorola pursuant to  
14 the notice of deposition which we reissued as a Re-notice of  
15 Deposition of Applicant Motorola, Inc.

16 Now, you understand you are here in a  
17 representative capacity speaking on behalf of Motorola  
18 itself?

19 A Yes, I do.

20 Q Pursuant to the rules, we have identified  
21 particular topics that we are interested in asking questions  
22 about.

23 And under the rules, you have been designated to  
24 address all of those topics. Do you understand that?

25 A I do.

1 MR. STEWART: I want to ask that the reporter mark as  
2 Klein Exhibit 1 a copy which I will hand you in just a  
3 moment of the re-notice of deposition of Applicant Motorola,  
4 Inc.

5 (Klein Deposition Exhibit  
6 No. 1 was marked as  
7 requested.)

8 BY MR. STEWART:

9 Q Would you take a minute to review that document  
10 and, in particular, the list of topics with respect to which  
11 we are going to be asking you questions, the subject matter  
12 categories.

13 A Okay.

14 Q Okay. Have you reviewed this Klein Exhibit 1  
15 previously?

16 A I have seen and read the document.

17 Q Okay. With respect to the subject matter  
18 categories that are numbered 1 through 15, are you the  
19 person at Motorola most qualified to discuss each of those  
20 topics?

21 MR. WILLIAMS: Objection. Under the rules, he  
22 doesn't necessarily have to be the person most qualified.  
23 He's being designated today on behalf of Motorola

24 BY MR. STEWART:

25 Q Are you prepared to address each of those 15



1 categories Mr. Klein?

2 A I'm prepared to the best of my knowledge to  
3 address the 15 categories.

4 Q Are there people within Motorola who would be  
5 more knowledgeable with respect to particular ones of these  
6 15 categories.

7 MR. WILLIAMS: Objection, that's vague and  
8 ambiguous.

9 BY MR. STEWART:

10 Q You may answer the question.

11 A I am unaware of specific people who would be  
12 readily available to answer all 15 elements.

13 Q Well, with respect to any particular ones of  
14 those, are there people in Motorola who are more qualified  
15 or have more information to answer questions about those  
16 particular topics?

17 MR. WILLIAMS: Objection, that's vague and  
18 ambiguous.

19 BY MR. STEWART:

20 Q Please answer the question.

21 A I do not know.

22 Q Okay. We will come back to that.

23 Now, to what extent have you had personal  
24 involvement in the facts underlying these subject matter  
25 categories?

1 MR. WILLIAMS: Objection to the extent that that  
2 question calls for revealing privileged communications  
3 between the lawyer and the client.

4 BY MR. STEWART:

5 Q Please answer.

6 A Will you repeat the question.

7 Q To what extent have you had personal involvement  
8 in the facts relating to each of these 15 topics?

9 MR. WILLIAMS: I instruct you not to answer to the  
10 extent that your answer would involve revealing  
11 communications that you have had with the lawyers or the  
12 Legal Department.

13 A I have read company documentation and seen  
14 company records related to the topics.

15 BY MR. STEWART:

16 Q With respect to the work that you have done for  
17 Motorola in marketing and as an engineer, have you -- were  
18 you involved in any of these subject matters?

19 A I have worked on products that include the 911  
20 Hz Tone.

21 Q Have you worked on any aspect of the creation,  
22 selection or incorporation of the 911 Hz Tone itself?

23 A Yes.

24 Q Explain how that has happened, please.

25 MR. WILLIAMS: Objection, that's vague.

1 BY MR. STEWART:

2 Q Answer, please.

3 A The tone is a standard within these products, and  
4 we have adhered to that standard.

5 Q And for you personally as an engineer, how has --  
6 how did you implement that adherence, or what exactly did  
7 you do with respect to the 911 Hz Tone itself?

8 A Can you clarify.

9 Q Yes. You said you worked on the creation,  
10 selection or incorporation of the 911 Hz Tone itself, is  
11 that correct?

12 A In current products, yes.

13 Q In current products, yes. Can you tell me  
14 exactly what your work consisted of? How did -- let me end  
15 it there.

16 A In the current products, my effort was specific  
17 to insuring that the products utilize the specific 911 Hz  
18 Tone as we have done in previous products for consistency.

19 Q And in doing so, how did you go about that?

20 A That included requiring the appropriate pitch and  
21 cadence of the tone; the inclusion of the description of the  
22 tone in manuals; verification that the operation overall of  
23 the products in the customers' hands when they used  
24 operations involving the tone matched previous products.  
25 That's pretty much it.

1 Q First, you said requiring the appropriate cadence  
2 and tone for purposes of consistency, is that right?

3 A Yes.

4 Q In what capacity did you require that?

5 A It is stipulated as a requirement to the  
6 products.

7 Q In what form is that stipulation or that  
8 requirement stipulated?

9 A The stipulation comes in the general form of the  
10 product that is being replaced must match functionality.  
11 The new product that's replacing the old product must match  
12 functionality. It's more of a blanket statement of  
13 operation.

14 Q Is that in writing?

15 A To the best of my knowledge, I believe it is.

16 Q That it is in writing?

17 A Yes.

18 Q In what form?

19 A Internal documents, a stipulation of definition  
20 of the products.

21 MR. STEWART: We would ask if that document has not  
22 been produced to us, that it be produced to us at this  
23 point.

24 Are you aware of whether that document has been  
25 produced.

1 MR. WILLIAMS: We will take that request under  
2 advisement.

3 MR. STEWART: Thanks. I'm sorry, go ahead.

4 A Nothing.

5 BY MR. STEWART:

6 Q Okay. Let me ask, have you reviewed all of the  
7 documents that were produced by Motorola to Nextel in  
8 response to Nextel's discovery requests in this proceeding?

9 A I am unsure. I have reviewed some -- I have  
10 reviewed documentation. I'm unsure if it's the full scope  
11 of documentation.

12 Q Was the stipulated requirement that you just  
13 described among the documents you reviewed?

14 A For the purpose of this activity, it was not part  
15 of the documents that I reviewed.

16 Q Did you review it separately?

17 A Yes, during natural job functions and activities.

18 Q When was that?

19 A Over the last two or three years of actual job  
20 functions, documentations that describe products are seen  
21 and reviewed.

22 Q So that was while you were in your position as  
23 marketing manager, correct?

24 A Between marketing manager and portfolio planner.

25 Q While you were an engineer, did you see such

1 stipulated requirement?

2 A I did not see stipulated requirement because  
3 those stipulated requirements were not in the particular  
4 documentation I worked with on a day-to-day basis.

5 Q Why not?

6 MR. WILLIAMS: Objection, that's vague.

7 A I need a little bit of clarity.

8 BY MR. STEWART:

9 Q What were you working on that was different?

10 I'm sorry, were you working on some area of  
11 functionality of the devices that was different from that  
12 that included the 911 Hz Tone?

13 A I worked on a PC based application software that  
14 placed configuration information into the products.

15 So I was not part of the group that developed the  
16 911 tone for particular products.

17 I was a person who worked on a slightly different  
18 aspect of the overall delivery of the products.

19 Q You mentioned that you had reviewed documents.  
20 What else have you done to prepare yourself for the  
21 deposition today?

22 MR. WILLIAMS: Objection. To the extent that your  
23 answer would reveal communications between the lawyers and  
24 yourself, I instruct you not to answer.

25 A I reviewed user manuals, I reviewed product

1 description documents. These would be internal documents  
2 that Engineering uses to describe the products.

3 And I looked at training information in reference  
4 to the frequency tone, had discussion with Motorola  
5 employees concerning the frequency tone.

6 BY MR. STEWART:

7 Q With which Motorola employees did you speak?

8 A Mitch <sup>Leshin</sup> ~~Leshin~~, <sup>Leshin</sup> ~~Leshin~~, I believe, and Dave  
9 Mills.

10 Q And what are their positions in Motorola?

11 A They are engineering managers.

12 Q Are they managers with respect to particular  
13 product lines?

14 A They are managers with product lines that I'm  
15 directly related to, which would be Motorola Type 2  
16 Trunking, Astro -- the APCO Trunking and APCO Project 25  
17 Trunking, and other forms of conventional operation.

18 Q And if you know, how long have they been with  
19 Motorola?

20 A I do not know their tenure at Motorola, the  
21 length of it.

22 Q Why did you speak with them?

23 MR. WILLIAMS: Object to the extent that your answer  
24 calls for revealing communications between the lawyers and  
25 yourself.

1           A    I spoke with both gentlemen in concern with  
2   general availability and engineering effort to support and  
3   interact with the 911 Hz Tone.

4           BY MR. STEWART:

5           Q    What do you mean by availability?

6           A    I guess implementation would be a more  
7   appropriate term. How they implemented the tone in  
8   different products.

9           Q    Did you talk to them with respect to 911 Hz Tone  
10   products that are not current products?

11          A    I spoke with them about previous 911 Hz Tone  
12   products.

13          Q    Did they have direct knowledge of previous 911 Hz  
14   Tone products?

15          A    Mitch <sup>Leshin</sup>~~Leshim~~ had knowledge about previous 911 Hz  
16   Tone products.

17          Q    And Dave Mills did not?

18          A    Not beyond common knowledge of the 911 Hz Tone  
19   products.

20          Q    Did you do anything else to prepare?

21          A    Not beyond my daily job functions and my own  
22   personal history and interaction with the products, no.

23          Q    Did you speak to anyone other than Mitch <sup>Leshin</sup>~~Leshim~~  
24   and Dave Mills?

25          MR. WILLIAMS:   Objection to the extent your answer



1 would call for revealing communications between the lawyers  
2 and yourself.

3 A I did speak with Marlon Moo-Young, M-o-o -  
4 Y-o-u-n-g, Marlon Moo-Young, concerning his understanding of  
5 the tone. He -- I worked with him on understanding the  
6 tone.

7 I have spoken to his manager, Tim Quirey,  
8 concerning the tone.

9 BY MR. STEWART:

10 Q How do you spell Quirey?

11 A Q-u-i-r-e-y, I believe.

12 Q What are their respective positions?

13 A Marlon Moo-Young manages the engineering support  
14 team, assisting customers in the field, and Tim is his  
15 manager for that organization.

16 Q Did you obtain any documents from any of these  
17 four individuals?

18 A Not that I'm aware of. In other words, no --  
19 they turned over no documentation to me for -- for this  
20 tone.

21 Q Did you take notes of your conversations with  
22 them?

23 A I do have notes. I do have notes that Mitch and  
24 I -- Mitch and I had a conversation with.

25 MR. STEWART: We would ask for the production of

1 those notes.

2 MR. WILLIAMS: We will take that under advisement.

3 BY MR. STEWART:

4 Q Did you talk with any other individuals?

5 A Specifically about the 911 Hz Tone, let me think.  
6 I had spoken to our Training Department, specifically one of  
7 our training developers, Janice Morey; M-o-r-e-y is her last  
8 name.

9 She is, for lack of a better term, an author of  
10 our -- of our user guides and training material.

11 Q What did you discuss with her?

12 A The presence of training information related to  
13 the 911 Hz Tone.

14 Q And did you collect documents from her?

15 A Yes, I did.

16 MR. STEWART: We would ask for those documents, to  
17 the extent they haven't already been produced, or for their  
18 identification if they have already been produced.

19 MR. WILLIAMS: We will take that under advisement.

20 BY MR. STEWART:

21 Q Did you take notes of your conversations with  
22 Janice Morey?

23 A No, I did not.

24 Q Did you talk with other individuals?

25 A No, I actually never did -- there would be -- I

1 was directed to, oddly enough, Dave Klein, as he manages the  
2 Training Department, but he was out of town.

3 Q And is that the only other person you tried to  
4 speak with in preparing for this deposition?

5 A I was directed to Monica Gingells -- don't ask me  
6 to spell it -- and who I never really had a chance to have  
7 any conversation with either.

8 Q And what's her position?

9 A My assumption is she is assisting in management  
10 of the Training Department while David Klein is on vacation.  
11 That is merely an assumption.

12 Q Okay. Are there any other individuals you spoke  
13 with in preparing for the deposition?

14 A I did speak with Mary <sup>Pittman</sup> ~~Pitman~~.

15 Q Who is that?

16 A She handles our -- I'm not really sure what her  
17 actual title is. She handles -- if we sell products to an  
18 integrator company, something like that.

19 Q So she is in sales?

20 A Not that I'm aware of. As near as I know, she is  
21 just part of the North American Business Team. That's our  
22 title for that group.

23 Q Any other individuals?

24 A Not that I'm aware of.

25 Q Did you collect documents from Mary <sup>Pittman</sup> ~~Pitman~~?

1 A No, I did not.

2 Q Did you take notes of conversations with her?

3 A Verbal only.

4 Q So the answer is no?

5 A No.

6 Q Then let me read you the list we have just gone  
7 through.

8 Mitch Leshim, Dave Mills, Marlon Moo-Young, Tim  
9 Quirey, Janice Morey, and Mary Pitman were the individuals  
10 you identified as people you talked to in preparing for this  
11 deposition?

12 A Correct.

13 Q Any others come to mind?

14 A None that I'm aware of.

15 Q And when did these conversations take place  
16 roughly?

17 A In the last two weeks or so.

18 Q Did you speak with anyone in sales or marketing?

19 A You would have to define marketing because we  
20 have a -- different definitions of marketing within our  
21 organization.

22 Q I would like to get all the details of that, but  
23 did you talk with anybody who was involved in sales or  
24 marketing activities or responsibilities in a general sense?

25 A Yes, I did. Yes, I did. I did speak with Linda

1 Serges.

2 Q How do you spell her name?

3 A S-e-r-g-e-s, I believe. She is -- she does  
4 management for some of our promotional trade show and user  
5 interaction groups.

6 Q and did you collect documents from her?

7 A Yes, I did.

8 MR. STEWART: We ask that those be produced or  
9 identified if they have already been produced.

10 MR. WILLIAMS: We will take that under advisement.

11 BY MR. STEWART:

12 Q Did you take notes of any conversations with her?

13 A No, I did not take any notes of our conversation.  
14 It was strictly verbal.

15 Q Any other people that now come to mind?

16 A It's been a busy few weeks. I did speak with Joe  
17 Balchune, B-a-l-c-h-u-n-e, I believe. I should know this.

18 And he identified, in association with  
19 conversations with Mary <sup>Pittman</sup> ~~Pitman~~ -- he identified, again,  
20 products that we have sold to integrators.

21 Q Define product integrators or integrators in this  
22 context.

23 A Companies who purchase products from us to be  
24 integrated into a larger product or a larger final product.

25 Q All right. We have added these two -- two

1 additional names, Linda Serges and Joe Balchune.

2 Did you speak with any other individuals in  
3 preparing for the deposition?

4 A No, no.

5 Q Okay. Did you communicate with any of these  
6 people or others by e-mail in preparing for this deposition?

7 A I did communicate with multiple of those people  
8 via e-mail.

9 MR. STEWART: All right. And we would ask for those  
10 e-mails to be produced.

11 MR. WILLIAMS: We will take that under advisement.

12 BY MR. STEWART:

13 Q Did you communicate by e-mail to any other  
14 individuals?

15 A Concerning the 911 Hz Tone?

16 Q Uh hum.

17 A Not that I'm aware of.

18 Q Did you speak with anyone who was responsible for  
19 engaged in advertising activities?

20 A That would be -- please identify your concept of  
21 advertising.

22 We do it in a multitude of ways.

23 Q Well, you've talked about promotion and trade  
24 shows and user interaction groups.

25 Let me come back to that when I talk more

1 specifically about the advertising. I think it will be  
2 clearer if we break it all down.

3 But with respect to any kinds of marketing and  
4 promotion, are Linda Serges -- is Linda Serges the only  
5 person you spoke with in preparing for this deposition?

6 A Linda Serges is the only person I spoke with as  
7 far as managing trade shows, promotional events and user  
8 groups.

9 Q And what -- who else did you speak to with  
10 respect to other kinds of marketing activities?

11 A Our training organization develops tools as such,  
12 so it would be Janice Morey.

13 MR. STEWART: Okay. All right. I would like to  
14 have marked as Klein Exhibit 2 the file history reflecting  
15 the PTO records on the Motorola application for trademark  
16 registration for the 911 Hz Tone.

17 (Klein Deposition Exhibit  
18 No. 2 was marked as  
19 requested.)

20 BY MR. STEWART:

21 Q Have you ever seen this -- I'm sorry, continue  
22 reviewing the document.

23 Have you seen this document before?

24 A No, I have not.

25 Q All right. If you would turn to the very last

1 page of this document which is labeled MOT 002015 -- do you  
2 see that?

3 A Yes, I do.

4 Q Do you see in the identification of  
5 "Goods/Services" down in the left hand column there, an  
6 indication that goods and services are two-way radios,  
7 immediately to the right of that?

8 A I do see that.

9 Q Now, are you aware of the scope of the rights  
10 being sought in this registration application?

11 MR. WILLIAMS: Objection, that calls for a legal  
12 conclusion. This is a fact witness.

13 BY MR. STEWART:

14 Q You may answer.

15 A I do not know the full ramifications of this  
16 statement.

17 Q If you -- in Klein Exhibit 1, which is the  
18 re-notice of deposition that we showed you before, you have  
19 a defined term on Page four, the definition numbered eight.  
20 Do you see that there?

21 A Correct.

22 Q That's a definition of the 911 Hz Tone products.

23 A Okay.

24 Q And we have defined that as meaning the goods  
25 that are being applied for which registration is being



1 applied for by Motorola in this 911 Hz proceeding, okay?

2 A Okay.

3 Q Now, using that as a basis, I would like to talk  
4 with you about kind of the nomenclature and the way you  
5 understand the nature of those products.

6 A So for clarification, you are asking me to --  
7 when we discuss two-way radios, that I am to assume the  
8 definition to be 911 Hz Tone products?

9 Q I want to do it the other way around. The 911 Hz  
10 Tone products, for purposes of our discussion right now, and  
11 throughout this deposition, unless we revisit this, is going  
12 to refer to all the Motorola products identified as two-way  
13 radios for which the registration application has been  
14 filed.

15 MR. WILLIAMS: I'm going to renew my objection based  
16 on the fact that he's a fact witness, and he's not  
17 designated to testify about the Patent & Trademark Office  
18 identifications of goods and services.

19 BY MR. STEWART:

20 Q I'm sorry. Go ahead.

21 A So when you stipulate two-way radios, I'm to  
22 assume you are referring to 911 Hz Tone products? Is that  
23 my understanding?

24 Q I'm going to be using 911 Hz Tone products to  
25 refer to whatever it is that Motorola is seeking the

1 registration to cover in this proceeding.

2 A Okay.

3 Q Do you have an understanding yourself of what is  
4 meant by 911 Hz Tone products?

5 A I do.

6 Q What is that understanding?

7 A My understanding of this term is that it is a  
8 product that produces a particular cadence at a pitch of 911  
9 Hz or thereabouts, and it represents two things within the  
10 products.

11 One is, the audio path is open and the <sup>microphone</sup> ~~mike~~ is  
12 available to transmit the audio spoken, and that it refers  
13 to Motorola products.

14 Q Are there any products manufactured by --  
15 manufactured or sold or offered for sale by Motorola that  
16 incorporate the 911 Hz Tone, this particular sound that you  
17 have described, but are not two-way radios?

18 A None that I'm aware of.

19 Q Are you generally aware of all of the Motorola  
20 products that incorporate this 911 Hz Tone?

21 A I am not an expert in all Motorola products. I  
22 have familiarity with the products that are associated with  
23 the GEMS, G-E-M-S -- GEMS organization within Motorola.

24 Q What is the GEMS organization?

25 A Specifically a business organization within

1 Motorola who -- who sells our definition of two-way  
2 products.

3 Q And what is that definition of two-way products?  
4 I'm sorry, what does your definition of two-way products  
5 encompass?

6 A My definition of two-way products encompasses  
7 private or leased radio systems, hand-held devices, and  
8 dispatch centers that allow for immediate group dispatch or  
9 direct unit-to-unit communications.

10 Q Do you use the distinction indirect or direct  
11 communications devices in this context?

12 A Those are internal nomenclature for the overall  
13 market.

14 Q And what do those two terms mean in this context?

15 A Indirect specifically is a portion of our  
16 business where we sell to shops, businesses, such that they  
17 can lease out equipment to other users, essentially  
18 intermediates, organizations, private organizations that we  
19 sell to; and then they either resell or lease or rent,  
20 versus direct, where we have a direct customer interaction  
21 with the sales force.

22 These customers are larger customers that will  
23 own their own private systems, maintain their systems.

24 Q Do the -- you identified three, if I understood  
25 this correctly, three categories of two-way products within

1 the GEMS organization. The first was private or leased  
2 radio systems, the second was hand-held devices, third was  
3 group dispatch systems and devices?

4 A Group system dispatch and devices are more of an  
5 attribute to the hand-helds.

6 They also -- there is also an organization or a  
7 group of products that are for dispatch centers such that it  
8 is still a two-way, but is a two-way product, but it's  
9 within, say, a building or actually mobile.

10 Q Is that covered within the GEMS organization?

11 A Yes, it is.

12 Q And that's within the scope of the products that  
13 you are considering the 911 Hz Tone products?

14 A I have more familiarity with the hand-held or the  
15 mobile products, whether it's hand-held or whether it's  
16 installed in a vehicle, than I do of the infrastructure and  
17 dispatch groups.

18 But I have some working familiarity with those  
19 organizations as per my job.

20 Q Are any of these categories of two-way products  
21 -- do any of them, I'm sorry, operate in a direct hand-held  
22 to hand-held communication path as opposed to through a  
23 central control or network?

24 A For our term, we refer to that as infrastructure.  
25 A significant number of -- I take that back.

1           Currently, to the best of my knowledge, all of  
2 the products that we make available for sale on indirect and  
3 direct markets support a direct unit-to-unit without --  
4 without going through a system or infrastructure.

5           Now, not all features are available, but they do  
6 operate.

7           Q   Do any of the products encompassed within this  
8 business organization operate solely in a unit-to-unit mode?

9           A   Can you repeat the question.

10          Q   Do any of the two-way products that you have  
11 described as being within the GEMS organization operate  
12 solely in a unit-to-unit mode?

13          A   Yes. There are a number of lower cost, lower  
14 priced products that operates only in a unit to unit method.

15          Q   Now, does the GEMS organization also produce or  
16 sell products other than two-way products?

17          A   GEMS, to the best of my knowledge -- it goes back  
18 -- I cannot fully categorically answer that because of the  
19 definition of what is a two-way radio.

20          We have products that operate, sending and  
21 receiving messages, which constitutes a two-way product, so  
22 I'm not sure how to respond to that given verbiage.

23          Q   You are distinguishing between two-way products  
24 and two-way radio products, do I understand you correctly?

25          A   Well, I don't -- I guess I need to understand the

1 question. You -- can you repeat the question.

2 Q Is the GEMS organization responsible for  
3 producing or selling products other than two-way products?

4 A We do sell data products. They again work under  
5 the same principle of two-way products, so I don't know if  
6 there is a distinction between those.

7 Q I want to come around and ask you in the end,  
8 then, does every two-way product sold -- produced by and  
9 sold by the GEMS organization include the 911 Hz Tone?

10 A The products that generate that tone are trunking  
11 infrastructure utilized products.

12 If a product utilizes or has the opportunity to  
13 utilize that function, those products can generate a 911 Hz  
14 Tone.

15 Q So there are additional products, two-way  
16 products that do not use the 911 Hz Tone within the GEMS  
17 organization?

18 A There are 911 -- there are two-way products that  
19 do not utilize the 911 Hz Tone.

20 Q Can you identify those products?

21 A Specifically those products are products that are  
22 not designed to operate on infrastructure systems.

23 Q And this would include the lower priced  
24 unit-to-unit --

25 A Correct --

1 Q Products. Okay. So just to confirm, every  
2 product designed to utilize trunking infrastructure within  
3 the GEMS organization uses the 911 Hz Tone?

4 A For clarity, every voice product.

5 Q And with that clarification, that was a true  
6 statement that I made, is that correct?

7 MR. WILLIAMS: Objection, that's vague and  
8 ambiguous.

9 BY MR. STEWART:

10 Q Let me restate it. Every voice product produced  
11 or offered for sale by the GEMS organization that is capable  
12 of utilizing trunking infrastructure incorporates the 911 Hz  
13 Tone, is that correct?

14 A That is a correct statement.

15 Q Are there other products produced or offered for  
16 sale by Motorola outside the GEMS organization that also use  
17 the 911 Hz Tone?

18 A Not that I'm aware of.

19 Q So Motorola currently manufactures 911 Hz Tone  
20 products, is that right?

21 A Correct.

22 Q And I would like now to talk about the overall  
23 organization of Motorola and how the GEMS organization fits  
24 within Motorola.

25 Is it one of a number of business units within

1 Motorola?

2 A The GEMS organization is one of, I believe, four  
3 -- is it four now -- four organizations.

4 Q What are the -- I'm sorry?

5 A Mobile Devices, Connected Home, the GEMS  
6 organization, and -- are we down to three now? We might be  
7 down to three. We've had some reorganizations.

8 Q Was the GEMS organization in place as far back as  
9 1991?

10 A The GEMS organization itself, under different  
11 names. We have, to my knowledge, added and removed business  
12 elements within the organization, but the organization  
13 itself has been there since 1991.

14 Q What are the prior names of the organization?

15 A CGISS, C-G-I-S-S. Before that, it was LMPS;  
16 before that, it was Land Mobile. I believe it was Land  
17 Mobile during the time of 1991, or it could have been the  
18 Communications Group -- Communications Sector. I'm not sure  
19 if that was before 1991 or not.

20 Q And has your position within Motorola always been  
21 within the GEMS organization or a prior -- a predecessor?

22 A Yes, I have worked throughout -- throughout my  
23 tenure within this organization.

24 Q Going back through the prior history of the GEMS  
25 organization, I want to ask you the same question I've asked



1 -- that we have now established, that is, no products  
2 produced by other organizations within Motorola used the 911  
3 Hz Tone. Was the same true for -- when the GEMS  
4 organization was constituted as CGISS?

5 MR. WILLIAMS: Objection, that's vague and  
6 ambiguous, and a compound question.

7 A Can you clarify -- can you give a little clarity  
8 to that?

9 BY MR. STEWART:

10 Q You've testified that no products created by  
11 Motorola outside the GEMS organization incorporate the 911  
12 Hz Tone, is that correct?

13 A Correct.

14 Q And that's as a current matter, correct?

15 A That is a current organization.

16 Q Was the same true with respect to the CGISS  
17 organization?

18 A Yes. There was no -- CGISS was the producer of  
19 911 Hz Tone products.

20 Q Was the same true with respect to the LMPS  
21 organization?

22 A Yes. There was no 911 Hz Tone products.

23 Q And was the same true with the Land Mobile Group?

24 A It is hard for me to answer that, in that it was  
25 before my time.

1 Q If you needed to find out the answer to that  
2 question with respect to Land Mobile, how would you go about  
3 finding the answer?

4 A For that specific -- for absolute validation,  
5 somebody involved with that at the time would be Mitch  
6 <sup>Leshin</sup>  
~~Leshin~~.

7 In a conversation he and I have had, I am -- with  
8 that as a premise, I am unaware of any products during that  
9 time that had the 911 Hz Tone outside of the Land Mobile.

10 Q Okay. Who is currently the head of the GEMS  
11 organization?

12 A The business president is Greg Brown.

13 Q Greg --

14 A Greg Brown.

15 Q Brown. And I would like you to give me the  
16 predecessor heads of these organizations if you know that.

17 A Okay. Before him was Bob Barnett. Bob Barnett  
18 was there for a while.

19 I couldn't clearly give you additional presidents  
20 of the sector. We were part of the CE sector -- or CE  
21 umbrella, so that -- what was his name, he came to visit us.  
22 I can't go beyond that.

23 That goes back to about 1997 or somewhere in  
24 there. That's as far as I can recall names.

25 Q Do you know who the head of the Land Mobile

1 organization was in 1991?

2 A I do not -- I am not aware of that.

3 Q You said that the GEMS organization is part of  
4 the CE umbrella, is that correct?

5 A In one of our many reorgs, the CE was a label  
6 that was given to a multitude of business units.

7 Q And who was the head of the CE structure?

8 A I cannot recall his name at this time.

9 Q What time -- during what years was the CE  
10 umbrella in place?

11 A I would be guessing if I was to tell you the  
12 exact timeframe.

13 Q Did it go back as far as 1991?

14 A No, sir.

15 Q Was it in place when you joined the company?

16 A No, sir. It was, to the best of my recollection,  
17 a 96, 97 timeframe of instantiation.

18 Q Is it still in place?

19 A No, it is not.

20 Q When did it go out of effect?

21 A I would be guessing at the time of the reorg. My  
22 best guess would be in the 1999, 2000 timeframe.

23 Q Is that when the GEMS organization was created?

24 A No, sir.

25 Q When was that?

1           A    The GEMS organization was created nine months  
2   ago, the label, and when it was associated with that  
3   acronym.

4           Q    When was -- when did CGISS come into effect?

5           A    CGISS was instantiated, to the best of my  
6   knowledge, in the end -- in the mid point of 2000.

7           Q    Now, does the GEMS organization support itself  
8   with -- in effect -- internal resources for marketing,  
9   sales, distribution?

10          A    To the best of my knowledge -- can you define  
11   internal, internal to --

12          Q    Let me start over and ask you to tell me. How is  
13   the GEMS organization itself structured internally?

14          A    We have a business unit, and we have an  
15   engineering unit and we have manufacturing units.

16          Q    And you are within the business unit?

17          A    Yes, I am.

18          Q    And what operations are encompassed by the  
19   business unit?

20          A    The business unit includes the -- the external  
21   sales force, our direct sales force who interact with  
22   customers. The business unit does the accounting, the  
23   financial management of the sales force, sales.

24                There is a marketing communication organization;  
25   there is a products definition marketing organization; and

1 that's kind of -- that seems to be the full scope of the  
2 groups.

3 Q What does the -- what responsibilities fall  
4 within the marketing communications organization?

5 A They are responsible for traditional  
6 communication messages, documentation associated with  
7 products.

8 They are responsible for managements of  
9 promotional and advertising events, and advertising  
10 documentation ads or -- items that appear, say, in a  
11 magazine or something, prints, in addition to customer  
12 interaction, promotions; in addition to management of trade  
13 show opportunities; in addition to supplies, whether it be  
14 material supplies or whether it be sponsoring events to help  
15 support the sales force interact with the customers.

16 Q How about broadcast advertising?

17 A Yes, any type of advertising that is associated  
18 with the GEMS organization, they would either -- my  
19 understanding is they are responsible for that. Whether it  
20 is internal or whether they have external firms, I'm  
21 unaware.

22 When we require communication messages, this is  
23 the organization that has responsibility.

24 Q What about competitive intelligence?

25 A Intelligence is handled within the business

1 units, not necessarily in the marketing communication  
2 organization.

3 Q How about brand management?

4 A Brand management is handled in two methods that  
5 I'm aware of, one being a consistent advertising  
6 presentation scheme of materials, and, then, a second in how  
7 we manage our portfolio from the business side, such that we  
8 keep a consistent message out with our products -- or a  
9 definition of our products.

10 Q Are you within one of these four organizations  
11 within the business unit?

12 A I'm within the product portfolio planning -- I'm  
13 not sure what term I used.

14 Q Product definition marketing organization?

15 A Yes.

16 Q Is there a separate head of the business unit as  
17 opposed to the heads of these four individual operations?

18 A Jim <sup>Sarallo</sup> ~~Surello~~ (phon.sp.) is the head of our North  
19 American Business Operations.

20 There is -- there are people who are in  
21 International Operations as far as business heads also.

22 Q And who is the head of the Marketing  
23 Communications Organization?

24 A Mary <sup>Botie</sup> ~~Botie~~, ~~B-o-t-i-e~~. There might be two O's.

25 Q And who is the head of the Product Definition

1 Marketing Organization?

2 A For -- this becomes -- if we have a head for the  
3 subscribers, we have a head for infrastructure. The head  
4 for the subscriber is dualled. I believe it's Craig  
5 ~~Jenisek~~ <sup>Chenicek</sup> (phon.sp.) for the indirect market, and he might also  
6 be the business -- I'm not quite sure how they are organized  
7 at this time.

8 In the direct sales line of products, it's ~~Curt~~ <sup>Kurt</sup>  
9 Brasch, B-r-a-s-c-h or a-u-s-c-h.

10 Q And how about on the infrastructure side?

11 A There is -- I believe the gentleman's name is  
12 Randy Helm from a product planning type perspective. I'm  
13 not a hundred percent sure. We've had some reorgs around  
14 there also.

15 Q What does the product definition marketing  
16 organization do?

17 A We try to capture the needs of the user and,  
18 then, transfer that into a product definition and, then,  
19 insure that that product fits within the portfolio of  
20 products we want to offer and the set of customers we wish  
21 to appeal to.

22 Q Do you do this through research?

23 A We do this in several ways. One is research, one  
24 is just insuring that the current product is well replaced  
25 as far as a feature sets.

1           Then it's pretty much the two major ways; the  
2 research itself could be involving interaction with  
3 customers, our own internal understanding of things. It's  
4 different approaches.

5           Q    Have you ever -- or has this organization --  
6 sorry -- ever done research on the 911 Hz Tone itself?

7           A    Specific to the 911 Hz Tone, I am unaware of any  
8 research focused directly at that tone.

9           Q    Are you aware of any research results that are  
10 related directly to the 911 Hz Tone?

11          A    No research results. We have heard customer  
12 feedback in interviews. I am not aware if it's tangible  
13 documentation as far as notes taken and recorded, though.

14          Q    What's the nature of that customer feedback?

15          A    Training and understanding how the product works.  
16 If they are to replace a product, they need to know that the  
17 user is able to understand how to use and feels comfortable  
18 with it, and understands that they know it.

19          Q    And how did that customer feedback relate  
20 directly to the 911 Hz Tone?

21          A    We have, consistent with our tones, over the life  
22 of the products, specifically for -- the internal term we  
23 use is "Hands on, eyes off".

24               Customers, without focusing on the products,  
25 understand what's happening, understand when the ~~micro~~ <sup>microphone</sup> is



1 active. They are told in a consistent manner, and if they  
2 are using a Motorola product, there is an understanding that  
3 we -- that we have been consistent such that if they replace  
4 that Motorola product with another Motorola product,  
5 training of certain aspects of the radio are at a minimum or  
6 not even required.

7 Q Because they can use it in the same way as they  
8 have used prior products?

9 A They are able to -- they are very attuned to  
10 particular sounds, and it allows them to understand what's  
11 happening without them interacting.

12 So we have been consistent, and they are familiar  
13 enough with our products to know that tone means they can  
14 now talk.

15 Q Have you in the course of this product definition  
16 marketing organization's activities -- have you or others  
17 within the organization looked at competitors' products that  
18 are within the same product sector?

19 A We have -- we have reviewed competitors' products  
20 from a feature standpoint, aspects to how a bid is written  
21 or a request for proposal or request for bid, and we also  
22 analyze the products overall -- alterability, robustness;  
23 items that are very key to the customer, especially when  
24 they want a long lasting product, so key focus points we  
25 have on the durability, things like that.

1 MR. WILLIAMS: Are you ready for a short break?

2 A Yeah, I can use a little restroom break.

3 MR. STEWART: Great.

4 THE VIDEOGRAPHER: This is the Videographer. The  
5 time is 11:25 a.m. We are going off the record.

6 (Whereupon, a short recess was  
7 taken.)

8 THE VIDEOGRAPHER: We are back on the record. This  
9 is the Videographer. The time is 11:40 a.m.

10 BY MR. STEWART:

11 Q Is there a standard nomenclature within Motorola  
12 for identifying the function of the 911 Hz Tone and other  
13 tones generated by your products?

14 A Can you clarify.

15 Q You used some verbiage which I didn't write down  
16 before to identify what it is that the 911 Hz Tone signifies  
17 to a user of one of your radios, is that right?

18 A Correct.

19 Q Could you repeat that language. I will write it  
20 down this time.

21 A The 911 Hz Tone signifies the microphone --  
22 either the channels available for communication or that the  
23 microphone is active and transmitting.

24 So it allows the user to understand that. In  
25 addition, they know that when they hear that tone, that tone

1 is coming from a Motorola product.

2 Q Just a second on that. How do they know that  
3 it's coming from a Motorola product?

4 A There is a variety of ways. Motorola trains end  
5 users specifically in the tone; tones mentioned in end user  
6 documentation manuals, user guides.

7 The tone is heard at trade shows and in other  
8 events. Motorola provides a system that is at a trade show  
9 and be able to show the radio is communicating on the  
10 infrastructure, and that tone is audible there.

11 There is many -- many times, the sales folks will  
12 visit a customer and bring new products, and they can  
13 configure their products such that they can operate on the  
14 system and, then, they can show the customer the new  
15 products, and that -- and that tone, that audible tone is  
16 heard during the transmission attempts.

17 Q And is that all?

18 A Let me think. Manual, training, trade shows.  
19 There is -- to the best of my knowledge, I believe that's --  
20 that's my understanding of the association.

21 And in addition to the -- you know -- the  
22 Motorola products themselves make the tone; the emblem or  
23 the embossed label, the product is there.

24 As a matter of fact, we go through effort to make  
25 sure it can't be worn away. It appears multiple times on

1 the product such that when you hear that tone, you are  
2 presented with the Motorola label, the trademarks, the  
3 bat wing emblem, things like that.

4 So it's been that way for a while. So the  
5 repetition of the products, the repetition of the training,  
6 the consistencies are kind of the -- of that linkage.

7 Q Is that all?

8 A To what I can recall right now, yes.

9 Q If you recall anything further, please let me  
10 know.

11 A Okay.

12 Q You said that customers know it's from a Motorola  
13 product. And you listed these as ways in which a customer  
14 might know that.

15 Do you have any direct evidence that customers do  
16 know that the tone is emanated -- that the tone is a  
17 Motorola tone?

18 A I have no research statements that says that's  
19 fact. It's -- I don't have any research that gives that  
20 fact.

21 Q Do you have any other evidence that would  
22 demonstrate that a customer actually knows that this tone is  
23 a Motorola tone?

24 A From my own personal job related experience,  
25 explicitly it's been interaction with customers who do not

1 refer to it as their radio, but refer to it as their  
2 Motorola radio and, you know, the use of it -- when talking  
3 with them, you know, statements about what sounds it makes,  
4 was it explicit to a 911 tone? No, it was with reference to  
5 the tones that it makes.

6 Q Are you aware whether any other -- whether any  
7 product manufactured by any other manufacturer emits the  
8 same tone?

9 A Define "manufactured".

10 Q I'm stumped. Well, are you trying to distinguish  
11 between manufacturing and assembling, or what?

12 A Integrators --

13 Q Integrators?

14 A We have integrators.

15 Q Who buy Motorola manufactured devices and then  
16 sell them as part of a system, is that what you are talking  
17 about?

18 A Integrators that would purchase a Motorola radio  
19 with -- you know -- with our understanding that they would  
20 be placing it in either their product or a helicopter or  
21 something like that.

22 Q In those situations, is the radio branded as a  
23 Motorola radio, or by the integrator?

24 A I am not sure in all cases. For a particular  
25 case, it is branded as their products on the face of the

1 products -- an E. F. Johnson portable radio, mobile radio.

2 Q Beyond that, that kind of situation, are you  
3 aware of other manufacturers who produce products that emit  
4 a 911 Hz Tone?

5 A No, I'm not aware of any other.

6 Q Have you ever attempted to determine whether  
7 there was any such product?

8 A I myself have not actively sought to investigate  
9 that occurrence. I personally have not.

10 I am not aware -- to the best of my knowledge,  
11 I'm not aware if other people have actively investigated  
12 that.

13 Q Who would you ask if you wanted to find out  
14 whether Motorola -- anyone within Motorola had sought to  
15 determine that fact?

16 A I'm not a hundred percent sure. I would probably  
17 ask members -- or people who are involved with our  
18 Competitive Information Group.

19 Q Who are they?

20 A I specifically interface with Andres LaCambras.  
21 I can't spell that.

22 Q And he's within GEMS?

23 A Yes, he is.

24 Q By the way, GEMS is an acronym, is that correct?

25 A Yes it is.

1 Q What's it stands for?

2 A Government and Enterprise Mobile -- I think it's  
3 Mobile Solutions.

4 Q Okay. Fair enough. Which of the four  
5 organizations -- I'm sorry, let me start over.

6 The Competitive Information Group, is that within  
7 a business unit of GEMS?

8 A It is handled within the business unit of GEMS.

9 Q And what organization within the business unit?

10 A I'm not a hundred percent sure. There are --  
11 there is different people who help on different things.

12 Q Okay. Going back to my first question, the  
13 function that is represented by the 911 Hz Tone as used in  
14 the Motorola products is that the channel is available for  
15 communication or the microphone is active and transmitting,  
16 is that right?

17 A Correct.

18 Q Is there a short version of that that you use to  
19 describe that function in your devices?

20 A The training manuals and the user guide speak to  
21 it in two different ways, depending upon the group that  
22 these manuals are designed for.

23 One refers to it as the Talk-<sup>Permit</sup>~~Permits~~ tone, and  
24 one of it refers to as the Call-Back tone.

25 Q What's the difference between those two?

1           A    The Talk-Permit tone says that you pressed the  
2    PTT button, the push-to-talk button, and the channel is  
3    available, and the microphone is enabled or active for a  
4    Talk-Permit tone to occur.

5           So once the radio is in that state of Talk-Permit  
6    tone, the radio plays the Talk-Permit tone or gives the  
7    Talk-Permit tone.

8           Q    Now, do these 911 Hz Tone products -- those are  
9    the two-way radios we have been talking about --

10          A    Okay --

11          Q    Also emit other tones?

12          A    Yes, they do.

13          Q    How many?

14          A    Somewhere in the range of nine to 12 different  
15    tones.

16          Q    And what are the functions that these other tones  
17    serve?

18          A    They range from -- there is no -- there is no  
19    channel available during communication, so it's a -- it's a  
20    Talk-Prohibit tone, to items like low battery.

21          Q    And do you engage in the same effort to make sure  
22    that successive generations of two-way radio products use  
23    the same tones for consistent functional references?

24          A    Yes, we do.

25          Q    And so these other tones have also been kept



1 consistent over years of two-way radio products?

2 A Yes, they have.

3 Q Was the 911 Hz Tone itself originally created by  
4 Motorola?

5 A To the best of my knowledge, yes, it was.

6 Q When?

7 A To the best of my knowledge, it was developed  
8 during the 1983-1984 product developments efforts.

9 Q What product development effort was that?

10 A It was for the MTX 300T.

11 Q What kind of product was that?

12 A It was -- it was the trunking -- or, you know, it  
13 was a radio that worked on one of the initial Motorola  
14 infrastructure systems.

15 Q Had there been prior products produced by  
16 Motorola that served that same function?

17 A Not to my knowledge. When you say "same  
18 function", give me a little bit of clarity.

19 My response was not a trunking based product. I  
20 wasn't quite sure if that's what you were referring to.

21 Q Okay. So that was the first trunking based  
22 two-way radio product produced by Motorola?

23 A That I'm aware of.

24 Q And how was the 911 Hz Tone created?

25 MR. WILLIAMS: Objection, that's vague.

1           A    A little bit of clarity, please.

2           BY MR. STEWART:

3           Q    Who created the tone?

4           A    The tone was developed between the business --  
5   the business people at the time and the engineering staff  
6   that was developing the tone.

7           Q    Who were the business people involved?

8           A    I do not -- I do not know.

9           Q    Have you attempted to find out who they were?

10          A    I did attempt. I do not have any information to  
11   that point.

12          Q    How did you -- what were your attempts?

13          A    My attempt was speaking with Marlon Moo-Young.

14          Q    Why did you ask him?

15          A    Marlon supports our field products, and the hope  
16   was he potentially had some of the legacy product  
17   documentation available.

18          Q    Is that documentation that would have identified  
19   who the individuals were who developed the tone?

20          A    That was the hope.

21          Q    Did he have such documents?

22          A    No, we did not.

23          Q    Did he have any personal recollection of the  
24   facts that you were looking for?

25          A    He had knowledge of the tone itself in

1 relationship to the MTX 300T.

2 Q What was the basis of that information? I'm  
3 sorry, had he worked on that product?

4 A I do not know.

5 Q What did he tell you about the use of the tone in  
6 relation to the MTX 300T?

7 A That it was the first product to carry it, and it  
8 was ~~it was not~~ MTX 300T came out and, then, it was a  
9 follow-on update to it, if you would, carried the tone, and  
10 that was the initiation of the tone itself as far as  
11 availability.

12 Q Do you know who the engineering people were who  
13 were involved in the development of the tone?

14 A No, I do not.

15 Q Did you seek to find out who they were?

16 A Yes, I did.

17 Q How did you do that?

18 A I went to speak with Marlon.

19 Q Did he refer you to anyone else as a possible  
20 source for this information?

21 A He was unsure of who would have had that specific  
22 information on the MTX 300T.

23 Q Did he suggest any names?

24 A He suggested Rick Lehman.

25 Q Who is that?

1           A    Rick Lehman was the -- was the release manager  
2   for the products, the release manager being defined as the  
3   person who insured what the date was for the product's  
4   release, and that the product met all goals to be released.

5           Q    And did you talk with Rick Lehman?

6           A    I did not.

7           Q    Did you seek to talk to Rick Lehman?

8           A    I did.

9           Q    And what happened?

10          A    He was unavailable every time I went to speak  
11   with him.

12          Q    Did you try to track this information down  
13   through anyone else?

14          A    I did.

15          Q    Who was that?

16          A    I seeked out -- or sought out, I should say,  
17   <sup>Leshin</sup>  
17   Mitch ~~Leshin~~. He was not able to shed any light on the  
18   particulars of the MTX 300T.

19          Q    Is Rick Lehman still with Motorola?

20          A    Yes, he is.

21          Q    What's's his position?

22          A    He is a quality manager.

23          Q    Within GEMS?

24          A    Yes, he is.

25          Q    Is he within the engineering?

1 A Yes, he is.

2 Q Okay. One further question. You talked about  
3 the integrators' use of the Motorola manufactured mobile  
4 radios with -- you used the example, E. F. Johnson branding  
5 on the radio itself, is that right?

6 A Correct.

7 Q And do you know whether that radio emits the  
8 911 Hz Tone?

9 A I do believe it emits the tone. I do believe --  
10 I have not heard the tone, but I do believe it emits the  
11 tone.

12 Q Are there other integrators who operate in the  
13 same fashion?

14 A I do not have direct understanding of how other  
15 integrators operate. They purchase material from Motorola.  
16 That's the extent of my knowledge of other integrators.

17 Q Do you know whether Motorola has a license  
18 agreement with E. F. Johnson for the use of the 911 Hz Tone?

19 MR. WILLIAMS: Objection. That calls for a legal  
20 conclusion. This witness is a fact witness.

21 BY MR. STEWART:

22 Q You may answer.

23 A I don't know.

24 Q Do you know whether Motorola has any license  
25 agreements with anyone for the use of the 911 Hz Tone?

1 MR. WILLIAMS: Same objection. That calls for a  
2 legal conclusion. This is a fact witness.

3 A Again, I do not know.

4 BY MR. STEWART:

5 Q Did you try to ascertain whether Motorola had  
6 such license agreements?

7 A I did.

8 Q How did you do that?

9 A By speaking with Mary <sup>Pitman</sup>~~Pitman~~.

10 Q And what did you learn from Mary <sup>Pitman</sup>~~Pitman~~?

11 A Quite honestly, nothing.

12 Q What did she say about whether Motorola had  
13 license agreements in place for the use of the 911 Hz Tone?

14 MR. WILLIAMS: I'm going to object and instruct you  
15 not to answer to the extent this involved communications  
16 with lawyers.

17 A I can't answer.

18 BY MR. STEWART:

19 Q Is Mary Pitman a lawyer?

20 A I don't know.

21 MR. STEWART: Counsel, will you allow the witness to  
22 answer this question?

23 MR. WILLIAMS: You can answer the question to the  
24 extent that it doesn't involve communications between  
25 yourself and the lawyers.

1 A Actually, I was being honest. I really don't  
2 know. I do not believe she is, but I do not know.

3 BY MR. STEWART:

4 Q I'm going to ask you then to answer my question  
5 specifically, did Mary <sup>Pittman</sup> ~~Pitman~~ tell you -- what did Mary  
6 <sup>Pittman</sup> ~~Pitman~~ tell you with respect to whether Motorola had license  
7 agreements in place for the use of 911 Hz Tone?

8 A There was -- there was work that needed to be  
9 looked at. I mean, there was no answer.

10 Q Was she -- is she still working on developing  
11 that answer?

12 A I am not sure. I haven't seen any  
13 correspondence, but I have not been on my computer or  
14 anything, so I do not know.

15 Q And you exchanged e-mails with Mary <sup>Pittman</sup> ~~Pitman~~ on  
16 this subject?

17 A Yes.

18 MR. STEWART: I would ask for the production of  
19 those e-mails.

20 MR. WILLIAMS: We will take that under advisement.

21 BY MR. STEWART:

22 Q Do you know whether the 911 Hz Tone in its  
23 current configuration existed somewhere prior to the  
24 development of the MTX 300T product?

25 A Not that I'm aware of.

1 Q Is it your belief that someone within Motorola  
2 created it for the first time?

3 A Yes, that is my belief.

4 Q On what do you base that belief on?

5 A I base -- I base that belief on conversations  
6 with Marlon Moo-Young and with Mitch <sup>Leahin</sup> ~~Leahin~~.

7 Q And what did they tell you that led you to that  
8 belief?

9 A The creation of the tone itself has roots in the  
10 time aspects, when they were originally defining the  
11 trunking protocol. These time aspects were specific -- or  
12 were not known or stipulated before that effort.

13 Q Explain that a bit further, if you would. What  
14 time aspects are you referring to?

15 A The first radio was designed such that it would  
16 operate on a -- on this trunking protocol, a particular  
17 language used, communicates. There is expectations that  
18 information will be transmitted in a certain period of time  
19 .

20 These tones are based upon -- my understanding --  
21 a selection of certain groupings of these time periods in  
22 association with a particular selection of a pitch such that  
23 an <sup>aesthetic</sup> ~~esthetic~~ tone was created.

24 Q First, with respect to the time periods, are you  
25 referring to the duration of the entire time or the cadence



1 of the tone?

2 A The cadence.

3 Q And in what way is the cadence related -- I'm  
4 sorry, is the cadence then related technically to the  
5 transmission speed of the trunking protocol that was being  
6 put in place?

7 A Not technically. There is some relationship, but  
8 it's not technically related to.

9 Q In what way is it related?

10 A The radio was producing -- was producing events  
11 every 23 and a third milliseconds. They used that event and  
12 multiples of that ~~events~~<sup>event</sup> to create their cadence.

13 Q I see. Is there any significance to the duration  
14 of the tone in its entirety?

15 A No.

16 Q Is there any significance to the number of sounds  
17 within the tone in its entirety?

18 A No.

19 Q Was the 911 Hz Tone ever produced at a different  
20 frequency?

21 A Can you clarify.

22 Q Was it ever a 900 Hz Tone?

23 A To the best of my knowledge, it has been anywhere  
24 between 909.9999 and 911 based upon just ~~Aaron~~<sup>error in</sup> creating a  
25 frequency, but indistinguishable to the ear of the tone.

1           So the tone audibly has always come across as 911  
2 or -- at that particular frequency pitch.

3           Q   Was there any reason to select that range, 910 to  
4 911, as opposed to another frequency range for this tone?

5           A   It is my understanding that the frequency  
6 generator originally used in the MTX 300T was such that it  
7 could generate a frequency of 150, and they selected a  
8 six-times multiplier of that because of the <sup>aesthetic</sup>~~esthetic~~ness of  
9 the tone.

10          Q   How did you learn this information?

11          A   This was again speaking with Marlon and with  
12 Mitch Leshim.

13          Q   So why -- if the frequency generated 150 hertz,  
14 911 is not a six-times multiplier of 150.

15          A   There is error to the -- to the item, and that's  
16 how it -- it's my understanding that's how they got to that  
17 frequency point.

18          Q   So is it -- was it designed to be 900 Hz, is that  
19 what you are saying?

20          A   No, it was -- it was designed to be -- the  
21 frequency generator is not explicitly 150. It's 150 point  
22 something such that when it multiplies out, it starts  
23 getting higher.

24               It was an understood tool of the time so they  
25 were able to identify what the frequency was going to be.

1 MR. STEWART: Okay. I would like to have marked as  
2 Klein Exhibit 3 a user manual.

3 (Klein Deposition Exhibit  
4 No. 3 was marked as  
5 requested.)

6 MR. STEWART:

7 Q You are now looking at that document, Mr. Klein.  
8 Do you see that document?

9 A Yes, sir.

10 Q Is it a user manual?

11 A To the best of my -- my ability to read it, yes,  
12 it is.

13 Q Okay. And on the page marked MOT 000315 there is  
14 a copyright notice with the dates 1990, 1991; do you see  
15 that?

16 A Yes, I do.

17 Q Is that roughly the time, if you know, that the  
18 STX 800/821 Smartnet products were being sold?

19 A To the best of my knowledge, yes.

20 Q And could you turn to Page 13 of the manual --  
21 it's page MOT 000321.

22 A I'm there.

23 Q And this provides a list of audible tones on the  
24 right-hand side, correct?

25 A Correct.

1 Q Now, the third one is called the Call Back. Is  
2 that the 911 Hz Tone?

3 A Correct, it is.

4 Q And it's described as, "Three short, high pitched  
5 di-di-dit, indicate channel availability". Do you see that?

6 A Yes, I do.

7 Q And if you turn over to the next page on the  
8 left-hand side, Page 14 of the manual, there is a Talk  
9 Permit listing that says "Same as call back"?

10 A Correct.

11 Q Now, -- and that's the 911 Hz Tone as well?

12 A Correct.

13 Q Now, there is no reference to 911 Hz in this  
14 document, is that right?

15 A I have not fully reviewed the document, but it's  
16 my assumption that it is referenced as the Talk Permit or  
17 the Call Back tone.

18 Q And these two tones are in a list of other  
19 audible tones.

20 A Yes.

21 Q And it looks to me like there are 23 of them in  
22 all.

23 A Correct.

24 Q Okay. And are all those tones different from  
25 each other?

1           A    It is my understanding, based upon interaction  
2 with user guides, that if the tone is the same, it would  
3 stipulate that it is the same between the indications of  
4 what the tone means.

5           Q    Okay. As it does with Talk Permit?

6           A    Yes.

7           Q    Okay. If you look below Call Back on 321, there  
8 is Clear Mode Transmit is the next one in alphabetical order  
9 and that's described as a high pitched beep, do you  
10 see that?

11          A    Yes, I do.

12          Q    Now is that beep also at 911 Hz?

13          A    I cannot answer that question. I have not spent  
14 time investigating that particular tone.

15          Q    Are any of the other tones emitted by this radio  
16 -- for these purposes -- emitted at the frequency of 911 Hz?

17          A    I cannot answer the question. I am not -- I've  
18 not researched these tones enough to verify the exact  
19 frequency they operate on.

20          Q    Were all of the tones emitted by the first  
21 product in this line, the 300T, multiples of 150 hertz?

22          A    It is my understanding from discussions that they  
23 were multiples of 150 Hz -- or <sup>150 point-whatever Hz</sup> ~~150 points, whatever Hz.~~

24          Q    150 plus or minus?

25          A    Correct.

1 Q Do you know -- so that presents a somewhat  
2 limited number of potential frequencies at which tones could  
3 be generated, correct?

4 A I believe multiples of 150 Hz.

5 Q Do you know whether any of the other tones in  
6 that radio were at 911 Hz?

7 A Again, I would have to go back and investigate  
8 that particular -- if those tones are consistent, they  
9 should be the same as -- the tones that were in existence in  
10 that product should be consistent with the tones that are  
11 described here in this product.

12 Q Because of your intention to make sure that there  
13 was consistent use across successive products?

14 A Correct.

15 Q And the STX 800 is a successor to the MTX 300T?

16 A Correct, it is.

17 Q Have you looked -- have you looked at any of the  
18 other tones emitted by these 911 Hz Tone products in terms  
19 of analyzing their frequency and cadence and the like?

20 MR. WILLIAMS: Objection, that's vague.

21 A I have not investigated these tones in reference  
22 to 911 -- the 911 Hz Tone.

23 BY MR. STEWART:

24 Q Have you investigated what frequency the other  
25 tones are emitted at?

1           A    No, I have not. I have not investigated the  
2 other frequencies these tones are emitted at.

3           Q    Does the fact that the -- that the first four  
4 tones there or maybe five tones are identified as  
5 "high-pitched" suggest that they are all the same frequency?

6           MR. WILLIAMS:   Objection, that's vague.

7           BY MR. STEWART:

8           Q    Are you able to answer that question. I'm sorry,  
9 I meant to ask you to go ahead and answer.

10          A    It would be presumptuous for me to identify what  
11 intention or what perception a radio would have.

12          Q    Do you know from your actual use of these -- or  
13 experience with these 911 Hz -- I'm sorry.

14                You have actually used 911 Hz Tone product  
15 radios, have you not?

16          A    Yes, I have.

17          Q    Are you familiar based on that experience with  
18 whether more than the Call Back tone is emitted at 911 Hz?

19          A    I cannot say whether more than the Call Back and  
20 Tone Permit tone are at 911 Hz. They are the most often  
21 heard tones that I have in interacting.

22          Q    Do they -- just in terms of frequency alone, do  
23 other tones sound like the same frequency as the Call Back  
24 tone?

25          A    It's difficult to answer because of the different

1 cadences of the tones.

2 Q You can't distinguish between the cadence and the  
3 frequency of a tone?

4 A No, the tones are of X -- frequency X pitch. A  
5 majority of the time, I'm not utilizing the features that  
6 interact with other of these tones, or I am just  
7 particularly not paying attention when they come in such  
8 that I would be monitoring whether they are the same tones.

9 Q Is it possible that multiple tones use the same  
10 frequency on these products?

11 MR. WILLIAMS: Objection, vague.

12 A I do not know.

13 MR. STEWART: Next I would like to have marked as  
14 Klein Exhibit 4 another user manual.

15 (Klein Deposition Exhibit  
16 No. 4 was marked as  
17 requested.)

18 BY MR. STEWART:

19 Q If you would turn first to the page marked  
20 000269. On the left-hand side, there, page eight of the  
21 manual, there is the Talk Permit and the Call Permit -- I'm  
22 sorry -- Call Back alert tones there as well, do you see  
23 that?

24 A Yes, I do.

25 Q And is that the 911 Hz Tone that we are talking



1 about here?

2 A The Talk-Permit tone?

3 Q Yes.

4 A Yes.

5 Q And Call Back also?

6 A Yes.

7 Q And it is described slightly differently from the  
8 previous manual that we looked at, do you see that?

9 A It is -- it is "Dih-dih-dit". The description  
10 specifically -- I need some clarification on the exact --

11 Q It's slightly different, don't you think?

12 A The description of the tone?

13 Q Yes.

14 A There is. There is a greater amount of verbiage  
15 on the second.

16 Q And the second one is the MTX 800. Do you know  
17 where that fits in terms of time? There is not a copyright  
18 date on this one -- vis-a-vis the STX 800?

19 A It is my recollection that the MTX 800 was the  
20 follow-on to the STX products.

21 Q Okay. And over on the page 000271 --

22 A Excuse me, which page?

23 Q 000271, a couple of pages later, under -- in the  
24 upper left-hand side of the page, "Making Dispatch Calls",  
25 that is a description, is it not, of the generation of the

1 911 Hz Tone that we have been talking about?

2 A Yes, it is.

3 MR. STEWART: Okay. Now, one more user manual. I  
4 would like to mark this as Klein Exhibit 5.

5 (Klein Deposition Exhibit  
6 No. 5 was marked as  
7 requested.)

8 MR. STEWART:

9 Q Now, this has a copyright date on the second page  
10 -- no, where is it.

11 MR. WILLIAMS: I think you gave me something extra  
12 here. This isn't part of 5.

13 MR. STEWART: Thank you.

14 A What page are you on?

15 BY MR. STEWART:

16 Q It actually on 2207. There is a 2003 copyright  
17 date.

18 A 2207?

19 Q Right.

20 A There is a 2003 copyright, correct.

21 Q Now, is this a current product?

22 A This is a currently shipping product.

23 Q Do you know whether this is the current user  
24 guide for this product?

25 A This is the current user guide, to the best of my

1 knowledge, specific to the Project 25 version of this  
2 product.

3 Q And what is Project 25?

4 A It is a -- the open -- it's an organization that  
5 has helped to define the APCO communication standard that we  
6 have branded as Astro for our features and functions that  
7 support that standard.

8 Q And that standard is an interoperability  
9 standard, is that right?

10 A It is an open protocol, so it does create  
11 interoperability.

12 Q Now, if you turn to 2215, which is page six of  
13 the guide, you see here we have the list of tones again?

14 A Correct.

15 Q This one is different because it is -- the tones  
16 are grouped together with -- under a "Sound" description, do  
17 you see that?

18 A Yes, I do.

19 Q If you turn over to the page labeled 2217 which  
20 is page eight of the user guide --

21 A Correct.

22 Q Do you see under "Sound" it says, "A Group of  
23 Medium-pitched Tones", do you see that?

24 A Yes, I do.

25 Q And Talk Permit is one of those tones?

1           A    Yes, it is.

2           Q    Now, does that mean that the -- that the  
3 frequency of the tone was changed in this product?

4           A    No, it was not.

5           Q    But it's described as medium-pitched as opposed  
6 to high-pitched here?

7           A    Yes, it is.

8           Q    Do you know why that is?

9           A    It's my understanding -- and this is strictly  
10 based upon personal experience in helping to work on these  
11 manuals -- that there was an attempt to help organize these  
12 tones so that it was easier to reference.

13          Q    And they were thus grouped by -- I guess for this  
14 purpose, it's the pitch or frequency, right, the group of  
15 medium-pitched tones, is that right?

16          A    And a majority of these tones are grouped in that  
17 manner.

18          Q    And for the group of medium-pitched tones that  
19 includes the Talk-Permit tone, do you know whether all of  
20 those tones used the same frequency?

21          A    I cannot at this point say.

22          Q    You are presenting this to a user as a group of  
23 tones that are related in terms of their pitch, is that  
24 right?

25          A    Yes, we are.

1 Q But you don't know whether the pitch is actually  
2 the same?

3 A I do not to for sure. I would have to  
4 investigate.

5 Q If the pitch were the same, what would be the  
6 basis on which to distinguish from among these tones?

7 A My assumption, purely my assumption, would be  
8 cadence and length, over all length of tones.

9 Q And there is no indication of cadence and length  
10 for this group of tones, right?

11 A No, there is not, not that I see. I do not know  
12 if there is additional information, and I have not fully  
13 reviewed this document.

14 Q Do you want to take a minute to flip through that  
15 and see if you find anything else?

16 A Yes.

17 Q Where are you looking?

18 A On page -- I selected Dispatcher-Interrupt on  
19 page 44, MOT 002253. "Dispatcher-Interrupt: The  
20 Dispatcher-Interrupt feature allows the dispatcher to  
21 interrupt your radio and place you in a private conversation  
22 call with a dispatcher.

23 "When you receive -- when your radio receives a  
24 Dispatcher-Interrupt call, you hear a repeating sequence of  
25 four, short medium-pitched tones until you answer the call".

1                   That is different than the description for the  
2 Talk Permits.

3                   Q    Okay.

4                   MR. STEWART:   This would be a good place for me to  
5 break for lunch if you are ready to do that.

6                   MR. WILLIAMS:   That's fine.

7                   THE VIDEOGRAPHER:   This is the Videographer. The  
8 time is 12:30 p.m. We are going off the record.

9                                       (Whereupon, at 12:30 p.m., the  
10 deposition was recessed, to  
11 reconvene at 1:30 p.m., this  
12 same day.)  
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## AFTERNOON SESSION

(1:38 p.m.)

THE VIDEOGRAPHER: We are going back on the record. This marks the beginning of videotape Number Two, Volume One, in the deposition of David Klein. The time is 1:38 p.m.

DAVID ERIC KLEIN,  
the witness at the time of recess, having been previously  
duly sworn, was further examined and testified as follows:

## EXAMINATION (resumed)

BY MR. STEWART:

Q Good afternoon, Mr. Klein. What was the alleged date of first use of the 911 Hz Tone as a mark in commerce according to Motorola?

MR. WILLIAMS: Objection, that calls for a legal conclusion based on Patent and Trademark Office filings. This witness is a fact witness.

BY MR. STEWART:

Q Please answer.

A Can you clarify commerce. I'm not sure of the answer nor do I understand the statement of commerce.

Q It's evident from the face of the trademark application that we have already introduced into the record

1 that Motorola has asserted that the date of first use of the  
2 911 Hz Tone as a mark in commerce is May 6, 1991. Are you  
3 aware of that?

4 MR. WILLIAMS: Objection. Again, that's a legal  
5 conclusion based on Legal Department filings.

6 BY MR. STEWART:

7 Q Are you aware of the date May 6, 1991 as having  
8 been asserted to the Patent and Trademark Office, as the  
9 date of first use?

10 A I'm aware -- I read that date in one of the  
11 documents.

12 Q That's all I'm asking. Good.

13 What happened on that date?

14 A You've got to clarify, if you could, please.

15 Q What about May 6, 1991 led Motorola to assert it  
16 as a date of first use of the mark in commerce?

17 MR. WILLIAMS: Objection. Again, this is a question  
18 relating to a legal filing in the Patent and Trademark  
19 Office.

20 A I'm unaware of the specific events that occurred  
21 on that particular date.

22 BY MR. STEWART:

23 Q Have you sought to find out what happened on that  
24 particular date?

25 A No, I have not.



1 Q Was there any difference in the 911 Hz products  
2 that manifested itself on May 6, 1991?

3 A To the best of my knowledge, the consistency that  
4 has occurred with the tones, the 911 Hz, before and after  
5 the -- the May 11th, 1991 --

6 Q May 6th.

7 A I'm sorry, May 6th, 1991, those tones were  
8 consistent before and after that date.

9 Q Was there any other change in the products in  
10 which the 911 Hz Tone was incorporated on or around May 6,  
11 1991?

12 A The only product change would be the availability  
13 of potentially additional products that utilize the 911 Hz  
14 Tone.

15 Q When did that happen?

16 A That's a consistent process as we develop the  
17 products. This was -- that was a timeframe where we were  
18 developing the MTX, MTS variant of products.

19 Q Particularly in May of 1991, was there any  
20 product introduction or any other change in the products  
21 themselves?

22 A I do not know of any particular change associated  
23 with that specific date. I'm not aware of any.

24 Q Was there a change in May of 1991 in the  
25 marketing of 911 Hz Tone products?

1           A    I'm unaware of any change or deviation from the  
2 consistent marketing of the 911 Hz.

3           MR. STEWART:   I would like to have marked as Klein  
4 Exhibit 6 a document entitled "911 Hz Tone Information."

5                               (Klein Deposition Exhibit  
6                               No. 6 was marked as  
7                               requested.)

8           MR. STEWART:

9           Q    Have you seen this document before?

10          A    I have seen this document before.

11          Q    What is it?

12          A    It's my understanding that this document  
13 stipulates -- stipulates products that used the 911 Hz Tone.

14          Q    Who is -- or what is TAG Marketing, T-A-G  
15 Marketing?

16          A    The America Marketing -- The America Group  
17 Marketing.

18          Q    And who are they?

19          A    It is the marketing group that is specific to  
20 North America and Canada.

21          Q    The marketing group within Motorola?

22          A    I'm sorry, for clarity, it is the GEMS subscriber  
23 marketing group, the group that is used for defining the  
24 products, subscriber products that work on infrastructure  
25 and conventional operation for North America, particularly

1 the direct sales force.

2 Q When you talk about subscriber infrastructure and  
3 conventional products for North America, what -- what's  
4 meant by the term "subscriber" in that context?

5 A Subscriber is our internal nomenclature to define  
6 a hand-held radio or radio that gets installed in a vehicle  
7 of that type -- a mobile portable type of device.

8 Q As opposed to?

9 A As opposed to infrastructure which would be an  
10 installed tower and such.

11 Q So when did you first see this document?

12 A I did see this in March of this year.

13 Q What were the circumstances?

14 A The circumstances were I helped to collect the  
15 information that appeared -- this listing of features -- or  
16 excuse me, of products.

17 Q So you directed the TAG Marketing people to  
18 collect this information?

19 A I am part of the TAG Marketing team.

20 Q I see. So who actually collected the  
21 information?

22 A It was myself on behalf of my manager to collect  
23 this information.

24 Q So you produced this document to begin with?

25 A I do not know if I produced this particular

1 variance. This is the information I provided. To the best  
2 of my knowledge, it appears to be the information I turned  
3 over to my manager.

4 Q Is this the complete document?

5 A It appears to be from what I am aware of -- from  
6 my interaction.

7 MR. STEWART: I would like to mark as Klein Exhibit 7  
8 a one-page document entitled, "Post-1991 Indirect Radios  
9 with 911 Hz Trunking Clear-to-Talk or Talk-Permit Tone".

10 (Klein Deposition Exhibit  
11 No. 7 was marked as  
12 requested.)

13 BY MR. STEWART:

14 Q Have you seen that document before?

15 A I've not seen this particular document.

16 Q Okay. Going back to 6, who asked for the  
17 collection of the information about 911 Hz Tone products?

18 MR. WILLIAMS: Objection, that's vague.

19 BY MR. STEWART:

20 Q I'm sorry. I will rephrase that. Who asked for  
21 the information that is presented in Exhibit 6?

22 A This information was requested on behalf of my  
23 manager.

24 Q And who is your manager again?

25 A ~~Curt Braesh.~~  
Kurt Brasch

1 Q And what was his purpose, if you know, in asking  
2 for this information?

3 A He had received requests for this particular  
4 information and delegated that responsibility to me.

5 Q From whom did you receive the request?

6 A I do not know.

7 Q Do you have an understanding as to why this  
8 information was being collected in March of 2005?

9 A It was my understanding as per a discussion with  
10 my manager that this was a request for information for a  
11 trademark -- for the 911 Hz Tone.

12 Q For a new trademark application?

13 A I do not know. It was just in reference to a  
14 trademark of the 911 Hz Tone.

15 Q Were you aware in March of 2005 that Motorola had  
16 filed an application for registration of the 911 Hz Tone as  
17 a trademark?

18 A No, I was not aware.

19 Q Now, if you turn to the third page of this  
20 document, you see it's headed, "Pre-1991 Radios"?

21 A Correct.

22 Q And then the next page is headed, "Post-1991  
23 Direct Radios", do you see that?

24 A Correct.

25 Q What was the reason for distinguishing based on

1 the 1991 date?

2 A The request that I received, to the best of my  
3 knowledge -- the best of my recollection is that my manager  
4 requested that I find -- identify radios 1991 and later that  
5 utilized the 911 Hz Talk-Permit tone, Call-Back tone, versus  
6 -- he put that request out for clarity. For clarity, he  
7 mentioned that there were pre-1991 products available also,  
8 and he said give me a complete list.

9 So I myself identified pre and post based upon  
10 the initial request.

11 Q Did you ask him why he had specified 1991 as a  
12 demarcation?

13 A Honestly, I did not.

14 Q Do you have an understanding as to why he did?

15 A At the time of the request, I did not.

16 Q Do you now?

17 MR. WILLIAMS: Objection to the extent that your  
18 answer would call for privileged communications between  
19 yourself and the lawyers.

20 BY MR. STEWART:

21 Q Can you answer the question?

22 MR. WILLIAMS: If it involves discussion with the  
23 lawyers, I'm going to ask you to not answer the question.

24 A The only assumption I can make is because the  
25 dates showed up in the documents that you have showed me

1 already.

2 BY MR. STEWART:

3 Q What's the significance of the copyright date at  
4 the bottom of the first page, it says 2003?

5 A What does not come through, unless you print in  
6 color, is the design which is our internal -- I'm sorry, I  
7 stand corrected.

8 The -- what does not come through also is color  
9 and any formation -- artistic formations, but the copyright  
10 I believe is in relationship to Motorola and any -- this is  
11 from a template that's used that can carry the Motorola  
12 logo, and it was an older template that I had been using.

13 Q I see. Now, if you turn to the second page of  
14 Exhibit 6 --

15 A Okay.

16 Q Labeled 002265 -- do you see that?

17 A Yes, I do.

18 Q The second bulleted paragraph labeled  
19 "Consumer/cellular Support", do you see that?

20 A Yes, I do.

21 Q What is the significance -- or what's the meaning  
22 of that section of this page?

23 A This section was to define the development team  
24 that moved from our radio based group to support for our --  
25 was at that point referred to Gemini and later to Mirs,

1 M-i-r-s, and then to iDEN. They carry forward a similar  
2 need to have a Talk-Permit tone.

3 Q So Mirs and Gemini were the names of teams  
4 internal to GEMS?

5 A Yes, they were -- they were nomenclature for just  
6 identification of a development team.

7 Q And was iDEN also a -- within GEMS?

8 A At that point, when they became iDEN, they were  
9 moved out of the GEMS organization.

10 Q And what time period was that?

11 A To the best of my recollection, and my personal  
12 knowledge, I believe the timeframe was around mid 1995.

13 Q And what -- into what division of the company  
14 were they moved?

15 A I believe -- I believe the organization is called  
16 Networks.

17 Q You had previously identified GEMS mobile  
18 devices, connected home --

19 A I was missing the fourth. The fourth is  
20 networks.

21 Q Okay, I've got you. And what does it mean --  
22 "The iDEN team altered the period"?

23 A They altered the tone, tone being a mix of the  
24 actual pitch, the frequency of the tone and also the -- the  
25 duration and items that make up the actual sounds.



1 Q And who on iDEN team did that?

2 A I do not know a specific name.

3 Q Who were on the iDEN team? I'm sorry, these are  
4 people -- this was a team that moved out of the organization  
5 you were joining in 95, is that right?

6 A I joined in 1995. These people had already  
7 separated from the development team I was involved with at  
8 the period of 1995.

9 Q So how did you come by this information that they  
10 altered the period?

11 A I spoke to Marlon Moo-Young who, it is my  
12 assumption, had working knowledge of these facts as he was  
13 in the Gemini/Mirs/iDEN team at one point.

14 Q And the first product -- I'm sorry, in  
15 parenthesis in that first subsection, under the second  
16 bullet, it says, parens, "Timeframe for the actual tone",  
17 close parens. What did you mean by that?

18 A There was a modification of the frequency, there  
19 was a modification of the duration, there was a modification  
20 of the cadence of the tone.

21 So there was multiple aspects of the sounds that  
22 changed, that made it unique to the 911 Hz Tone.

23 Q Were there technical reasons for altering those  
24 aspects of the tone?

25 A I am not aware or I have not discovered any

1 evidence to say one way or the other.

2 Q Do you know whether the network protocols are  
3 different between iDEN and the trunk two-way radio protocols  
4 used by Motorola?

5 A The network protocols are different between the  
6 two, but the products in that timeframe did not require the  
7 protocol timings to generate tones.

8 Q We have moved beyond what you described with  
9 respect to the MTX 300T, is that right?

10 A Correct.

11 Q Now, the second -- the last line on this page  
12 says, "The first product to support this was released in  
13 1991". Do you see that?

14 A Yes I do.

15 Q What does that mean?

16 A The first -- in conversations with Marlon  
17 Moo-Young, it's my understanding that the first products  
18 that actually exhibited this modified tone or sounds was  
19 available for at least listening, beta testing or some type  
20 of function where the tone could be exhibited in 1991.

21 Q Do you know which of those was available in beta  
22 testing?

23 A I do not know at this point. I do not know if  
24 based upon conversations what -- what aspects.

25 Q And is it your understanding that that 1991

1 availability of the tone was an availability of the non 911  
2 Hz Tone, or an availability of the 911 Hz Tone in iDEN  
3 related products?

4 A No, the availability -- the product to support  
5 this was released in 1991. That availability was based upon  
6 the altered modified version of the sounds.

7 Q Now, were you asked to investigate tones used  
8 with respect to iDEN products?

9 MR. WILLIAMS: Objection to the extent that the  
10 question calls for communications between yourself and the  
11 lawyers.

12 A No, I -- my manager did not request for me to  
13 focus on those. He requested the products that I had  
14 working knowledge or the ability to have working knowledge  
15 of.

16 Q So did this second bulleted item on page two not  
17 result from your manager's direct request?

18 A Correct.

19 Q You mentioned before that there were variants of  
20 this document, is that correct?

21 A I do not know if it was placed into a larger  
22 document or not with my reference to variants of this  
23 document.

24 Q Who would have placed it in a larger document?

25 A I did not know if, say, this one that has a very

1 similar formatting was a page of this document or not. I'm  
2 only aware of the information that I provided and supplied  
3 to my manager.

4 Q And is Exhibit 6 exactly the form in which you  
5 provided the information?

6 A From what I can see, to my best understanding, it  
7 does appear to be the form which I delivered it.

8 Q Well, why would you have suggested that there  
9 would be -- that there may be a larger document of which  
10 this form is a part?

11 MR. WILLIAMS: Objection, that mischaracterizes his  
12 testimony. He did not say that.

13 A To be clear, I did not know if I was turning over  
14 information to be compiled into a larger document.

15 BY MR. STEWART:

16 Q Did your manager tell you anything that indicated  
17 that that might be the case?

18 A No.

19 Q Did you ever see another document that included  
20 this information?

21 A No.

22 Q To whom was this document distributed?

23 MR. WILLIAMS: Objection, vague.

24 BY MR. STEWART:

25 Q This document, referring to Klein Exhibit 6.

1           A    I do not know. I gave this -- submitted this to  
2 my manager.

3           Q    Did you submit it to anyone else?

4           A    No, I did not.

5           Q    Did you ever have a discussion of the information  
6 included in this Exhibit 6?

7           MR. WILLIAMS:   Objection to the extent your answer  
8 will call for a disclosure of communications between  
9 yourself and the lawyers.

10          A    The discussion I had with this information was  
11 pertinent to understanding what products were producing the  
12 911 Hz Tone for verification.

13          BY MR. STEWART:

14          Q    So did you have discussion about this information  
15 with people other than your manager?

16          A    I had discussions with Marlon Moo-Young and Mitch  
17 Leshim about the contents in this document.

18          Q    Did you show them this information after you had  
19 compiled it in March of 2005?

20          A    Not that I'm aware of.

21          Q    So you talked -- you said before that you had  
22 talked with those two individuals within the last two or  
23 three weeks, is that right?

24          A    Yes.

25          Q    Did you also talk with them prior to March 2005

1 in compiling the information that's in Exhibit 6?

2 A The information that's in Exhibit 6, I talked  
3 with Marlon Moo-Young. I believe I had a conversation with  
4 Mitch Leshim. I do not know if specific information came  
5 from Mitch or from Marlon.

6 Q At that time, in March of 2005 and before, who  
7 else did you talk with about 911 Hz Tone products?

8 MR. WILLIAMS: Objection. I instruct you not to  
9 answer if your answer were to involve discussions with  
10 lawyers.

11 A Can you clarify.

12 BY MR. STEWART:

13 Q Yes, let me rephrase that.

14 In responding to your manager's request for you  
15 to compile information about 911 Hz Tone products, in March  
16 of -- in March or prior to March of 2005, did you speak with  
17 individuals other than Marlon Moo-Young and Mitch Leshim?

18 A The only other person I would have spoken to, and  
19 I believe he was available at the time I would speak with  
20 Marlon, was his manager, Tim Quirey.

21 Q Tim Quirey. Did you collect any documentation at  
22 that time in support of the information you've compiled in  
23 Exhibit 6?

24 A None that I'm aware of. This collection of  
25 information was taken from lists of products that we had

1 developed over the years.

2 Q And looking now at Exhibit 7, do you see that  
3 it has a similar graphic format and title to parts of  
4 Exhibit 6?

5 A I do.

6 Q What do you make of that?

7 MR. WILLIAMS: Objection, vague.

8 A We have standard templates within the corporation  
9 so we have the same look and feel across documents.

10 MR. STEWART:

11 Q Okay. Tell me what classes of customers are  
12 there for the 911 Hz Tone products?

13 MR. WILLIAMS: Objection, that's vague.

14 A Can you clarify? What do you mean "classes of  
15 customers".

16 BY MR. STEWART:

17 Q Has Motorola identified any classes of potential  
18 customers for purchases of 911 tone products?

19 A Have we identified if Motorola -- specifically  
20 the GEMS organization -- sells to customers who require  
21 private system communications systems, so that they can have  
22 control of their communication methods?

23 Q Yeah, okay. What kinds of customers buy 911 Hz  
24 Tone products?

25 A The types of customers are normally, but not

1 specifically, in the public safety arena, purchasing agents  
2 and groups like that, the customer who interacts with the  
3 sales force.

4 There is fire departments and other parts of the  
5 public safety grouping. There are enterprise organizations  
6 that require a dedicated communication system, critical  
7 infrastructure, which would be typified by utilities and  
8 other organizations like that.

9 And that is a fairly broad estimate of the types  
10 of customers that the direct sales force interacts with.

11 And we then also work with <sup>lessors</sup> ~~leasers~~ of systems  
12 where they purchase infrastructure and then lease out the  
13 products to the eventual end user.

14 Q Can you give me an example of that kind of  
15 customer?

16 A Off the top of my head, it could be a  
17 communication company. I don't want to give specific names  
18 because I don't know if they are specifically in this  
19 configuration, where they would -- they will have a  
20 communication system set up over a city, and they would  
21 lease out or sell radios to, say, construction companies,  
22 where the construction company is not required to install  
23 their own communications, but this allows communication at  
24 multiple sites.

25 Q Has this -- those are three different kinds --



1 public safety, enterprise organizations and lessors of  
2 systems.

3 Are there more kinds of customers who buy these  
4 products?

5 A There are -- I mean, that is our majority  
6 numbers. I mean, there are groups, you know -- news groups  
7 purchase these radios sometimes such that they can get them  
8 programmed up to be able to listen to police activity for  
9 information, and things like that.

10 There are people who work at oil refineries.  
11 There is -- these particular products I've listed --  
12 customers I've listed are focused on, the voice-based  
13 products that integrate with the system and the  
14 infrastructure.

15 Q And have these kinds of customers -- let me start  
16 over again.

17 Back in 1991, were there different kinds of  
18 customers who bought 911 Hz products?

19 A Not that I'm aware of.

20 Q Okay. What are Motorola's principal competitors  
21 for products like the 911 Hz Tone products?

22 A Specific to -- specific to the competition in  
23 using the 911 Hz, or, you know, the 911 Hz would indicate  
24 that you are referring to system or trunking based products.  
25 Am I understanding -- am I understanding the question?

1 Q I think we talked earlier this morning about the  
2 911 Hz products being trunking-based voice services for  
3 which that particular type of availability, channel  
4 availability message was appropriate, and I guess rather  
5 than my saying that, I will take your limitation. That's  
6 right. We are talking about trunked voice systems.

7 A Okay. Of competitors that operate on a trunked  
8 voice system, there is E. F. Johnson, there is Macom, there  
9 is Kenwood, there is Icom, there is Vertex; there is  
10 probably going to be more competitors in the future, and  
11 there is probably competitors in the past.

12 But of the ones that are primary competitors, I  
13 believe it's those five.

14 Q And does each of those five sub products that  
15 include a -- a Talk-Permit tone or a Call-Back tone?

16 A It would be my assumption that those products  
17 would require some type of indication to notify the user  
18 that take either the channel is available or that the <sup>microphone</sup> ~~the~~ ~~is~~ ~~active~~ ~~is~~ ~~active~~  
19 is active.

20 Q I think we talked before, but let's confirm it  
21 here. Have you done any investigation to determine whether  
22 any of the products of any of those five companies produce  
23 a 911 Hz Tone?

24 A Currently we are investigating the audio and  
25 other aspects of those devices. Due to the nature and

1 requirements of how you have to configure the products, we  
2 are working through some details.

3 Right now we do not have elements that are  
4 working, say, from Macom or Kenwood, or of these other  
5 competitors that we do have.

6 Q I'm sorry, I don't understand your answer.

7 A The radio needs to be operating on a system such  
8 that you have an opportunity to be in a situation where the  
9 radio would generate that tone.

10 And currently we are working through some issues  
11 to actually get the radio we do have up on a system so we  
12 can validate the performance.

13 Q Okay. So you do have two-way radio devices from  
14 those five manufacturers?

15 A We do.

16 Q And you are unable to perceive tones generated by  
17 those products?

18 A Currently we are now focusing on that aspect.

19 Q And what is the purpose of your investigation of  
20 those devices?

21 MR. WILLIAMS: Objection to the extent your answer  
22 will require you to divulge communications between you and  
23 your lawyers.

24 A We have spent time identifying the robustness of  
25 the physical products. We are now evaluating the

1 performance of these products, and these would include any  
2 tones it generates, response on a system, and overall radio  
3 performance.

4 Q And that is yet to be accomplished as you have  
5 said, correct?

6 A Correct.

7 Q And to your knowledge, has Motorola engaged in  
8 any -- in an investigation of those performance  
9 characteristics of competitors' two-way radios before now?

10 A It is an ongoing -- it is an ongoing process. We  
11 have had previous products that we focus on the durability.

12 We are now trying to establish operational  
13 performances. But we also have -- when working on user  
14 systems that have a mix of products, we are -- they are  
15 evaluating their performance.

16 Q Do these products have an array of features or  
17 functionalities that would require them to have multiple  
18 different tones as the 911 Hz Tone products we looked at  
19 earlier today?

20 A It would be my assumption, and I would consider  
21 this a reasonable assumption that it would generate  
22 different tones.

23 We have certainly heard different tones not in a  
24 trunked operation, but different tones come from the device.  
25 So I think it would be a fine assumption to say that it

1 would produce multiple tones while operating in that mode.

2 Q How have you heard different tones coming from  
3 the device?

4 A Powering the device on, entering menus,  
5 interaction with the devices.

6 Q And how did you acquire those devices?

7 A Through purchase.

8 Q Is it possible then to purchase a device, one of  
9 these two-way radio devices, without having them  
10 operational?

11 A Can you clarify.

12 Q Well, you said that you are not able to make them  
13 make the -- the call-back tone at this point, is that right?

14 A You can purchase a product that is not configured  
15 to operate on a system such that you could observe its  
16 performance on a trunk system.

17 They would still operate. You could make it  
18 operate without any type of restriction in a unit-to-unit  
19 perspective, but operation on a trunked system does require  
20 security methods that are applied for configuration for a  
21 particular system. That's done on the user's behalf for  
22 security.

23 Q Okay. And the Talk-Permit tone and the Call-Back  
24 tone are only accessible in a trunked operation mode, is  
25 that right?

1           A    It is -- the tone is generated once the radio is  
2 configured for transmission on a trunk system.

3           Q    Does it have to be -- I want to talk to you about  
4 that next. In fact, you mentioned before that at trade  
5 shows and in sales rep visits to client facilities, you  
6 arrange to have the devices operational so they can be  
7 demonstrated, is that right?

8           A    That is true.

9           Q    Okay. Exactly how does that work? Let's look at  
10 trade shows first.

11          A    That's the easiest configuration. We bring our  
12 own system such that they are configured to operate, and  
13 they are on display in the trade show, on the floor, for  
14 customers such that, you know, they can wander around and  
15 use the products, interact with it.

16               They hear the tone as they were transmitting back  
17 and forth between -- between different people utilizing the  
18 radios.

19          Q    And just so I'm clear, in a trunked operation,  
20 there is a base station that is -- that operates wirelessly,  
21 is that correct?

22          A    There is a -- there is a base station that is  
23 communicating over the air to the radios.

24          Q    Right. And without that base station in place,  
25 these radios -- we talked before about the fact that they

1 are capable on a unit-to-unit basis. They would be able to  
2 communicate with each other, correct -- just by turning them  
3 on?

4 A By turning a radio on, if it is configured, you  
5 can communicate with another radio directly if it's  
6 configured.

7 Q I see. And are the 911 Hz Tone products sold by  
8 Motorola configured for either mode of operation, or does it  
9 depend on the customer's requirements?

10 A Depending upon how the product is configured, it  
11 can do either unit-to-unit, or unit-to-unit and  
12 infrastructure-based communications.

13 Q Now, what is the difference from the -- what is  
14 the difference in communications capability as between the  
15 trunked operation and the unit-to-unit operation?

16 A And this is -- I'm going to ask for clarity  
17 because there could be several aspects here.

18 So can you give me a little clarity here?

19 Q Is group call possible in a unit-to-unit  
20 configuration?

21 A If I'm configured in a unit-to-unit mode, if I  
22 press the Push-to-Talk button, the microphone becomes  
23 active. I will communicate to multiple units who are  
24 configured to receive my transmission.

25 Q Okay. So when you go to a trade show, you set up

1 a base station and configure the handsets to operate via  
2 trunked operation, is that right?

3 A Correct.

4 Q And then what happens? A potential customer  
5 comes to the booth. What happens?

6 A A customer can come to the booth and have a  
7 conversation with either the staff that's first on the  
8 products, or with their -- a direct sales member, and they  
9 would converse, they would be able to use the products,  
10 interact.

11 At that point, the tone is audible when  
12 transmission is occurring through the base station. The  
13 unit is generating the tone, and it's showing the forms and  
14 functions of the products.

15 Q And do sales people for Motorola demonstrate the  
16 functions of the handsets?

17 A It depends upon the situation. They could.  
18 There could be a -- it's normally a Motorola employee who is  
19 there, you know, going through the process.

20 Whether it is the direct sales force person,  
21 whether it is a business member who is at the booth, or  
22 whether it is a booth staff, it's just showing the operation  
23 availability of the features.

24 Q Does this kind of a trunk operation require an  
25 FCC license?



1           A    Yes, it does, for these particular products.

2           Q    And does Motorola have that license?  Is that how  
3 it demonstrates these capabilities at trade shows?

4           A    I go under the assumption.  I do not know for  
5 sure.  I would assume, but that's not -- I'm not part of  
6 that effort.

7           Q    Or a customer could have a license, is that  
8 right?

9           A    Correct, correct.

10          Q    So if a customer doesn't -- well, looking back at  
11 your competitors' products that you are looking at, what is  
12 it that's preventing you from being able to observe the same  
13 performance capabilities?

14          A    The -- for security purposes on products,  
15 customers have requested that you require a security method  
16 to limit the programming of the products.

17               Currently we have -- we have a system at my  
18 particular facility where I am based that we are looking to  
19 place these products on that system with the frequencies  
20 that we have from the FCC.

21               We are just in the middle of getting the security  
22 methods such that we can program these appropriately to  
23 operate on the system.

24          Q    And is it the case generally that it's possible  
25 to use two-way radio devices from one manufacturer on

1 another manufacturer's infrastructure?

2 A It depends upon the infrastructure that they  
3 operate on. The -- we already spoke of the Astro Project 25  
4 system, which is an open standard.

5 Q Yes.

6 A Such that these products operate on that open  
7 standard. Then there are other standards that they do not  
8 operate on.

9 Q And do any of your customers have handsets from  
10 competing manufacturers that they use on the same system  
11 with which -- on which they use Motorola 911 Hz Tone  
12 products?

13 A Again, it depends upon the type of system they  
14 operate on.

15 Q But the answer is yes, some of them do?

16 A For an Astro 25 -- or the APCO Project 25 system,  
17 they can have multiple vendors on it.

18 On previous systems, it was Motorola products  
19 only, and we have -- we have an agreement with E. F. Johnson  
20 such that they can produce products that work on that system  
21 also.

22 Q Have you seen that agreement?

23 A No, I have not.

24 Q How long has it been in place?

25 A I do not know.

1 MR. STEWART: We would ask for that to be produced  
2 to the extent it's responsive to our discovery requests,  
3 which it sounds to me as though it may be.

4 MR. WILLIAMS: We will take that under advisement.

5 BY MR. STEWART:

6 Q Okay. So let me ask you the more general  
7 question now that we have talked about the details.

8 What conditions and actions or any other  
9 circumstances are necessary for a potential customer to be  
10 able to hear the 911 Hz Tone?

11 A When you say potential customer, are you assuming  
12 that they have infrastructure or a system already in place  
13 or not?

14 Q Let's assume that they don't.

15 A They don't. If they came to any trade show where  
16 we have a system installed for display of products for  
17 operation of products, they would just have to approach the  
18 booth or speak with their direct sales Motorola employee,  
19 and they could have a presentation of the products.

20 Q So it's necessary to have the infrastructure in  
21 place and the product configured to work with the  
22 infrastructure on a trunked basis?

23 A Correct.

24 Q Okay. And once those conditions are satisfied,  
25 the potential customer could hear all of the tones that are

1 emitted by this device?

2 A They would be able to hear the tones associated  
3 with the -- with the operation of the radio for which it was  
4 configured for. By putting it on the system does not mean  
5 they hear all the tones.

6 Q Are there circumstances under which it would be  
7 put on a system and they would not hear the Talk-Permit  
8 tone?

9 A There is a situation in which -- for a mode  
10 called surveillance where the radio is meant to be  
11 completely quiet. There would be no tone that would come  
12 out of the micro -- out of the external speaker, but would  
13 be heard with an ear piece.

14 Q And that's true for the sender and the receiver?

15 A The tone is not -- does not transmit over the air  
16 for the receiver to hear. The tone is in the product.

17 The user who is trying to transmit the tone is  
18 instructional as far as you can now transmit and, again, in  
19 relationship to this is a -- a Motorola product.

20 Q So what's the difference between the Talk-Permit  
21 tone and the Call-Back tone?

22 A A Call-Back tone is if the channel is busy and I  
23 get a tone telling me so. Then, once the channel is  
24 available, you hear the Call-Back tone saying essentially  
25 you can now try again.

1           When you try again, if the channel is still  
2 available, you will again hear your Talk-Permit tone. The  
3 radio says here is -- I'm playing you this tone to tell you  
4 that the microphone is available for you, please start  
5 communicating.

6           Q   In this situation at a trade show, when potential  
7 customers were using the phone and they could hear the  
8 Talk-Permit tone, was that always in connection with the  
9 actual operation of the Talk-Permit function?

10          MR. WILLIAMS:   Objection, that's vague.

11          A   Yes.

12          BY MR. STEWART:

13          Q   Let me ask it this way:  When you push the button  
14 and you heard the tone, that's because the -- the channel  
15 function was working, is that right?  The communication  
16 channel open function was working?

17          A   The Talk-Permit tone from its inception has  
18 always indicated that when you hear this tone, you are being  
19 told that either there is a channel available for you now,  
20 or that the channel has been -- you know, essentially you  
21 have the channel.  The microphone is active.  You can now  
22 speak.

23          Q   And were there times -- are there times, I'm  
24 sorry, when the tone is heard and that's not the case?

25          A   No.  The tone is specific to -- the sound is

1 specific to those events.

2 Q Was the 911 Hz Tone -- I'm sorry.

3 Let me -- in the context you've described earlier  
4 in which a sales rep would go to a customer facility, how  
5 then would that work? How would the tone be demonstrated in  
6 that context?

7 A There is a -- several different ways that that  
8 could be established. The basics do not change. The radio  
9 needs to be configured to operate on the system.

10 The sales individual can either work with the  
11 customer to configure the radio on sites; the customer would  
12 have the pertinent security method to insure the radio got  
13 configured.

14 The sales individual could work with a support --  
15 a staff support company. Not all companies service their  
16 own products. They will have an outside company service  
17 those products.

18 They could work with that service provider to  
19 configure it appropriately and, then, work with the  
20 customer.

21 As long as the configuration is completed  
22 properly, operation will occur.

23 Q And in that context as well, is it the case that  
24 when you hear the tone, it's because the channel open  
25 function is working?

1           A    Again, the tone has always been in reference to  
2   either the call-back availability or of the microphone  
3   active and communications occurring.

4           MR. STEWART:  I would like to have marked as Klein  
5   Exhibit 8 an advertisement that was provided to us in  
6   discovery.

7                               (Klein Deposition Exhibit  
8                               No. 8 was marked as  
9                               requested.)

10          A    Okay.

11          BY MR. STEWART:

12          Q    Do you recognize this document?

13          A    I recognize it as the Astro XTS 3000  
14   specification sheet.  I have seen this document before.

15          Q    Where have you seen it?

16          A    In my daily job functions.

17          Q    Is this something you provide to potential  
18   customers?

19          A    If requested, yes.

20          Q    What is the purpose of it?

21          A    This document, to the best of my understanding  
22   and my use of this document, is to identify the form  
23   factors, the overall form of the products, weights,  
24   durability, ruggedness, frequency, supports, and high level  
25   protocol supports of products.

1 Q And the listing of features on the front page,  
2 does that -- is that what you are saying?

3 A Those are very high level protocol statements.

4 Q Okay. And can you look at this and tell me  
5 whether there is any mention or identification of the  
6 911 Hz Tone.

7 A There is -- from my visual inspection, there is  
8 no direct specification of the 911 Hz Tone beyond the  
9 stipulation of the protocols that would require the tone.

10 MR. STEWART: Let me have marked as Klein Exhibit 9  
11 a one-page advertisement provided to us in discovery.

12 (Klein Deposition Exhibit  
13 No. 9 was marked as  
14 requested.)

15 BY MR. STEWART:

16 Q Do you recognize this document?

17 A I have seen this document before in my normal job  
18 functions.

19 Q What is it?

20 A It is a -- a document that's to draw additional  
21 attention to the robust durability of a particular version  
22 of the XTS 3000 referred to as the XTS 3000 Rugged.

23 Q And is this a print advertisement that's placed  
24 in publications?

25 A I do not know if it's been placed in



1 publications. This was a document -- an informational  
2 element that I have used, and I am familiar with others who  
3 have used this at trade shows and also as customer  
4 literature.

5 Q How do you use it at trade shows?

6 A When requests come in about the durableness of  
7 the products and when they have keen interest in  
8 significantly more robust products than our current lines  
9 for ones that are submersible, marine patrol customers, as  
10 such.

11 Q Can you tell me whether there is any mention made  
12 of the 911 Hz Tone in this advertisement?

13 A No, there is not mention of any features that I  
14 can tell from what I'm seeing, beyond the form factor  
15 itself.

16 Q What do you mean when you say "form factor"?

17 A Large knobs set further apart, large push to talk  
18 button, large uncramped keypad, large display, robustness,  
19 submersibility, it's light, it's more visible.

20 Q Are you aware of any -- let's start with print  
21 advertising -- used by Motorola with respect to 911 Hz  
22 products that mentions the 911 Hz Tone?

23 A Print?

24 Q Yes.

25 A I'm not aware of any print advertisement that

1 explicitly states the 911 Hz Tone. Well, let me rephrase  
2 that.

3 We say print, beyond -- you know, when you say  
4 advertisements, this could be advertisements. Beyond the  
5 manuals that it's printed in, beyond the training  
6 information it's printed in, beyond those types of  
7 discussion, direct discussion of the Talk-Permit tone, if  
8 you are referring specifically to an ad in a magazine, I'm  
9 not aware of an ad in a magazine that specifically states  
10 the 911 tone.

11 Q Your reference to user manuals was to the kinds  
12 of information we saw in Exhibits 3, 4 and 5, is that right?

13 MR. WILLIAMS: Let me get those for him,  
14 please.

15 BY MR. STEWART:

16 Q Yes.

17 A I stipulated these manuals that reference the  
18 Talk-Permit tone; also training information that references  
19 the Talk-Permit tone, and other items.

20 Q I want to go one by one. The user manuals you  
21 referred to are these -- are like these exhibits that we  
22 reviewed previously, is that right?

23 A Yes.

24 Q And the references to the tones were the ones  
25 that we looked at ourselves in looking at these user

1 manuals, is that right?

2 A The references that I had were to the  
3 stipulations of the alert tone table as stipulated, six  
4 through eight, and also the descriptions within the text of  
5 the document that stipulates the tone itself, and the  
6 expectations of the tone, and interaction with the product  
7 that is producing that tone -- interaction with the products  
8 to produce that tone.

9 Q Okay. Now let's turn to training materials.  
10 What are you referring to there?

11 A Motorola has gone through and put efforts in the  
12 past to working with customers such that they understand the  
13 product and manuals such as this, such that they understand  
14 the product.

15 But they have also developed training information  
16 such that they will have a live trainer out with the  
17 customer that goes through the operation of the products,  
18 speaks about the tone, has configurations in which they can  
19 hear the tone. So that's discussed.

20 Then there has been -- as technology has moved  
21 forward, that training has continued and been developed more  
22 so such that there are CIT, computer interactive training.

23 There is an on-line method, and that itself again  
24 has interaction with describing the product, describes the  
25 tone, actually plays the tone so you can audibly hear the

1 sound of the Talk-Permit tone, and then that is either  
2 singular solo training of the customers themselves, end  
3 users, or there are trainers that work with the customers  
4 and that material such that the same -- the same  
5 functionality and the training of understanding the -- these  
6 tones and their meanings are accomplished.

7 So there is a -- those are the -- in my  
8 understanding, and I easily could be potentially missing out  
9 some opportunities, but those are my understanding of the  
10 different opportunities that we deliver and speak with a  
11 customer directly about the tone.

12 Q And, first, when you are talking about live  
13 trainers, a live trainer would use the tone for the purpose  
14 of demonstrating the operation of the channel-open feature,  
15 is that right?

16 A Correct.

17 Q Or function. With respect to the computer  
18 training, we were handed this morning by counsel for  
19 Motorola a box of documents that we hadn't seen before, plus  
20 two CD-ROM discs which appear to include a video and a  
21 PowerPoint training program of some sort.

22 Do you know that document?

23 A I am -- if it is what I think it is, I -- or the  
24 training information I have seen in the past, I have some  
25 familiarity with it. But I'm making an assumption that's

1 the same training information that I've seen in the past.

2 MR. STEWART: We are a bit at a loss here because we  
3 can't actually introduce it, because we have got our one  
4 copy, and we may want to go back and maybe provide it to  
5 your counsel and then stipulate that's the same thing we are  
6 talking about.

7 I don't want to have any confusion about what it  
8 is we are actually talking about here.

9 MR. WILLIAMS: Would you like to go off the record.

10 MR. STEWART: Yes, let's go off the record.

11 MR. WILLIAMS: Shall we take a five-minute break.

12 THE VIDEOGRAPHER: This is the Videographer. The  
13 time is now 2:42 p.m. We are now off the record.

14 (Whereupon, a short recess was  
15 taken.)

16 THE VIDEOGRAPHER: This is the Videographer. We are  
17 back on the record. The time is 2:55 p.m.

18 MR. STEWART: I'm going to ask that these two CD's  
19 of which I have only a single copy be marked as Klein  
20 Exhibits 10 and 11.

21 (Klein Deposition Exhibits  
22 Nos. 10 and 11 were marked as  
23 requested.)

24 BY MR. STEWART:

25 Q Now, what's been marked 10 was presented to us

1 with a Bates number MOT 0302268. What we have marked as  
2 Exhibit 11 has the Bates number MOT 002269.

3 We understand that 2268 has an 8-minute video.  
4 2269 has that video imbedded within some kind of training --  
5 interactive training module, okay.

6 And you are aware of what it is that we are  
7 talking about?

8 A Given that description, I believe I am.

9 Q Okay. Now, I would like to ask you about -- what  
10 I'm calling the training module on 269. You have seen that  
11 yourself?

12 A Yes, I have.

13 Q And what can you tell me about it? When was it  
14 produced?

15 A That particular module -- or that particular  
16 version, I am -- I do not know the specific timeframe. It  
17 has been in the last few years, as far as being developed  
18 and deployed.

19 Q Could it have been as early as 1991?

20 A No, it could not have been.

21 Q And are you aware whether there are any other  
22 training modules with respect to other 911 Hz Tone products?

23 A I'm aware that the Training Department, over the  
24 last few years, have been developing training information  
25 for the 911 Hz products as we have defined it.

1           Q    So might there be other interactive computerized  
2 modules like the one that's on 269?

3           A    Yes, there may be other interactive modules as  
4 such.

5           Q    Who is the head of the Training Department?

6           A    I would go to -- I guess -- David Klein, my name  
7 sake.

8           Q    Okay. All right. And he and Monica Gingells  
9 were the two people in the training group that you tried to  
10 contact unsuccessfully, is that right?

11          A    Correct.

12          Q    Do you know how this particular training module  
13 was discovered and produced to us this morning?

14          A    I spoke with Janice Morey.

15          Q    Okay.

16          A    Who is, in my understanding, an author of these  
17 types of manuals.

18          Q    "These types" referring to Exhibits 3, 4 and 5.

19          A    Yes. In this scenario, It's my understanding  
20 that the organization that produced these manuals -- where  
21 the verbiage is different between the authors, the tone as  
22 listed in Exhibits 3, 4 and 5 being the same.

23                She, it is my understanding, was responsible for  
24 and worked with the direct development of the XTS 3000 and  
25 the XTS 5000 manuals. I do not know if she was involved

1 with previous versions.

2 And one of the problems we do have with different  
3 authors, different verbiage, which is one reason why the  
4 training information, delivering it as such -- so they can  
5 hear the tones -- whether it describes on pages -- was it  
6 eight through whatever -- yeah, six through eight, these  
7 characterizations; by being able to hear them, you can  
8 clearly identify the distinction versus the organization of  
9 the descriptions.

10 Q Okay. So Exhibit 5 is the XTS 3000. You said  
11 that that was -- that Janice Morey was the author of that?

12 A She worked on this particular -- I worked with  
13 Janice Morey on this particular version of this particular  
14 product manual, being this covers the Astro 25 protocol. So  
15 I worked with her on this particular one.

16 Q Did you work in particular on the table on pages  
17 six through eight that you were just referring to?

18 A No, I did not. No, I did not. Since there are  
19 no changes to our tones, there was no reason to visit this  
20 -- this listing.

21 Q But there was a change in the way that they were  
22 described and grouped --

23 A There has been -- because of authors, the  
24 description, as minor as it is, there has been description  
25 changes.



1           The tones have shown no change there; audibly the  
2 same sounds. But different authors have used different ways  
3 to present them.

4           Q    Okay. And as you were suggesting, the training  
5 module on Exhibit 11 actually produces audible tones, is  
6 that right?

7           A    Instead of trying to capture the words, it gives  
8 you the actual tone -- the actual sounds.

9           Q    How is the accuracy of the frequency cadence and  
10 duration of the tone enforced?

11          A    The accuracy -- per the training information.

12          Q    Let's talk about the training information. How  
13 do you know that the tone there is actually a 911 Hz Tone  
14 just as described in this trademark application?

15          A    I would have to -- I would have to assume that  
16 the group that developed it did an accurate generation of  
17 the tone. I have no reason to doubt that it's not accurate.

18          Q    Now, who is the audience for that -- for Exhibit  
19 11, the training module?

20          A    The training module? The training module could  
21 be exhibited to end users, literally fielded users of the  
22 products. It could be presented to purchasing agents who  
23 are interested in making a purchase of a product; anybody  
24 who wants to see the function.

25               This could be applied to new sales members who

1 have exposure to the product, things like that.

2 Q That is, Motorola sales employees?

3 A It could be Motorola sales employees, it could be  
4 our -- our <sup>lessors</sup> ~~leasers~~ products.

5 Q You mentioned purchasing agents. Are you talking  
6 about the individual employees of customer organizations who  
7 would be the purchasers?

8 A When we interact with large companies, there  
9 would be a -- you know -- a procurement officer or  
10 procurement group that the sales group would interact with  
11 them and the other decision makers.

12 Some customers are wholly self-contained as far  
13 as they maintain the products. Those types of organizations  
14 would certainly be interested in this information.

15 Q And as far as you know, in that training module  
16 that's on Exhibit 11, is there any presentation of the 911  
17 -- audible presentation of the 911 Hz Tone other than in  
18 demonstration of the operation of the particular function?

19 A Yes, yes, the tone is available such that in a  
20 list of tones, of the list of tones that's called the core  
21 -- core tones of the products, you can actually just select  
22 strictly the tone and listen to it.

23 Q And when you do that, it is expressly a  
24 demonstration of the tone that sounds when this particular  
25 function is operational, correct?

1           A    It's a table that lists the Talk-Permit tone and,  
2 then, a button that you press that it plays the tone.

3           Q    And it's not a series of tones that you play for  
4 your amusement and edification but, instead, an illustration  
5 or demonstration of what it sounds like when you push the  
6 Push-to-Talk button, is that right?

7           A    Correct, I mean, it is specific to -- upon  
8 pressing this icon or button, you hear specifically that  
9 tone.

10          Q    Okay. Now, has Motorola -- we talked first about  
11 the print ads that might run in magazines, and you've talked  
12 -- we have talked about those previously.

13                   Has Motorola advertised 911 products in other  
14 media other than print media?

15          A    I am unaware of -- because we go through  
16 procurement officers and things like that, the advertising  
17 is focused to avenues of such customers.

18                   So that would include the trade shows, the  
19 promotions and interactive items.

20                   I am not aware of any radio or TV ad that  
21 specifies a 911 Hz Tone.

22          Q    So you mentioned a list of ways in which  
23 customers -- potential customers might hear the 911 Hz Tone  
24 before -- and I'm going to list then for you here. One was  
25 training?

1 A <sup>Yes</sup>  
~~Uh-hum.~~

2 Q One was mentioned in user guides?

3 A <sup>Yes</sup>  
~~Uh-hum.~~

4 Q A third --

5 MR. WILLIAMS: Say "yes" or "no".

6 A Yes.

7 BY MR. STEWART:

8 Q A third was heard at trade shows?

9 A Yes.

10 Q A fourth was a sales rep who demonstrates the  
11 product at the customers's facilities?

12 A Yes.

13 Q And a fifth was in effect when you use the  
14 product, it's got -- it makes the tone while at the same  
15 time being labeled a Motorola product?

16 A Yes, it does.

17 Q Now, are there other ways in which potential  
18 customers could have heard the 911 Hz Tone?

19 A Yes.

20 Q How?

21 A If a customer is in the field with another  
22 customer of -- with overlapping coverage of systems, they  
23 could easily be with somebody who utilizes their Motorola  
24 radio, and they could easily hear the 911 Hz tone.

25 A significant number of customers would have

1 systems such that the police would be on one system,  
2 potentially the fire could be on another, and there would be  
3 numerous occasions where that tone would be played to people  
4 who do not actually either carry a Motorola product or  
5 operate on that system.

6 Q So they would hear it as it was being operated by  
7 somebody who actually had already purchased the product?

8 A Yes, or who had authority. There are times  
9 where, in times of crisis and need, Motorola does supply a  
10 system, and we supply branded Motorola products to help out  
11 in times of need.

12 And there would be a situation where they could  
13 easily hear the tone as they are operating on those  
14 products.

15 Q Okay. And is that different -- I had considered  
16 those kinds of situations to be like the fifth example that  
17 you gave me, which was, you use a Motorola phone, it's got  
18 Motorola on it -- I'm sorry, not phone but radio. You use  
19 it and it's got a Motorola label on it.

20 A Correct, they are -- they are very similar, the  
21 distinction being whether the user actually -- it is their  
22 product, or if they are actually observing somebody use it,  
23 or if it's not their product, but they have been given this  
24 Motorola radio to operate in a time of need.

25 Q Okay. Any other ways in which that would happen

1 -- in which a potential customer would hear the 911 Hz  
2 Tone?

3 A To the best of my knowledge, beyond -- and just  
4 for clarification, on the trade shows, they are trade shows  
5 that are open, or they are Motorola sponsored trade shows  
6 where we go out and visit customers or groups of customers  
7 to exhibit our products.

8 To the best of my knowledge, that I can recall, I  
9 believe those are the -- those are the instances where a  
10 customer would hear that 911 Hz Tone.

11 MR. STEWART: I would like to have marked as  
12 Exhibit 12, Applicant's Response to Opposer's First Set of  
13 Interrogatories to Applicant.

14 (Klein Deposition Exhibit  
15 No. 12 was marked as  
16 requested.)

17 A Okay.

18 BY MR. STEWART:

19 Q Have you seen this document before?

20 A I have seen this document before.

21 Q I would like you just to turn to page seven and  
22 look at the response to Interrogatory Number 14 which goes  
23 over onto page nine.

24 A Okay.

25 Q Did you assist in producing this list of trade

1 shows?

2 A No, I did not.

3 Q Do you see any listed here that are unfamiliar to  
4 you?

5 A There are a few.

6 Q Which are they?

7 A I don't have a working knowledge of DistribuTECH  
8 2005.

9 I would need -- I perhaps know the AFCEA West  
10 item. I'm not sure of the acronym.

11 Major City Chiefs, that's fine.

12 TechAdvantage is fine.

13 NACO -- I have not. I'm not familiar with.

14 State and Provincial Conference, yes, I have  
15 heard of.

16 National Postal Forum, I have not.

17 Navy League, Air Sea Space, I have not.

18 FOSE, I have not.

19 IWCE, I have.

20 NFBPA, I have not.

21 FDIC -- I have heard of the organization. I know  
22 we have some interaction with them. I'm not too clear on  
23 the contents or, I should say, the extent of.

24 To kind of highlight the ones that are most in my  
25 mind, the APCO, the Fire Chiefs, the Rail System Suppliers,

1 the MDUG, IAFC, again, APCO.

2 Let's see, the IACP, <sup>Printtrak</sup>~~Print Track~~ Users, the AUSA  
3 annual MTG, Canadian APCO.

4 I'm not familiar with the HAPCOA organization.

5 <sup>Printtrak</sup>~~Print Track~~ is fine; the Financial Analyst  
6 Meeting; the Officers' Meeting the Shareholder Meeting and  
7 the other APCO events

8 So I have working knowledge of the events that  
9 are directly related to the customer bases that I interact  
10 with.

11 Q Can you tell from the names of these -- let me  
12 start over.

13 What is the nature of the customers with which  
14 you interact?

15 A I interact with the -- again, as defined before  
16 -- the public safety, fire, police, and aspects of the  
17 federal government.

18 I interact with some utilities and some critical  
19 infrastructure organizations, and the -- the people  
20 associated with them.

21 I have had limited interaction with our  
22 enterprise customers, as they normally focus on data driven  
23 products and not voice.

24 Q Can you tell, based on the names of the trade  
25 shows that you said you were not familiar with, whether



1 those fall into the category of enterprise customers?

2 A By the description of DistribuTECH,  
3 TechAdvantage, some of those, I'm going to draw the  
4 conclusion that they are -- they are enterprise based  
5 customers.

6 MDUG is our Data Users Group which I have some  
7 working familiarity with.

8 Some of these other items that are -- Navy, Army,  
9 and some other elements such as those, I know that we do  
10 have interactions with them from a federal -- federal  
11 discussion and federal trade shows, but I have not worked  
12 with those organizations.

13 The ones that define themselves as APCO or MTUG,  
14 ~~Print-Track~~ <sup>Printrak</sup>, and any of the Motorola specific meetings,  
15 these are all ones that I have working familiarity with.

16 Q Now, at any of those trade shows, are you aware  
17 of any instance in which Motorola featured the 911 Hz Tone  
18 other than in connection with the operation of the function  
19 that it signifies?

20 A I'm not aware of any other -- any other  
21 presentation of that tone.

22 Q Now, are 911 Hz Tone products offered for sale  
23 through other channels of trade such as retail or mail or  
24 Internet?

25 A It is my understanding that to purchase a new

1 Motorola product, you have to go through our established --  
2 either direct sales force or be an organization, a lessee of  
3 products.

4 There are availability of used products in free  
5 marketplace, eBay or whatever. I can't speak to those, as  
6 those are either sold as used products by customers or  
7 stolen or whatever. So I can't speak to any of that.

8 Q So Motorola itself does not sell through retail  
9 stores -- mail or by Internet?

10 A Not -- by Internet, only if -- for specifically  
11 the 911 Hz Tone products, the only Internet available  
12 purchase is via the Motorola Internet web site where you  
13 must be already authorized as a lessee or have an account  
14 within Motorola to gain access.

15 MR. STEWART: We would like to gain access to that  
16 site. I know we asked counsel for clarification of their  
17 response in which you identified the Motorola principal web  
18 site, but we have asked for a more specific page designator.

19 And it sounds as though we also need  
20 authorization to view that page.

21 MR. WILLIAMS: We will take it under advisement.

22 MR. STEWART: Thanks.

23 BY MR. STEWART:

24 Q Has Motorola ever run focus groups regarding  
25 reaction of customers to the 911 Hz Tone itself?

1           A    I'm not aware of any focus group that was  
2 specifically designated to see the response of a user to the  
3 911 Hz Tone.

4           Q    Does Motorola run focus groups in general with  
5 respect to 911 Hz Tone products?

6           A    Motorola does run focus groups -- you know, not  
7 necessarily specific focus groups, but those types of  
8 interactions with customers based for 911 Hz Tone products  
9 and information about the products.

10          Q    And are records kept of those focus groups?

11          A    I can't stipulate for -- in general. It's my  
12 understanding that when research has been completed, there  
13 has been documentation associated with it. Whether it was  
14 in the form of a trip report or -- you know -- actual  
15 findings, some type of report has been generated.

16          Q    How -- who has -- who is the custodian of those  
17 kinds of documents?

18          A    I don't know if there is a specific custodian to  
19 those documents. Normally that type of effort ends up being  
20 consolidated with a particular program's documentation.

21          Q    So for the 911 Hz Tone products, would they be  
22 within the product definition marketing organization?

23          A    They could be. They could be involved with other  
24 organizations also, perhaps the group that actually -- if it  
25 was not the Marketing Group, the Product Definition Group,

1 if there was another group that sponsored the research, or  
2 conducted the research and gave strictly feedback, verbal  
3 feedback.

4 But they potentially have their own documentation  
5 for the research that they have completed.

6 Q And is that research run out of the Product  
7 Definition Marketing Organization?

8 A It can be requested by the Product Definition  
9 Group, not necessarily run by -- there is leanings to who  
10 ends up working through that. So it's not strictly to the  
11 Product Definition Group.

12 Q Well, if not the Product Definition Group, would  
13 it be run or communicated directly with the Marketing  
14 Communications Organization?

15 A It could be them. I don't know a particular name  
16 within that organization; or it could be within --  
17 Engineering has an organization that completes research  
18 tasks for the Products Definition Group.

19 Q Are there -- does Motorola create and distribute  
20 other audio-visual promotional material regarding the 911 Hz  
21 Tone products?

22 A Motorola develops visual presentation and  
23 information concerning the products, I believe, on both  
24 evidence Number 10, 11 -- there is a video that shows the  
25 products' interaction with customers, and kind of highlights

1 and is an advertising method for the products themselves.

2 Q How is that advertising method disseminated?

3 A How is that advertising disseminated. To who --

4 Q To whom would that be shown?

5 A To whom would that particular video be shown?

6 Q Yes.

7 A That video comes with the training information.

8 That training information is available to sales force, given  
9 to customers and what not.

10 There has been -- you know -- that particular  
11 video, I believe, was on display at several trade shows in  
12 the background.

13 There has been web seminars that, you know, the  
14 introduction would be this type of informational video  
15 information and highlights of the products, information like  
16 that.

17 Q And which part of the organization produces that  
18 kind of video?

19 A Traditionally it has been the Marketing  
20 Communication Group. I say traditionally because they do  
21 work in association with other organizations such that they  
22 are aware of what focus we would like to highlight, what  
23 part of a feature or product that we like to highlight.

24 Q Does Motorola use an outside agency to produce or  
25 disseminate audio-visual promotional material about the 911

1 Hz products?

2 A I do not know.

3 MR. STEWART: We would request that all videos such  
4 as the one we have been given this morning that relate to  
5 the 911 Hz Tone products be produced to us.

6 MR. WILLIAMS: We will take that under advisement.

7 BY MR. STEWART:

8 Q You said that there -- videos like this could be  
9 used in web seminars, is that right?

10 A Yes.

11 Q What does that mean?

12 A A web seminar is essentially a presentation of  
13 information to customers via a web page that they could log  
14 into via the Internet, because we have many customers across  
15 many areas.

16 To help get the message out to them and be  
17 communicative with our customers instead of expecting them  
18 to travel to a particular location, we like to give them  
19 opportunities where we can inform them about products and  
20 updates and features, and we can do that in a very  
21 simplistic, easy manner so they do not have to leave the  
22 confines of their company or their particular location.

23 They don't have to spend the time to travel --  
24 things like that. It's an ease of getting the message out  
25 there in whatever ways.

1 Q Are you aware of any video promotional material  
2 produced by Motorola with respect to 911 Hz Tone products  
3 that has featured the 911 Hz Tone itself?

4 A I do not know. There are videos out there I'm  
5 sure I have not seen. I cannot make a statement to the --  
6 to the present that are not.

7 Q So you have not seen any video that features the  
8 911 Hz Tone itself?

9 A I personally have not seen a video that featured  
10 the 911 Hz Tone.

11 Q How much has Motorola spent on advertising the  
12 911 Hz Tone products on an annual basis?

13 A The -- the focus of that type of advertisement to  
14 advertise a 911 Hz Tone product, we have traditionally  
15 focused on the customers, purchasing agents, elements such  
16 as that. So it's come from these meetings, trade shows and  
17 other customer interactions.

18 It's difficult to put a single monetary dollar  
19 on it. I know that on average we spend approximately  
20 \$100,000 alone in support of our MTUG and mutual user  
21 groups, or users who use our products in public safety and  
22 in critical infrastructure.

23 I know that for the Federal Government's type  
24 entities, whether it's DOD, DOJ or other elements, it's  
25 approximately \$160,000 on those types of materials and

1 presentations.

2 And this still doesn't include all the efforts of  
3 the direct sales force and other groups. This is just  
4 strictly in trade shows and, to the best of my knowledge,  
5 trade shows and other material that are generated.

6 There is -- of the trade shows that I'm aware of  
7 that focus on the APCO based elements, and the Fire Chiefs  
8 and Police Chiefs, I know that those are -- those are, I  
9 believe, over \$600,000 just on that grouping of those  
10 particular trade shows.

11 And I cannot make any statement of, you know,  
12 this lengthy list here of all the financial efforts to  
13 support these.

14 Q So you've stated \$100,000 in support of mutual  
15 user groups in the critical infrastructure --

16 A Approximately \$100,000 in support of MTUG,  
17 Motorola Trunks User Group, and in Mutual, which is the  
18 Motorola -- it's the -- I don't know the full acronym, but  
19 it's the critical infrastructure, utilities and other  
20 aspects.

21 Q And that is an annual budget?

22 A Yes.

23 Q Current annual budget?

24 A I believe so, it's 100, \$110,000, somewhere  
25 thereabouts.



1 Q Has it been more or less?

2 A I'm not aware of any adjustment.

3 Q How far back are you aware of the budget?

4 A I've been -- it's my understanding that the  
5 budget has been like that for the last few years. I can't  
6 comment with specifics to that point or beyond in any  
7 timeframe.

8 Q And \$160,000 in annual budget for -- what was the  
9 next category?

10 A The Federal Government -- and that again is an  
11 approximation. This is not my specific financial area.

12 But it is approximately \$160,000, and that is for  
13 support of elements like the Navy League, like the Army,  
14 stuff, any type of DOJ, Department of Justice, Department of  
15 Defense, Department of Treasury, White House Communications  
16 -- those organizations.

17 Q And \$600,000 for trade shows for APCO and related  
18 public safety organizations?

19 A Correct.

20 Q And that's again an annual budget?

21 A That's an approximation of an annual budget for  
22 the APCO groups.

23 Q And these numbers that you have given me are for  
24 all promotional activities and staff support and travel  
25 expenses, and so on, is that correct?

1           A    Those are specific.  It's my understanding --  
2   again, I'm not the person who sets these up and pays the  
3   finances for these events.  It's my understanding that it  
4   covers promotional material, it covers the booth space,  
5   things like that.

6           I -- it certainly doesn't necessarily cover the  
7   travel of people who attend, or necessarily the hotel rooms  
8   and things like that, but it's focused on material used.

9           Q    Okay.  And who is the person who knows the  
10   answers to those questions?

11          A    Well, it would have to be somebody within Mary  
12   ~~Botie's~~ <sup>Bottie's</sup> organization.

13          Q    That's the Marketing Communications Organization?

14          A    Yes, it is.

15          Q    You said before that there is a separate  
16   financial management organization within the business unit?

17          A    I'm not familiar with the financials of how these  
18   get paid, or the specific budgets associated with each one  
19   of these.

20                That is part of the Marketing Communications  
21   Organization.  I don't have any visibility into that -- that  
22   material.

23          Q    Okay.  Are there written guidelines governing use  
24   of Motorola's trademarks?

25          MR. WILLIAMS:  Objection.  That calls for an

1 activity of the Legal Department. This witness is here as a  
2 fact witness.

3 BY MR. STEWART:

4 Q Please answer.

5 A I personally have not read a document stipulating  
6 the guidelines of that.

7 Q Have there been any instances of actual confusion  
8 between the 911 Hz Tone and any other tone or trademark?

9 MR. WILLIAMS: Objection, that's vague, calls for a  
10 legal conclusion.

11 BY MR. STEWART:

12 Q Please answer.

13 A Can you give me a little clarification of by  
14 "confusion".

15 Q Has somebody ever, to your knowledge, or to  
16 Motorola's knowledge, heard a tone and believed that that  
17 was a Motorola product, or heard a Motorola tone and the  
18 911 Hz Tone and thought it was a product belonging to  
19 someone else?

20 A I don't know. Not in my experience. But that is  
21 strictly my own experience.

22 Q Well, you are here speaking on behalf of  
23 Motorola.

24 A I have not heard of such, nor have I seen such.

25 Q Did you seek to determine whether there were any

1 instances of actual confusion in preparing for this  
2 deposition?

3 A Not specifically of confusion, no.

4 Q Then of what?

5 MR. WILLIAMS: Objection to the extent the question  
6 calls for communication between the Legal Department and  
7 yourself.

8 A I spent my energy identifying products, tone,  
9 information I've already stipulated in questions.

10 BY MR. STEWART:

11 Q So you did not undertake any effort to determine  
12 whether there had been instances of actual confusion between  
13 the 911 Hz Tone and any other mark?

14 A At -- no, I did not.

15 Q What measures has Motorola taken to enforce its  
16 rights in the 911 Hz Tone?

17 A At present, I am unaware of any products that  
18 utilizes the 911 Hz tone. I'm unaware of efforts that  
19 Motorola has done to protect the tone that we are using  
20 beyond the fact that we are using it.

21 Q Do you -- have you during the course of the day  
22 today remembered anything else? I offered you the  
23 opportunity to come back and tell me if anything came to  
24 mind later in the day.

25 A No, not that I'm aware of. No.

1 MR. STEWART: Okay. If we could go off the record  
2 for a five-minute break, we will see if we are in a position  
3 to wrap it up at this point.

4 THE VIDEOGRAPHER: This is the Videographer. The  
5 time is now 3:26 p.m. We are going off the record.

6 (Whereupon, a short recess was  
7 taken.)

8 THE VIDEOGRAPHER: This is the Videographer. The  
9 time is now 3:44 p.m. We are back on the record.

10 MR. STEWART: Mr. Klein, thank you for your  
11 testimony.

12 We have no further questions for you at this  
13 time.

14 A All right.

15 MR. WILLIAMS: We have no questions.

16 MR. STEWART: Then the deposition is adjourned.

17 MR. WILLIAMS: We are going to reserve signature.

18 THE VIDEOGRAPHER: This marks the end of videotape  
19 Number 3 and the conclusion of the deposition of David  
20 Klein.

21 The time is now 3:45 p.m. We are off the record.

22 (Whereupon, at 3:45 p.m., the  
23 signature of the witness having  
24 been reserved, the witness being  
25 present and consenting thereto,

the taking of the instant  
deposition ceased.)

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IN THE UNITED STATES PAATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

NEXTEL COMMUNICATIONS, INC., )

Opposer, ) Opp. No. 91/161,817

vs. ) App. No. 78/235,618

MOTOROLA, INC., ) Pot. Mark: SENSORY MARK

Applicant. ) (911 Hz tone)

I, DAVID ERIC KLEIN, state that I have  
read the foregoing transcript of the testimony given  
by me at my deposition on the 19th day of July 2005,  
and that said transcript constitutes a true and  
correct record of the testimony given by me at

1 said deposition except as I have so indicated on  
2 the errata sheets provided herein.  
3  
4

5 \_\_\_\_\_  
6 DAVID ERIC KLEIN

7 No corrections (Please initial) \_\_\_\_\_

8 Number of errata sheets submitted \_\_\_\_\_ (pgs)  
9

10 SUBSCRIBED AND SWORN TO  
11 before me this \_\_\_\_\_ day  
12 of \_\_\_\_\_, 2005.  
13

14 \_\_\_\_\_  
15 NOTARY PUBLIC  
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1 STATE OF ILLINOIS )  
2 ) SS:  
3 COUNTY OF C O O k )

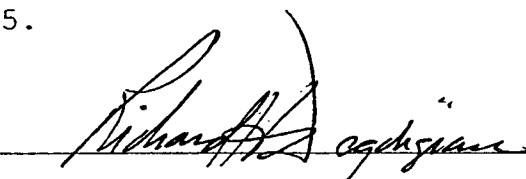
4 I, RICHARD H. DAGDIGIAN, Illinois CSR No.  
5 084-000035, Registered Professional Reporter and Notary  
6 Public in and for the County of Cook, State of Illinois, do  
7 hereby certify that previous to the commencement of the  
8 examination, said witness was duly sworn by me to testify  
9 the truth; that the said deposition was taken at the time  
10 and place aforesaid; that the testimony given by said  
11 witness was reduced to writing by means of shorthand and  
12 thereafter transcribed into typewritten form; and that the  
13 foregoing is a true, correct, and complete transcript of my  
14 shorthand notes so taken as aforesaid.

15 I further certify that there were present at the  
16 taking of the said deposition the persons and parties as  
17 indicated on the appearance page made a part of this  
18 deposition.

19 I further certify that I am not counsel for nor in  
20 any way related to any of the parties to this suite, nor am  
21 I in any way interested in the outcome thereof.  
22  
23  
24  
25

1 I further certify that this certificate applies to  
2 the original signed IN BLUE and certified transcripts only.  
3 I assume no responsibility for the accuracy of any  
4 reproduced copies not made under my control or direction.  
5

6 IN TESTIMONY WHEREOF, I have hereunto set  
7 my hand and affixed my notarial seal this 20<sup>th</sup> day of  
8 July, 2005.  
9

10   
11 Richard H. Dagdigian, CSR, RMR, CRR

12  
13 My Commission expires  
14 May 1, 2007.  
15  
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OFFICIAL SEAL  
RICHARD H DAGDIGIAN  
NOTARY PUBLIC - STATE OF ILLINOIS  
MY COMMISSION EXPIRES: 05-01-07

## ERRATA

Deposition of: David Eric Klein

I wish to make the following changes for the following reasons:

<u>CJS</u>	Page	Line	Change:	Reason:
✓ 5		11	TVMP – TBMP	Spelling Error
✓ 36		6	Leshim – Leshin	
✓ 17		8	Leshim – Leshin	
✓ 54		17	Leshim – Leshin	
✓ 18		15	Leshim – Leshin	
✓ 58		6	Leshim – Leshin	
✓ 18		23	Leshim – Leshin	Spelling Error
✓ 49		23	Talk-Permits – Talk-Permit	Spelling Error
✓ 53		8	delete “it was not”	Clarification
✓ 56		9-10	Pitman – Pittman	
✓ 21		14	Pitman - Pittman	
✓ 57		5-6	Pitman – Pittman	
✓ 21		25	Pitman – Pittman	
✓ 57		15	Pitman – Pittman	

✓ <sub>23</sub>	19	Change:	Pitman – Pittman
		Reason:	Spelling Error
✓ <sub>28</sub>	11	Change:	Mike – Microphone
✓ <sub>42</sub>	25	Change:	Mike – Microphone
✓ <sub>92</sub>	18	Change:	Mike – Microphone
		Reason:	Abbreviation correction
✓ <sub>40</sub>	18	Change:	Jim Sarallo
		Reason:	Spelling Error
✓ <sub>40</sub>	24	Change:	Mary Bottie
✓ <sub>132</sub>	11-12	Change:	Mary Bottie
		Reason:	Spelling Error
✓ <sub>41</sub>	4-5	Change:	Craig Chenicek
		Reason:	Spelling Error
✓ <sub>41</sub>	8-9	Change:	Kurt Brasch
✓ <sub>78</sub>	25	Change:	Kurt Brasch
		Reason:	Spelling Error
✓ <sub>59</sub>	12	Change:	Even – Event
		Reason:	Correction
✓ <sub>59</sub>	24	Change:	Aaron – Error in
✓ <sub>58</sub>	23	Change:	esthetic – aesthetic
✓ <sub>60</sub>	8	Change:	esthetic – aesthetic
		Reason:	Spelling Error
✓ <sub>63</sub>	23	Change:	150 point-whatever Hz.

✓ 90	11	Reason:	Correction
		Change:	leasers - lessors
✓ 116	4	Change:	leasers - lessors
		Reason:	Correction
✓ 118	1	Change:	Yes
✓ 118	3	Change:	Yes
		Reason:	Clarification
✓ 122	2	Change:	Printrak
✓ 122	5	Change:	Printrak
✓ 123	14	Change:	Printrak
		Reason:	Spelling Error

Signed: \_\_\_\_\_

Dated: \_\_\_\_\_

Aug 29 2005

# EXHIBIT 3

Nextel Communications, Inc., Opposer, v. Motorola, Inc., Applicant  
Opposition No.: 91/161,817  
Application No.: 78/235,618  
Mark: Sensory Mark (911 Hz Tone)

Exhibit 3 in Support of Applicant's Motion for Summary Judgment

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE**  
**THE TRADEMARK TRIAL AND APPEAL BOARD**

NEXTEL COMMUNICATIONS, INC.,	)	
	)	
Opposer,	)	
	)	
v.	)	Opp. No.: _____
	)	App. No.: 78/235,618
MOTOROLA, INC.,	)	Pot. Mark: SENSORY MARK
	)	(911 Hz tone)
	)	
Applicant.	)	
	)	

**BOX - TTAB - FEE**  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

**NOTICE OF OPPOSITION**

Honorable Commissioner:

NEXTEL COMMUNICATIONS, INC. ("Opposer"), a corporation duly organized and existing under the laws of the State of Delaware, located and doing business at 2001 Edmund Halley Drive, Reston, VA 20191, believing that it will be damaged by registration, hereby opposes Application Serial No. 78/235,618, filed April 9, 2003, under the Trademark Act of 1946, as amended ("Lanham Act"), in the name of MOTOROLA, INC. ("Applicant").

The grounds for opposition are as follows:

1. Opposer is one of the largest providers of cellular telephone and dispatch communications services in the United States, and currently has over 12 million subscribers to its services nationwide.

2. Opposer and Applicant have a long-standing business relationship, whereby Applicant manufactures phones, and accessories therefor, for sale by Opposer for use with Opposer's cellular telephone and dispatch services.

3. Applicant manufactures phones and accessories for Opposer's direct competitors.

4. On April 9, 2003, Applicant filed an application for registration of an electronic sound consisting of a tone at 911 Hz played at a cadence of 25 milliseconds (ms) on, 25 ms off, 25 ms on, 25 ms off, 50 ms on ("the 911 Hz Tone Application"). The 911 Hz Tone Application was assigned Serial No. 78/235,618, and was published for opposition in the Official Gazette on February 24, 2004. As published for opposition, the goods recited in the 911 Hz Tone Application are "[t]wo-way radios."

5. The 911 Hz Tone Application was filed under Section 1(a) of the Lanham Act, and claimed May 6, 1991, as the date of first use and the date of first use in commerce.

6. On October 17, 2003, the United States Patent and Trademark Office ("USPTO") issued an Office Action in connection with the 911 Hz Tone Application, requiring a description of the 911 Hz tone and a specimen evidencing use of the 911 Hz tone in commerce.

7. On October 17, 2003, Applicant submitted a response to the USPTO Office Action. The response included a description of the 911 Hz tone as follows:



"[t]he mark is an electronic chirp consisting of a tone at 911 Hz played at a cadence of 25 ms ON, 25 ms OFF, 25 ms ON, 25 ms OFF, 50 ms ON."

8. Applicant's response to the USPTO Office Action also included a specimen of use in the form of a compact disc described as "[a] sound file that contains a sound that emanates from a two-way radio to alert user or receiver of an incoming call or the availability to speak." The specimen was asserted to have been in use in commerce since at least as early as the filing date of the application.

9. Upon information and belief, Applicant has not used the 911 Hz tone in commerce in connection with the goods listed in the 911 Hz Tone Application, in derogation of Sections 1 and 45 of the Lanham Act. *See* 15 U.S.C. §§ 1051, 1127.

10. Upon information and belief, the 911 Hz tone is not inherently distinctive and has not acquired distinctiveness as to the goods listed in the 911 Hz Tone Application, in derogation of Sections 1, 2, and 45 of the Lanham Act. *See* 15 U.S.C. §§ 1051, 1052, 1127.

11. Opposer avers that, as it is a purchaser and potential purchaser of communications devices incorporating two-way radio capabilities from Applicant and other vendors of such devices, and as Opposer also sells such devices to end users, it will be damaged by the unjustified registration by Applicant of the 911 Hz tone as set forth in the 911 Hz Tone Application.

WHEREFORE, Opposer, NEXTEL COMMUNICATIONS, INC., believes and avers that it will be damaged by registration of the 911 Hz tone as aforesaid, and prays that said Application Serial No. 78/235,618 be rejected, that no

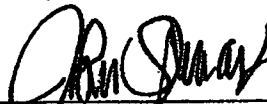
registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Opposer has appointed JOHN I. STEWART, JR., JEFFREY D. SANOK, and MICHAEL H. JACOBS, members of the law firm of CROWELL & MORING LLP, and members of the Bar of the District of Columbia, to prosecute this Opposition proceeding and to transact all business in and before the United States Patent and Trademark Office in connection herewith. Please address all correspondence to:

John I. Stewart, Jr.  
Crowell & Moring LLP  
1001 Pennsylvania Avenue, NW  
Washington, DC 20004  
Telephone No.: (202) 624-2500  
Facsimile No.: (202) 628-5116

The filing fee in the amount of \$300.00 should be charged to the Deposit Account of Crowell & Moring LLP, Account Number 05-1323 (Docket #100773.92133US). Please credit any overpayments or charge any additional fees to the Deposit Account of Crowell & Moring LLP, Account Number 05-1323 (Docket #100773.92133US).

Respectfully submitted,



John I. Stewart, Jr.  
Attorney for Opposer

August 23, 2004

CROWELL & MORING LLP  
1001 Pennsylvania Avenue, NW  
Washington, DC 20004  
Telephone No.: (202) 624-2500  
Facsimile No.: (202) 628-5116

ESTTA Tracking number: **ESTTA13805**

Filing date: **08/23/2004**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

<b>Name</b>	Nextel Communications, Inc.
<b>Granted to Date of previous extension</b>	08/22/2004
<b>Address</b>	Nextel Communications, Inc. 2001 Edmund Halley Drive Reston, VA 20191 UNITED STATES

<b>Attorney information</b>	John I. Stewart, Jr. Crowell & Moring LLP 1001 Pennsylvania Avenue, NW Washington, DC, DC 20004 UNITED STATES jstewart@crowell.com, khermann@crowell.com, wsauers@crowell.com Phone: (202) 624-2500
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**Applicant Information**

<b>Application No</b>	78235618	<b>Publication date</b>	02/24/2004
<b>Opposition Filing Date</b>	08/23/2004	<b>Opposition Period Ends</b>	08/22/2004
<b>Applicant</b>	Motorola, Inc.		

**Goods/Services Affected by Opposition**

Class 009. First Use: 19910506 First Use In Commerce: 19910506  
All goods and services in the class are opposed, namely: Two-way radios

<b>Attachments</b>	Notice of Opposition (Executed).pdf ( 4 pages )
<b>Signature</b>	/John I. Stewart, Jr./
<b>Name</b>	John I. Stewart, Jr.
<b>Date</b>	08/23/2004

# EXHIBIT 4

Nextel Communications, Inc., Opposer, v. Motorola, Inc., Applicant  
Opposition No.: 91/161,817  
Application No.: 78/235,618  
Mark: Sensory Mark (911 Hz Tone)

Exhibit 4 in Support of Applicant's Motion for Summary Judgment

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD**

NEXTEL COMMUNICATIONS, INC.,	)	
	)	
Opposer,	)	
	)	
v.	)	
	)	
MOTOROLA, INC.,	)	
	)	
Applicant.	)	
	)	

Opp. No.: 91/161,817  
App. No.: 78/235,618  
Pot. Mark: SENSORY MARK  
(911 Hz tone)

**OPPOSER'S RESPONSE TO APPLICANT'S  
FIRST SET OF INTERROGATORIES**

Pursuant to Federal Rules of Civil Procedure 33, Opposer, Nextel Communications, Inc. ("Opposer") responds to Applicant Motorola, Inc.'s ("Applicant") First Set of Interrogatories [Nos. 1-10].

**GENERAL OBJECTIONS**

1. Opposer objects to the interrogatories to the extent that they request information that is covered by the attorney-client privilege and/or work product doctrine or any other applicable privilege. Any responsive documents will be reflected on a privilege log at the appropriate time.
  
2. Opposer objects to each interrogatory that purports to impose upon Opposer any obligation greater than or different from those required under the Federal Rules of Civil Procedure, the rules of the Trademark Trial and Appeal Board, or applicable case law.

3. Opposer objects to the interrogatories to the extent that they seek confidential, proprietary, or commercially sensitive information. To the extent that such information is otherwise discoverable, Opposer will provide it to Applicant pursuant to terms of a suitable Protective Order entered by the TTAB.

4. The following responses reflect Opposer's present knowledge, information, and belief, and may be subject to change or modification based on Opposer's further discovery, or on facts or circumstances that may come to Opposer's knowledge.

5. Opposer objects to the interrogatories to the extent that they request identification of documents. Where appropriate, Opposer will produce non-privileged documents pursuant to Fed. R. Civ. P. 33(d) instead of undertaking the burden of identifying the documents. A response stating that Opposer will produce/provide documents, things or information is not a representation that any responsive document, thing or information necessarily exists. To the extent Opposer states that it will produce/provide responsive documents, things, or information, it will produce/provide such documents, things, or information as they exist and can be located after a reasonable search of documents, things, and information within Opposer's possession, custody and control.

6. In addition to all facts, information and documents identified or referred to in these responses, Opposer reserves its right to use and rely upon any facts, information or documents provided by Applicant during discovery.

7. These General Objections shall apply to each of Opposer's responses. To the extent that specific objections are provided because they are believed to be particularly

applicable to specific interrogatories, they are not to be construed as a waiver of any General Objection applicable to the information falling within the scope of the interrogatory.

Subject to these General Objections and the specific objections hereinafter set forth, Opposer responds to Applicant's First Set of Interrogatories as follows:

1. Describe in detail all facts relating to Opposer's contention that Applicant has not used Applicant's Mark in commerce in connection with two-way radios (§ 9 of Notice of Opposition), and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

**RESPONSE:** In addition to the General Objections, Opposer objects to this interrogatory to the extent it seeks to invade the attorney-client privilege and/or attorney work product doctrine. Opposer further objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that it is unaware of any instances in which Applicant has used the 911 Hz tone as a mark in commerce in connection with two-way radios.

2. Describe in detail all facts relating to Opposer's contention that Applicant's Mark is not inherently distinctive in connection with two-way radios (§ 10 of Notice of Opposition), and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

**RESPONSE:** In addition to the General Objections set forth above, Opposer objects to this interrogatory as it invades the attorney client privilege and/or attorney work product doctrine. Opposer further objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Opposer further objects that the phrase "inherently distinctive" calls for a legal conclusion.



3. Describe in detail all facts relating to Opposer's contention that Applicant's Mark has not acquired distinctiveness in connection with two-way radios (§ 10 of Notice of Opposition), and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

**RESPONSE:** Opposer incorporates its response to Interrogatory No. 1 as if fully set forth herein. Opposer further objects that the phrase "acquired distinctiveness" calls for a legal conclusion.

4. Identify and describe the types of individuals and the classes of consumers or entities who purchase or use two-way radios that emit Applicant's Mark or any mark similar thereto, and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

**RESPONSE:** In addition to the General Objections set forth above, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Opposer further objects that the use of the phrase "or any mark similar thereto" is vague, ambiguous and calls for a legal conclusion. Opposer further objects that this interrogatory is overbroad, unduly burdensome and not reasonable calculated to lead to the discovery of admissible evidence.

5. If Opposer has ever received an opinion, from legal counsel or otherwise, relating to Applicant's Mark, including but not limited to any opinion on whether Applicant has used the Mark, whether the Mark is inherently distinctive, or whether the Mark has acquired distinctiveness, for each such opinion: describe the opinion in detail, including but not limited to the date of the opinion, the author(s) of the opinion, the recipient(s) of the opinion, and the substance of the opinion; identify each document or thing that relates to or constitutes the opinion; and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

**RESPONSE:** In addition to the General Objections set forth above, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce.

Opposer further objects to this interrogatory in that it seeks to invade the attorney-client and/or attorney work product privilege.

6. Describe how and to whom Opposer's two-way radios are marketed, promoted, sold, and distributed, and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

**RESPONSE:** In addition to the General Objections set forth above, Opposer objects to this interrogatory in that it is vague, overbroad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence, to the extent that it calls for information relating to Opposer's different products and services marketed, promoted, sold and distributed under various marks. Subject to and without waiving its objections, Opposer states that it does not market, promote, sell or distribute two-way radios that emit the 911 Hz tone as claimed in Applicant's application.

7. Describe in details the facts and circumstances surrounding Opposer's first knowledge of Applicant's Mark, Applicant's use of the Mark, and of Application No. 78/235,618, and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

**RESPONSE:** In addition to the General Objections set forth above, Opposer objects to this interrogatory to the extent it seeks to invade the attorney-client privilege and/or attorney work product doctrine. Opposer further objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that it first learned that Applicant was claiming it had trademark rights in the 911 Hz tone that emits from Applicant's two-way radios when it became aware of Opposer's trademark application.

8. Describe in detail the facts and circumstances surrounding any instance in which a person has been, or may have been, confused as to the source of Applicant's two-way radios or for any service provided by Applicant in connection with such radios, and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

**RESPONSE:** In addition to the General Objections set forth above, Opposer objects to the use of the term "confused" in that it is vague, ambiguous and calls for a legal conclusion. Subject to and without waiving its objections, Opposer states that it is not aware of any instances of confusion as to the source of Applicant's two-way radios or any service provided by Applicant in connection with such radios.

9. Identify each witness (whether fact or expert) whom Opposer intends to call during the testimony period of this proceeding and for each witness, describe in detail the subject matter of his/her testimony, describe in detail the facts upon which his/her testimony will be based, identify the documents and things upon which his/her testimony will be based, and provide a detailed written description of any opinions the witness may offer in his/her testimony.

**RESPONSE:** In addition to the General Objections set forth above, Opposer objects to this interrogatory as premature. Subject to and without waiving its objections, Opposer states that it will disclose anticipated fact and expert witnesses in accordance with applicable Pretrial Orders, the Federal Rules of Civil Procedure and the Trademark Trial and Appeal Board Practice and Procedure rules.

10. Describe in detail all facts relating to Opposer's contention that it will be damaged if Applicant's Mark is registered (§ 11 of Notice of Opposition), and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

**RESPONSE:** In addition to the General Objections set forth above, Opposer objects to this interrogatory in that it invades the attorney client privilege and/or work product doctrine. Opposer further objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as

trademark use in commerce. Subject to and without waiving its objections, Opposer states that it sells wireless phones and devices that incorporate electronic tones, that Opposer and Applicant are business partners and that Applicant manufactures wireless phones and devices for Opposer and Opposer's competitors.

April 25, 2005

Respectfully submitted,



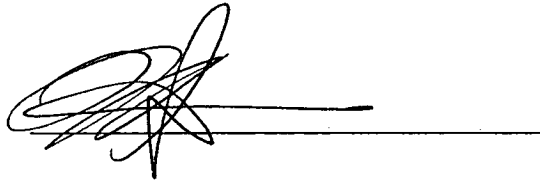
John I. Stewart, Jr.  
Attorney for Opposer

**CROWELL & MORING LLP**  
1001 Pennsylvania Avenue, N.W.  
Washington, DC 20004  
Telephone No.: (202) 624-2500  
Facsimile No.: (202) 628-5116

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the OPPOSER'S RESPONSE TO APPLICANT'S  
FIRST SET OF INTERROGATORIES was served on counsel for the Applicant, this 25th day of  
April, 2005, by sending same via electronic mail and First Class Mail, postage prepaid, to:

John T. Gabrielides  
BRINKS, HOFER, GILSON & LIONE  
455 North Cityfront Plaza Drive  
NBC Tower, Suite 3600  
Chicago, Illinois 60611-5599



2229060

# EXHIBIT 5

Nextel Communications, Inc., Opposer, v. Motorola, Inc., Applicant  
Opposition No.: 91/161,817  
Application No.: 78/235,618  
Mark: Sensory Mark (911 Hz Tone)

Exhibit 5 in Support of Applicant's Motion for Summary Judgment

NEXTEL COMMUNICATIONS, INC.,

Opposer,

v.

MOTOROLA, INC.,

Applicant.

**OPPOSER'S RESPONSE TO APPLICANT'S FIRST SET OF  
REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS**

## GENERAL OBJECTIONS

## REQUESTS

1. All documents that refer or relate to Opposer's first knowledge of Applicant's

**RESPONSE:** In addition to the General Objections, Opposer objects to the use of the term “Applicant’s Mark” in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer will produce all non-privileged documents and things responsive to this Request.

2. All documents that refer or relate to Opposer's first knowledge of Applicant's use of Applicant's Mark in connection with two-way radios.

**RESPONSE:** In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

3. All documents that refer or relate to Opposer's first knowledge of Application No. 78/235,618.

**RESPONSE:** Subject to and without waiving the General Objections, Opposer will produce all non-privileged documents and things responsive to this Request.

4. All documents that refer or relate to Application No. 78/235,618.

**RESPONSE:** Subject to and without waiving the General Objections, Opposer will produce all non-privileged documents and things responsive to this Request.

5. All documents that refer or relate to Applicant's Mark.

**RESPONSE:** In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer will produce all non-privileged documents and things responsive to this Request.

6. All documents that refer or relate to Applicant's use of Applicant's Mark in connection with two-way radios.



**RESPONSE:** In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

7. All documents that refer or relate to Applicant's alleged non-use of Applicant's Mark in connection with two-way radios, as referred to in, for example, ¶ 9 of Opposer's Notice of Opposition.

**RESPONSE:** In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that it will produce all non-privileged documents and things responsive to this Request.

8. All documents that refer or relate to the inherent distinctiveness of Applicant's Mark in connection with two-way radios.

**RESPONSE:** In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Opposer further objects to the use of the phrase "inherent distinctiveness" in that it calls for a legal conclusion. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

9. All documents that refer or relate to the alleged lack of inherent distinctiveness of Applicant's Mark in connection with two-way radios, as referred to in, for example, ¶ 10 of Opposer's Notice of Opposition.

**RESPONSE:** In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Opposer further objects to the use of the phrase "inherent distinctiveness" in that it calls for a legal conclusion. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

10. All documents that refer or relate to the acquired distinctiveness of Applicant's Mark in connection with two-way radios.

**RESPONSE:** In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Opposer further objects to the use of the phrase "acquired distinctiveness" in that it calls for a legal conclusion. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

11. All documents that refer or relate to the alleged lack of acquired distinctiveness of Applicant's Mark in connection with two-way radios, as referred to in, for example, ¶ 10 of Opposer's Notice of Opposition.

**RESPONSE:** In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Opposer further objects to the use of the phrase "acquired distinctiveness" in that it calls for a legal conclusion. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

12. All documents that refer or relate to the damage that Opposer will allegedly suffer if Applicant's Mark is registered, as referred to in, for example, ¶ 11 of Opposer's Notice of Opposition.

**RESPONSE:** In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that it will produce all non-privileged documents and things responsive to this Request.

13. All documents that refer or relate to the types of individuals or entities, or the classes of consumers or entities, who purchase or use two-way radios that emit Applicant's Mark or any mark similar thereto.

**RESPONSE:** In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Opposer further objects that the Request is overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery of admissible evidence. Opposer further objects that the use of the phrase "or any mark similar thereto" is vague, ambiguous and calls for a legal conclusion.

14. Documents sufficient to show Opposer's yearly sales volume (in units, dollars, and number of purchasers) of two-way radios.

**RESPONSE:** In addition to the General Objections, Opposer objects to this Request in that it is vague, overbroad, unduly burdensome and not likely to lead to the discovery of admissible evidence, to the extent that it calls for production of all documents relating to Opposer's different products and services marketed, promoted, sold and distributed under various marks. Subject to and without waiving its objections, Opposer states that it does not market, promote, sell or distribute two-way radios that emit the 911 Hz tone as claimed in

Applicant's application and that there are no non-privileged documents responsive to this Request.

15. Documents sufficient to show each entity from whom Opposer purchases or has purchased two-way radios.

**RESPONSE:** In addition to the General Objections, Opposer objects to this Request in that it is vague, overbroad, unduly burdensome and not likely to lead to the discovery of admissible evidence, to the extent that it calls for production of all documents relating to Opposer's different products and services marketed, promoted, sold and distributed under various marks. Subject to and without waiving its objections, Opposer states that it does not market, promote, sell or distribute two-way radios that emit the 911 Hz tone as claimed in Applicant's application and that there are no non-privileged documents responsive to this Request.

16. A sample of each advertisement or promotional item that includes Applicant's Mark, including any such advertisements or promotional items that are used by, on behalf of, or for the benefit of Opposer.

**RESPONSE:** In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

17. All documents that refer or relate to Opposer's decision to use Applicant's Mark in Opposer's advertisements or promotional items.

**RESPONSE:** In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

18. All documents that relate to the development or drafting of advertisements or promotional items that use Applicant's Mark, whether the advertisement or promotional item was ever distributed, displayed, or used.

**RESPONSE:** In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

19. Documents sufficient to show the yearly amount spent for each advertisement or promotional item identified in response to Document Request No. 16.

**RESPONSE:** Opposer incorporates its response to Request No. 16 as if fully set forth herein.

20. All documents that refer or relate to any trademark search conducted by or on behalf of Opposer for or in connection with Applicant's Mark.

**RESPONSE:** In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer will produce all non-privileged documents and things responsive to this Request.

21. All documents that refer or relate to any survey, poll, research, or investigation made, conducted by, on behalf of, or for the benefit of Opposer that refers or relates to Applicant's Mark or Applicant's two-way radios that use Applicant's Mark.

**RESPONSE:** In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

22. All documents that refer or relate to any instance in which an individual has been, or may have been, confused as to the source of Applicant's two-way radios or for any service provided by Applicant in connection with such radios.

**RESPONSE:** In addition to the General Objections, Opposer objects to the term "confused" in that it is vague, ambiguous and calls for a legal conclusions. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

23. All documents that refer or relate to the manner in which Opposer markets, promotes, sells, or distributes two-way radios.

**RESPONSE:** In addition to the General Objections, Opposer objects to this Request in that it is vague, overbroad, unduly burdensome and not likely to lead to the discovery of admissible evidence, to the extent that it calls for production of all documents relating to Opposer's different products and services marketed, promoted, sold and distributed under various marks. Subject to and without waiving its objections, Opposer states that it does not market, promote, sell or distribute two-way radios that emit the 911 Hz tone as claimed in Applicant's application and that there are no non-privileged documents responsive to this Request.

24. All documents that describe Opposer's policies and procedures regarding the destruction or retention of documents.

**RESPONSE:** In addition to the General Objections, Opposer objects that this Request is overbroad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving these objections, Opposer states that, beginning July 15, 2002, Opposer adopted the following policy:

"[S]torage of email will be limited to 90 days. Data older than 90 days will automatically be deleted from the email servers. This applies to data in the Inbox, Sent Items, Deleted Items, and the Calendar. Users may save their own email, calendars, etc. to their local computers for longer than that period if they choose."

25. All documents that Opposer intends to rely upon in this proceeding.

**RESPONSE:** Subject to and without waiving the General Objections, Opposer states that it intends to rely on all non-privileged documents produced herewith or in any supplement hereto and reserves its right to rely on any documents produced by Applicant.

26. All documents identified by Opposer in its answers to Applicant's First Set of Interrogatories.

**RESPONSE:** Subject to and without waiving the General Objections, Opposer will produce all non-privileged documents and things responsive to this Request.

27. All documents referred to by Opposer in answering Applicant's First Set of Interrogatories.

**RESPONSE:** Subject to and without waiving the General Objections, Opposer will produce all non-privileged documents and things responsive to this Request.

April 25, 2005

Respectfully submitted,



John I. Stewart, Jr.  
Attorney for Opposer

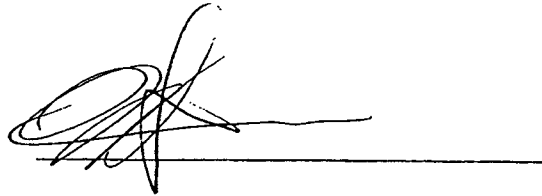
**CROWELL & MORING LLP**  
1001 Pennsylvania Avenue, N.W.  
Washington, DC 20004  
Telephone No.: (202) 624-2500  
Facsimile No.: (202) 628-5116



**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the OPPOSER'S RESPONSE TO APPLICANT'S FIRST REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS was served on counsel for the Applicant, this 25<sup>th</sup> day of April, 2004, by sending same via electronic mail and First Class Mail, postage prepaid, to:

John T. Gabrielides  
BRINKS, HOFER, GILSON & LIONE  
455 North Cityfront Plaza Drive  
NBC Tower, Suite 3600  
Chicago, Illinois 60611-5599

A handwritten signature in black ink, appearing to be "John T. Gabrielides", is written over a horizontal line.

2229102

# EXHIBIT 6

Nextel Communications, Inc., Opposer, v. Motorola, Inc., Applicant  
Opposition No.: 91/161,817  
Application No.: 78/235,618  
Mark: Sensory Mark (911 Hz Tone)

Exhibit 6 in Support of Applicant's Motion for Summary Judgment

Feb 4, 2004

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514  
[www.uspto.gov](http://www.uspto.gov)

## NOTICE OF PUBLICATION UNDER 12(a)

- |                                      |                                     |
|--------------------------------------|-------------------------------------|
| 1. Serial No.:<br>78/235,618         | 2. Mark:<br>No Drawing-Sensory Mark |
| 3. International Class(es):<br>9     |                                     |
| 4. Publication Date:<br>Feb 24, 2004 | 5. Applicant:<br>Motorola, Inc.     |

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a certificate of registration.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents  
U.S. Government Printing Office  
PO Box 371954  
Pittsburgh, PA 15250-7954  
Phone: (202)512-1800

By direction of the Commissioner.

☐ AMENDMENT STAGE☒ NO CHANGE☒ PUBLICATION/REGISTRATION STAGE

Name TRACY SMITH L.O. 112 Date 01/05/2004 Serial No. 7\_ /

INSTRUCTIONS: Place a check mark in the appropriate column and/or box to indicate which data elements have been amended/coded.

**Legal Instrument Examiner (LIE)**

	Amended	Data Element	
Class Data		<input type="checkbox"/> Prime/International Class	<input type="checkbox"/> Goods and Services
		<input type="checkbox"/> First Use Date	<input type="checkbox"/> First Use in Commerce Date
		<input type="checkbox"/> In Another Form	<input type="checkbox"/> Certification
		<input type="checkbox"/> 1b	
Mark Data		<input type="checkbox"/> Word Mark	<input type="checkbox"/> Pseudo Mark
		<input type="checkbox"/> Mark Drawing Code	<input type="checkbox"/> Design Search Code
		<input type="checkbox"/> Scan Sub Drawing	
Misc. Mark Data		<input type="checkbox"/> Mark Description	<input type="checkbox"/> Disclaimer
		<input type="checkbox"/> Lining/Stippling	<input type="checkbox"/> Name/Portrait/Consent
		<input type="checkbox"/> Translation	
Section 2(f)		<input type="checkbox"/> Section 2(f) Entire Mark	
		<input type="checkbox"/> Section 2(f) Limitation Statement	<input type="checkbox"/> Section 2(f) in Part
		<input type="checkbox"/> Amended Register	<input type="checkbox"/> Amended Register Date
Foreign Reg. Data		<input type="checkbox"/> Foreign Country	<input type="checkbox"/> 44(d)
		<input type="checkbox"/> Foreign Application Number	<input type="checkbox"/> Foreign Application Filing Date
		<input type="checkbox"/> Foreign Registration Number	<input type="checkbox"/> Foreign Registration Date
		<input type="checkbox"/> Foreign Registration Expiration Date	<input type="checkbox"/> Foreign Renewal Reg. Number
		<input type="checkbox"/> Foreign Reg. Renewal Expiration Date	<input type="checkbox"/> Foreign Renewal Reg. Date
Owner Data		<input type="checkbox"/> Owner Name	<input type="checkbox"/> DBA/AKA/TA
		<input type="checkbox"/> Address 1	<input type="checkbox"/> Address 2
		<input type="checkbox"/> City	<input type="checkbox"/> State
		<input type="checkbox"/> Zip Code	
		<input type="checkbox"/> Citizenship	<input type="checkbox"/> Entity
		<input type="checkbox"/> Entity Statement	<input type="checkbox"/> Composed of
		<input type="checkbox"/> Assignment(s)/Name Change	
Amd/Corr Restr.		<input type="checkbox"/> Concurrent Use	
Prior U.S. Reg.		<input type="checkbox"/> Prior Registration	
Correspondence		<input type="checkbox"/> Attorney	<input type="checkbox"/> Domestic Representative
		<input type="checkbox"/> Attorney Docket Number	
		<input type="checkbox"/> Correspondence Firm Name/Address	

I certify that all corrections have been entered in accordance with text editing guidelines.

LIE TRACY SMITH

Other: \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

# TRADEMARK EXAMINATION WORKSHEET

☒ AMENDMENT STAGE

☐ NO CHANGE

☐ PUBLICATION/REGISTRATION STAGE

Name **TRACY SMITH** L.O. 112 Date 11/18/2003 Serial No. 7\_\_ /

INSTRUCTIONS: Place a check mark in the appropriate column and/or box to indicate which data elements have been amended/coded.

## Legal Instrument Examiner (LIE)

	Amended	Data Element
<b>Class Data</b>	<input type="checkbox"/>	<input type="checkbox"/> Prime/International Class
	<input type="checkbox"/>	<input type="checkbox"/> Goods and Services
	<input type="checkbox"/>	<input type="checkbox"/> First Use Date
	<input type="checkbox"/>	<input type="checkbox"/> First Use in Commerce Date
<b>Mark Data</b>	<input type="checkbox"/>	<input type="checkbox"/> In Another Form
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	<input checked="" type="checkbox"/>	<input type="checkbox"/> Word Mark
<b>Misc. Mark Data</b>	<input type="checkbox"/>	<input type="checkbox"/> Pseudo Mark
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	<input type="checkbox"/>	<input type="checkbox"/> Design Search Code
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	<input type="checkbox"/>	<input type="checkbox"/> Mark Description
	<input type="checkbox"/>	<input type="checkbox"/> Disclaimer
<b>Foreign Reg. Data</b>	<input type="checkbox"/>	<input type="checkbox"/> Lining/Stippling
	<input type="checkbox"/>	<input type="checkbox"/> Name/Portrait/Consent
	<input type="checkbox"/>	<input type="checkbox"/> Translation
	<input type="checkbox"/>	<input type="checkbox"/> Section 2(f) Entire Mark
<b>Owner Data</b>	<input type="checkbox"/>	<input type="checkbox"/> Section 2(f) Limitation Statement
	<input type="checkbox"/>	<input type="checkbox"/> Section 2(f) in Part
	<input type="checkbox"/>	<input type="checkbox"/> Amended Register
	<input type="checkbox"/>	<input type="checkbox"/> Amended Register Date
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	<input type="checkbox"/>	<input type="checkbox"/> Foreign Application Filing Date
	<input type="checkbox"/>	<input type="checkbox"/> Foreign Registration Number
	<input type="checkbox"/>	<input type="checkbox"/> Foreign Registration Date
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	<input type="checkbox"/>	<input type="checkbox"/> Foreign Renewal Reg. Number
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<b>Correspondence</b>	<input type="checkbox"/>	<input type="checkbox"/> DBA/AKA/TA
	<input type="checkbox"/>	<input type="checkbox"/> Address 1
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	<input type="checkbox"/>	<input type="checkbox"/> State
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<b>Correspondence</b>	<input type="checkbox"/>	<input type="checkbox"/> Domestic Representative
	<input type="checkbox"/>	<input type="checkbox"/> Attorney Docket Number
	<input type="checkbox"/>	<input type="checkbox"/> Correspondence Firm Name/Address

I certify that all corrections have been entered in accordance with text editing guidelines.

LIE

TRACY SMITH

11/18/2003

Other:

Cofm 10/17/03

NOV 20 2003

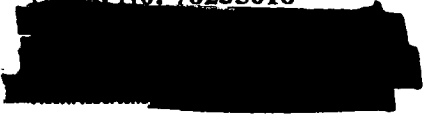
Nextel - 0010003  
Opp. No. 91/161,817

# Incoming Correspondence Routing Sheet

To: TMO LAW OFFICE 112 - AWAITING RESPONSE DOCKET

Word Mark: (Design Mark Only)

Serial No: 78235618



Mail Date: 10202003



Doc. Type: Responses to Office Actions



No Fee

PAM Mail Date: 102003



RECEIVED  
2003 NOV - 7 A 10:33  
TMO  
LAW OFFICE 112

Nextel - 0010004  
Opp. No. 91/161,817

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Motorola, Inc. Examining Attorney: Patricia Malesardi Evanko

Serial No: 78235618 Law Office: 112

Filed: April 22, 2003 Int'l Class: 009

Mark: (SENSORY MARK ONLY)

Attorney Docket No: TM03-1006

October 17, 2003

BOX ITU

NO FEE

Commissioner for Trademarks

2900 Crystal Drive

Arlington, Virginia 22202-3514

RECEIVED

2003 NOV - 1 A 10:33

TMEO  
LAW OFFICE 112

RESPONSE TO OFFICE ACTION DATED OCTOBER 17, 2003 WITH DECLARATION

CERTIFICATE OF MAILING BY FIRST CLASS MAIL	
I, <u>Kristen D. Poggensee</u>	hereby certify that this correspondence is
(printed name)	
being deposited with the United States Postal Service on <u>10/17/03</u>	as first
(date)	
class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on:	
Date: <u>10/17/03</u>	Signature: <u>Kristen D. Poggensee</u>

Responsive to the Office Action dated October 17, 2003, Applicant submits the following description of the mark:

The mark is an electronic chirp consisting of a tone at 911 Hz played at a cadence of 25 ms ON, 25 ms OFF, 25 ms ON, 25 ms OFF, 50 ms ON.

Applicant submits a CD specimen for the above-referenced sound mark. TMEP §904, §1202.15. The specimen is a sound file that contains a sound that emanates from a two-way radio to alert user or receiver of an incoming call or the availability to speak.



10-20-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #64

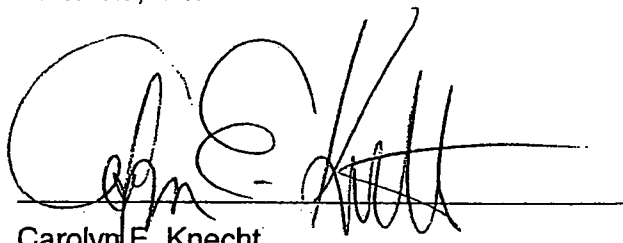
Nextel - 0010005  
Opp. No. 91/161,817

The specimen being submitted was in use in commerce at least as early as the filing date of the application.

#### DECLARATION

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; all statements made of his own knowledge are true; and all statements made on information and belief are believed to be true.

Motorola, Inc.

A handwritten signature in black ink, appearing to read 'Carolyn E. Knecht', is written over a horizontal line.

Carolyn E. Knecht

Senior Trademark Counsel

Date: Oct. 17, 2003



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Motorola, Inc. Examining Attorney: Patricia Malesardi Evanko  
Serial No.: 78235618 Law Office: 112  
Filed: April 22, 2003 Int'l Class: 009  
Mark: (SENSORY MARK ONLY)  
Attorney Docket No: TM03-1006

October 17, 2003

BOX ITU  
NO FEE  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

RESPONSE TO OFFICE ACTION DATED OCTOBER 17, 2003 WITH DECLARATION

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class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on:	
Date: <u>10/17/03</u>	Signature: <u>Kristen D. Poggensee</u>

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Applicant submits a CD specimen for the above-referenced sound mark. TMEP §904, §1202.15. The specimen is a sound file that contains a sound that emanates from a two-way radio to alert user or receiver of an incoming call or the availability to speak.

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Motorola, Inc.

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Carolyn E. Knecht

Senior Trademark Counsel

Date: Oct. 17, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Motorola, Inc.      Examining Attorney: Patricia Malesardi Evanko  
Serial No: 78235618      Law Office: 112  
Filed: April 22, 2003      Int'l Class: 009  
Mark: (SENSORY MARK ONLY)  
Attorney Docket No: TM03-1006

October 17, 2003

BOX ITU  
NO FEE

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

RESPONSE TO OFFICE ACTION DATED OCTOBER 17, 2003 WITH DECLARATION

CERTIFICATE OF MAILING BY FIRST CLASS MAIL	
I, <u>Kristen D. Poggensee</u>	hereby certify that this correspondence is
(printed name)	
being deposited with the United States Postal Service on <u>10/17/03</u>	as first
(date)	
class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on:	
Date: <u>10/17/03</u>	Signature: <u>Kristen D. Poggensee</u>

Responsive to the Office Action dated October 17, 2003, Applicant submits the following description of the mark:

The mark is an electronic chirp consisting of a tone at 911 Hz played at a cadence of 25 ms ON, 25 ms OFF, 25 ms ON, 25 ms OFF, 50 ms ON.

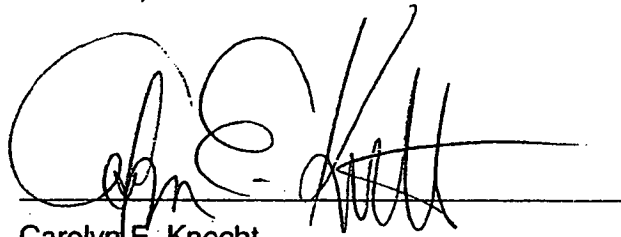
Applicant submits a CD specimen for the above-referenced sound mark. TMEP §904, §1202.15. The specimen is a sound file that contains a sound that emanates from a two-way radio to alert user or receiver of an incoming call or the availability to speak.

The specimen being submitted was in use in commerce at least as early as the filing date of the application.

#### DECLARATION

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; all statements made of his own knowledge are true; and all statements made on information and belief are believed to be true.

Motorola, Inc.

A large, stylized handwritten signature in black ink, appearing to read 'Carolyn E. Knecht', is written over a horizontal line.

Carolyn E. Knecht

Senior Trademark Counsel

Date: Oct. 17, 2003

7

**To:** Motorola, Inc. (carrie.knecht@motorola.com)  
**Subject:** TRADEMARK APPLICATION NO: 78235618 TM03-1006  
**Sent:** 10/17/03 9:43:04 AM  
**Sent As:** ECom112  
**Attachments:**

## UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 78/235618

**APPLICANT:** Motorola, Inc.

**CORRESPONDENT ADDRESS:**

Carolyn E. Knecht  
Motorola, Inc.  
600 North U.S. Highway 45  
Libertyville IL USA 60196

**RETURN ADDRESS:**

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514  
ecom112@uspto.gov

**MARK:**

**CORRESPONDENT'S REFERENCE/DOCKET NO:** TM03-1006

**CORRESPONDENT EMAIL ADDRESS:**

carrie.knecht@motorola.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

### OFFICE ACTION

**TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.**

**RE:** Serial Number 78/235618

The assigned examining attorney has reviewed the referenced application and determined the following.

**Search Results**

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

Nextel - 0010011  
Opp. No. 91/161,817

**Description of the Mark Needed**

The applicant must submit a concise description of the mark. 37 C.F.R. §2.37; TMEP §§808 *et seq.* The description must identify the sound mark in common English terms. For example, the following form is acceptable, if accurate:

The mark consists of the sound of [specify, e.g., a ringing telephone].

**Specimen Required**

An application based on use of the mark in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), must include a specimen showing use of the mark in commerce on or in connection with the goods/services. TMEP §904. The application does not contain a specimen. Because this application is for a sound mark, the specimen must be a sound file. TMEP Section 1212.05. The applicant must submit a specimen, and must submit the following statement:

The specimen was in use in commerce at least as early as the filing date of the application.

This statement must be verified with an affidavit or a declaration under 37 C.F.R. §2.20. 37 C.F.R. §2.59(a); TMEP §904.09.

A sample declaration is set forth below for the applicant's convenience.

The following is a properly worded declaration under 37 C.F.R. §2.20. At the end of your response, please insert the declaration signed by someone authorized to sign under 37 C.F.R. §2.33(a):

The specimen was in use in commerce at least as early as the filing date of the application.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Signature \_\_\_\_\_

Name and Position \_\_\_\_\_

Date \_\_\_\_\_

NOTE: For the signature above, use the same format as the electronic signature on the original e-TEAS application, e.g., /john doe/ or /jd/. 37 CFR §2.193(c)(1)(iii); TMEP §§304.08 and 804.05.

/Patty Evanko/  
Trademark Examining Attorney  
Law Office 112  
(703)308-9112, ext. 163  
patty.evanko@uspto.gov (questions only)

**How to respond to this Office Action:**

Nextel - 0010013  
Opp. No. 91/161,817

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.**



<b>DOCUMENT INFORMATION</b>	
<b>TRADEMARK/SERVICEMARK APPLICATION</b>	
<b>VERSION 1.24</b>	
<b>APPLICANT INFORMATION</b>	
NAME	Motorola, Inc.
STREET	1303 East Algonquin Road
CITY	Schaumburg
STATE	IL
COUNTRY	USA
ZIP/POSTAL CODE	60196
TELEPHONE NUMBER	847-523-1633
FAX NUMBER	847-523-4348
<b>APPLICANT ENTITY INFORMATION</b>	
CORPORATION: STATE/COUNTRY OF INCORPORATION	Delaware
<b>TRADEMARK/SERVICEMARK INFORMATION</b>	
MARK	NO DRAWING (SOUND MARK)
TYPED FORM	Yes
<b>BASIS FOR FILING AND GOODS/SERVICES INFORMATION</b>	
USE IN COMMERCE: SECTION 1(a)	Yes
SPECIMEN	Yes
SPECIMEN DESCRIPTION	A sound specimen for this application has been submitted separately to the TEAS Help Section.

78235618

INTERNATIONAL CLASS NUMBER	009
LISTING OF GOODS AND/OR SERVICES	Two-way radios
FIRST USE ANYWHERE DATE	05/06/1991
FIRST USE IN COMMERCE DATE	05/06/1991
<b>OPTIONAL INFORMATION</b>	
DESCRIPTION OF THE MARK	The mark consists of a tone at 911 Hz played at a cadence of 25ms ON, 25 ms OFF, 25 ms ON, 25 ms OFF, 50 ms ON..
<b>ATTORNEY INFORMATION</b>	
NAME	Carolyn E. Knecht
STREET	600 North U.S. Highway 45
CITY	Libertyville
STATE	IL
COUNTRY	USA
ZIP/POSTAL CODE	60196
FIRM NAME	Motorola, Inc.
E-MAIL ADDRESS	carrie.knecht@motorola.com
AUTHORIZE E-MAIL COMMUNICATION	Yes
TELEPHONE NUMBER	847-523-5876
FAX NUMBER	847-523-4348
ATTORNEY DOCKET NUMBER	TM03-1006
OTHER APPOINTED	Arch M. Ahern

78235618

ATTORNEY(S)	
<b>FEE INFORMATION</b>	
TOTAL FEES PAID	335
NUMBER OF CLASSES PAID	1
NUMBER OF CLASSES	1
<b>LAW OFFICE INFORMATION</b>	
E-MAIL ADDRESS FOR CORRESPONDENCE	carrie.knecht@motorola.com
<b>SIGNATURE AND OTHER INFORMATION</b>	
SIGNATURE	/cek/
DATE	04/09/2003
NAME	Carolyn E. Knecht
TITLE	Senior Trademark Counsel
<b>MAILING ADDRESS</b>	
LINE	Carolyn E. Knecht
LINE	Motorola, Inc.
LINE	600 North U.S. Highway 45
LINE	Libertyville IL USA 60196
<b>SERIAL NUMBER INFORMATION</b>	
SERIAL NUMBER	78235618
<b>RAM INFORMATION</b>	
RAM SALE NUMBER	828
RAM ACCOUNTING DATE	04/09/2003

78235618

INTERNET TRANSMISSION DATE	Wed Apr 09 13:04:09 EDT 2003
TEAS STAMP	USPTO/BAS-1361822222-20030409130409526135-78235618- 200551f906c6de47dcd8f64dcaa871f0ad-DA-828-20030409130129232154
E-MAIL ADDRESS FOR ACKNOWLEDGMENT	kristen.poggensee@motorola.com

&lt;SERIAL NUMBER&gt; 78235618

&lt;FILING DATE&gt; 04/09/2003

## &lt;DOCUMENT INFORMATION&gt;

&lt;TRADEMARK/SERVICEMARK APPLICATION&gt;

&lt;VERSION 1.24&gt;

## &lt;APPLICANT INFORMATION&gt;

&lt;NAME&gt;

Motorola, Inc.

&lt;STREET&gt;

1303 East Algonquin Road

&lt;CITY&gt;

Schaumburg

&lt;STATE&gt;

IL

&lt;COUNTRY&gt;

USA

&lt;ZIP/POSTAL CODE&gt;

60196

&lt;TELEPHONE NUMBER&gt;

847-523-1633

&lt;FAX NUMBER&gt;

847-523-4348

## &lt;APPLICANT ENTITY INFORMATION&gt;

&lt;CORPORATION: STATE/COUNTRY OF INCORPORATION&gt; Delaware

## &lt;TRADEMARK/SERVICEMARK INFORMATION&gt;

&lt;MARK&gt; NO DRAWING (SOUND MARK)

&lt;TYPED FORM&gt; Yes

~Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended).~

## &lt;BASIS FOR FILING AND GOODS/SERVICES INFORMATION&gt;

&lt;USE IN COMMERCE: SECTION 1(a)&gt; Yes

~The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, or the applicant's predecessor in interest used the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended.~

Applicant attaches one SPECIMEN for each class showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services.

&lt;SPECIMEN&gt; Yes

<SPECIMEN DESCRIPTION> A sound specimen for this application has been submitted separately to the TEAS Help Section.

&lt;INTERNATIONAL CLASS NUMBER&gt; 009

&lt;LISTING OF GOODS AND/OR SERVICES&gt; Two-way radios

<FIRST USE ANYWHERE DATE> 05/06/1991  
<FIRST USE IN COMMERCE DATE> 05/06/1991

**<OPTIONAL INFORMATION>**

<DESCRIPTION OF THE MARK> The mark consists of a tone at 911 Hz played at a cadence of 25ms ON, 25 ms OFF, 25 ms ON, 25 ms OFF, 50 ms ON..

**<ATTORNEY INFORMATION>**

<NAME> Carolyn E. Knecht  
<STREET> 600 North U.S. Highway 45  
<CITY> Libertyville  
<STATE> IL  
<COUNTRY> USA  
<ZIP/POSTAL CODE> 60196  
<FIRM NAME> Motorola, Inc.  
<E-MAIL ADDRESS> carrie.knecht@motorola.com  
<AUTHORIZE E-MAIL COMMUNICATION> Yes  
<TELEPHONE NUMBER> 847-523-5876  
<FAX NUMBER> 847-523-4348  
<ATTORNEY DOCKET NUMBER> TM03-1006  
<OTHER APPOINTED ATTORNEY(S)> Arch M. Ahern

**<FEE INFORMATION>**

<TOTAL FEES PAID> 335  
<NUMBER OF CLASSES PAID> 1  
<NUMBER OF CLASSES> 1

**<LAW OFFICE INFORMATION>**

~The USPTO is authorized to communicate with the applicant's attorney at the below e-mail address~

<E-MAIL ADDRESS FOR CORRESPONDENCE> carrie.knecht@motorola.com

**<SIGNATURE AND OTHER INFORMATION>**

~The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in

78235618

commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.~

<SIGNATURE> /cek/  
<DATE> 04/09/2003  
<NAME> Carolyn E. Knecht  
<TITLE> Senior Trademark Counsel


<MAILING ADDRESS>  
<LINE> Carolyn E. Knecht  
<LINE> Motorola, Inc.  
<LINE> 600 North U.S. Highway 45  
<LINE> Libertyville IL USA 60196

<SERIAL NUMBER INFORMATION>  
<SERIAL NUMBER> 78235618

<RAM INFORMATION>  
<RAM SALE NUMBER> 828  
<RAM ACCOUNTING DATE> 04/09/2003  
<INTERNET TRANSMISSION DATE> Wed Apr 09 13:04:09 EDT 2003  
<TEAS STAMP>  
USPTO/BAS-1361822222-20030409130409526135-78235618-  
200551f906c6de47dcd8f64dcaa871f0ad-DA-828-20030409130129232154  
E-MAIL ADDRESS FOR ACKNOWLEDGMENT> kristen.poggensee@motorola.com

Internet Transmission Date:  
2003/04/09

Serial Number:  
78235618




Filing Date:  
2003/04/09

TRADEMARK APPLICATION

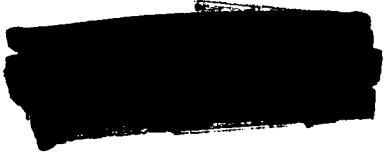
U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE  
FEE RECORD SHEET

TOTAL FEES PAID: \$335

RAM SALE NUMBER: 828  
RAM ACCOUNTING DATE: 04/09/2003



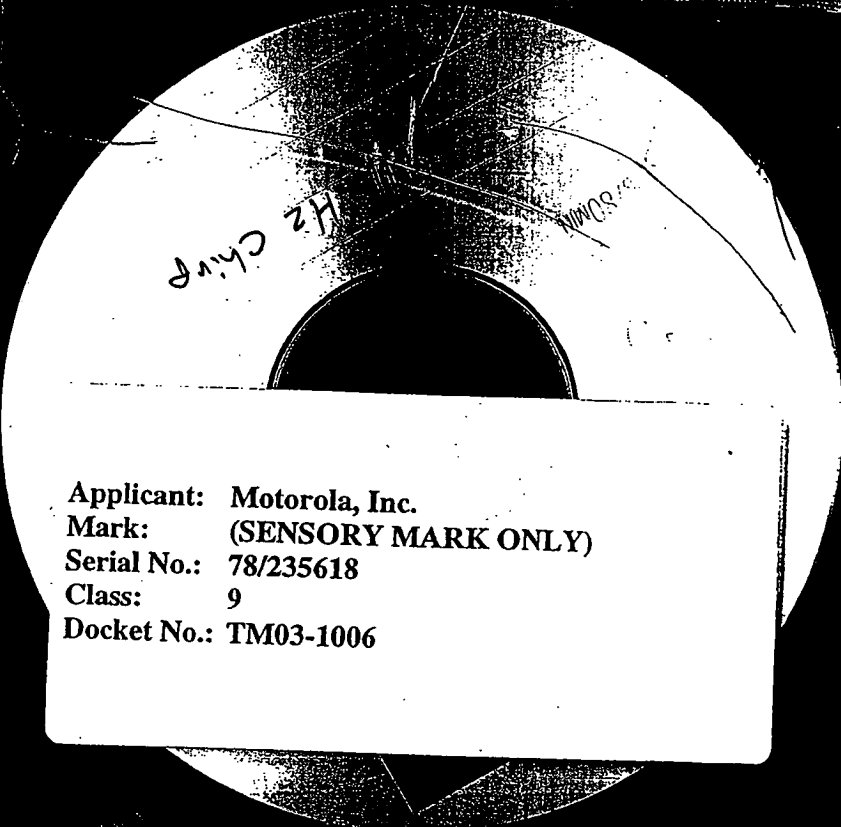
NO OCR



04-09-2003

Nextel - 0010022  
Opp. No. 91/161,817





Handwritten on the CD: "H2 chip" and "80MM".

Applicant: Motorola, Inc.  
Mark: (SENSORY MARK ONLY)  
Serial No.: 78/235618  
Class: 9  
Docket No.: TM03-1006

**Drawing Page**

**Serial Number:**

78235618

**Applicant:**

Motorola, Inc.  
1303 East Algonquin Road  
Schaumburg IL USA 60196

**Date of First Use:**

05/06/1991

**Date of First Use in Commerce:**

05/06/1991

**Goods and Services:**

Two-way radios

**Mark:**

NO DRAWING (SOUND MARK)

PUBLISHED

2/24/04

Nextel - 0010024  
Opp. No. 91/161,817

**Drawing Page**

**Serial Number:**

78235618

**Applicant:**

Motorola, Inc.  
1303 East Algonquin Road  
Schaumburg IL USA 60196

**Date of First Use:**

05/06/1991

**Date of First Use in Commerce:**

05/06/1991

**Goods and Services:**

Two-way radios

**Mark:**

NO DRAWING (SOUND MARK)

PUBLISHED  
2/24//04

NO OCR

04-09-2003

Nextel - 0010025  
Opp. No. 91/161,817

# EXHIBIT 7

Nextel Communications, Inc., Opposer, v. Motorola, Inc., Applicant  
Opposition No.: 91/161,817  
Application No.: 78/235,618  
Mark: Sensory Mark (911 Hz Tone)

Exhibit 7 in Support of Applicant's Motion for Summary Judgment

# EXHIBIT 8

Nextel Communications, Inc., Opposer, v. Motorola, Inc., Applicant  
Opposition No.: 91/161,817  
Application No.: 78/235,618  
Mark: Sensory Mark (911 Hz Tone)

Exhibit 8 in Support of Applicant's Motion for Summary Judgment

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Nextel Communications, Inc.,	)	
	)	
Opposer,	)	
	)	Opposition No. 91161817
v.	)	
	)	
Motorola, Inc.,	)	App. No. 78/235,618
	)	
Applicant.	)	SENSORY MARK (911 Hz Tone)

**APPLICANT'S FIRST NOTICE OF DEPOSITION  
OF OPPOSER PURSUANT TO FED.R.CIV.P. 30(B)(6)**

Please take notice that on March 14, 2005, beginning at 9:00 a.m. at the offices of Brinks Hofer Gilson & Lione, 455 North Cityfront Plaza Drive, Suite 3600, Chicago, IL 60611, or at another location that is mutually agreeable to the parties, and continuing thereafter from day to day until completed, Applicant will take the deposition of Opposer pursuant to Rule 30(b)(6) of the Federal Rules of Civil Procedure on each Deposition Category listed below. The deposition will be transcribed by videotape and/or certified short-hand reporter.

Opposer is requested to designate to Applicant's counsel, on or before March 7, 2005, the person(s) whom Opposer is designating in response to each Deposition Category.

For purposes of this Notice, "Applicant's Mark" means the mark that is the subject of Application No. 78/235,618.

**DEPOSITION CATEGORIES**

1. The facts on which Opposer bases its contention that Applicant has not used Applicant's Mark in commerce in connection with two-way radios (§ 9 of Notice of Opposition).



2. The facts on which Opposer bases its contention that Applicant's Mark is not inherently distinctive in connection with two-way radios (§ 10 of Notice of Opposition).

3. The facts on which Opposer bases its contention that Applicant's Mark has not acquired distinctiveness in connection with two-way radios (§ 10 of Notice of Opposition).

4. The facts in which Opposer bases its contention that it will be damaged if Applicant's Mark is registered (§ 11 of Notice of Opposition).

5. The types of individuals and the classes of consumers or entities who purchase or use two-way radios that emit Applicant's Mark or any mark similar thereto.

6. Every opinion that Opposer has received, from legal counsel or otherwise, relating to Applicant's Mark, including but not limited to any opinion on whether Applicant has used the Mark, whether the Mark is inherently distinctive, or whether the Mark has acquired distinctiveness.

7. How and to whom Opposer's and Applicant's two-way radios are marketed, promoted, sold, and distributed.

8. Opposer's first knowledge of Applicant's Mark, of Applicant's use of the Mark in connection with two-way radios, and of Application No. 78/235,618.

9. Any instance in which a person has been, or may have been, confused as to the source of Applicant's two-way radios or for any service provided by Applicant in connection with such radios.

10. The types of individuals or entities, or the classes of consumers or entities, who purchase or use two-way radios that emit Applicant's Mark or any mark similar thereto.

11. Opposer's yearly sales volume (in units, dollars, and number of purchasers) of two-way radios.

12. Each entity from whom Opposer purchases or has purchased two-way radios.

13. Advertisements or promotional items that includes Applicant's Mark, including any such advertisements or promotional items that are used by, on behalf of, or for the benefit of Opposer, and the yearly amount spent for each advertisement or promotional item.

14. Opposer's use of Applicant's Mark in Opposer's advertisements or promotional items.

15. The development or drafting of advertisements or promotional items that use Applicant's Mark, whether the advertisement or promotional item was ever distributed, displayed, or used.

16. Trademark searches conducted by or on behalf of Opposer for or in connection with Applicant's Mark.

17. Surveys, polls, research, or investigations made conducted by, on behalf of, or for the benefit of Opposer that refer or relate to Applicant's Mark or Applicant's two-way radios that use Applicant's Mark.



18. Any instance in which an individual has been, or may have been, confused as to the source of Applicant's two-way radios or for any service provided by Applicant in connection with such radios.

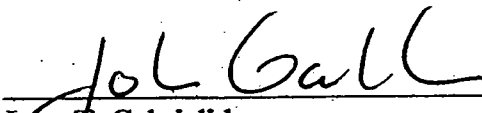
19. The manner in which Opposer markets, promotes, sells, or distributes two-way radios.

20. Opposer's policies and procedures regarding the destruction or retention of documents.

21. Prior and current third-party uses of Applicant's Mark or any mark similar thereto.

Motorola, Inc.

By:

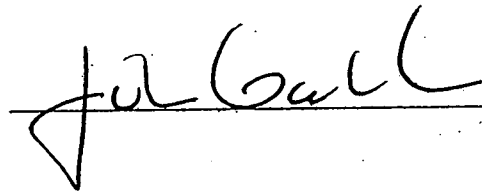
  
\_\_\_\_\_  
John T. Gabrielides  
Elisa M. Valenzona  
BRINKS HOFER GILSON & LIONE  
P.O. Box 10395  
Chicago, IL 60610  
(312) 321 4200  
(312) 321 4299 (fax)

Attorneys for Applicant

**Certificate of Service**

I hereby certify that a true copy of APPLICANT'S FIRST NOTICE OF  
DEPOSITION OF OPPOSER PURSUANT TO FED.R.CIV.P. 30(B)(6) was served on  
Opposer's counsel on March 1, 2005, by sending the document via first class mail, postage  
prepaid, to:

Michael H. Jacobs  
Crowell & Moring LLP  
1001 Pennsylvania Avenue, N.W.  
Washington, DC 20004

\_\_\_\_\_

# EXHIBIT 9

Nextel Communications, Inc., Opposer, v. Motorola, Inc., Applicant  
Opposition No.: 91/161,817  
Application No.: 78/235,618  
Mark: Sensory Mark (911 Hz Tone)

Exhibit 9 in Support of Applicant's Motion for Summary Judgment

CONFIDENTIAL - ATTORNEYS' EYES ONLY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

NEXTEL COMMUNICATIONS, INC., :

Opposer :

v. : App. No. 78/235,618

MOTOROLA, INC., :

Applicant :

**CONFIDENTIAL**  
**ORIGINAL**

Deposition of ALLISON O'REILLY

Washington, D.C.

Tuesday, July 26, 2005

9:05 a.m.

Job No.: 22-60399

Pages 1 - 65

Reported by: Nancy Bond Rowland

**CONFIDENTIAL - ATTORNEYS' EYES ONLY**

**Allison O'Reilly July 26, 2005**

2

1 Deposition of ALLISON O'REILLY, held at the  
2 offices of:

3

4

Crowell & Moring

5

1001 Pennsylvania Avenue, N.W.

6

Washington, D.C.

7

8

Pursuant to agreement, before Nancy Bond

9

Rowland, Registered Professional Reporter and Notary

10

Public in and for the District of Columbia.

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1 A P P E A R A N C E S

2 ON BEHALF OF OPPOSER:

3 MICHAEL H. JACOBS, ESQUIRE

4 WILLIAM J. SAUERS, ESQUIRE

5 CROWELL & MORING

6 1001 Pennsylvania Avenue, N.W.

7 Washington, D.C. 20004

8 (202) 624-2500

9

10 ON BEHALF OF APPLICANT:

11 THOMAS M. WILLIAMS, ESQUIRE

12 BRINKS, HOFER, GILSON & LIONE

13 NBC Tower - Suite 3600

14 455 N. Cityfront Plaza Drive

15 Chicago, IL 60611-5599

16 (312) 321-4200

17

18 ALSO PRESENT: Cindy Lin

19

20

21

22

23

24

25

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2	EXAMINATION OF ALLISON O'REILLY	PAGE
3	By Mr. Williams	5
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6	E X H I B I T S	
7	(Attached to the Transcript)	
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10	2 - Applicant's First Notice of Deposition.	17
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1 PROCEEDINGS

2 ALLISON O'REILLY

3 having been duly sworn, testified as follows:

4 EXAMINATION BY COUNSEL FOR APPLICANT

5 BY MR. WILLIAMS:

6 Q Good morning, Miss O'Reilly. I'm Tom  
7 Williams. I'm here on behalf of Motorola.

8 Could you please state your name for the  
9 record?

10 A Allison Scherry O'Reilly.

11 Q Do you have any maiden names or other names  
12 you've gone by over the years?

13 A My maiden name is Scherry.

14 Q Okay. What's your address?

15 A Home?

16 Q Yes.

17 A 1178 Randolph Road, McLean, Virginia 22101.

18 Q And your business address?

19 A 2003 Edmund Halley Drive, Reston, Virginia  
20 20191.

21 Q Have you ever testified at a deposition  
22 before?

23 A I have not.

24 Q Have you ever testified at a trial before?

25 A I have not.



1 Q Is there any reason why you cannot give  
2 truthful and accurate testimony here today?

3 A Absolutely not.

4 Q Do you have a college degree?

5 A Yes.

6 Q From what school?

7 A University of Maryland.

8 Q In what year did you receive that?

9 A 1982.

10 Q What was your major?

11 A Marketing.

12 Q Did you have any minors?

13 A No.

14 Q Do you have any graduate degrees?

15 A I do not.

16 Q Who is your current employer?

17 A Nextel Communications.

18 Q And what is your current job title?

19 A Director - promotions and retail marketing.

20 Q How long have you had that title?

21 A Since last June of 2004.

22 Q What do your job duties entail in that  
23 position?

24 A I am responsible for all offer-driven  
25 advertising. Underneath the people who work for me

1 manage packaging, collateral, point of purchase  
2 materials, promo television, radio.

3 Q Who is your supervisor?

4 A Mary Matthews.

5 Q And what's her title?

6 A Vice-president - mass marketing  
7 communications.

8 Q Does she have the same business address as  
9 you?

10 A Yes.

11 Q Offer-driven advertising you mentioned?

12 A Yes.

13 Q Can you explain that?

14 A Sure. Anything that has a price point in it  
15 as opposed to brand marketing.

16 Q Are you involved in brand marketing at all?

17 A Not per se other than it's within the same  
18 group.

19 Q Who works with brand marketing in your group?

20 A Right now the person has left the company, so  
21 it's Mary Matthews.

22 Q You referred to collateral materials. What  
23 was that?

24 A Brochures, electronic collateral.

25 Q What's an example of electronic collateral?

1 A An e-flier that's posted online that someone  
2 can download and customize with their call to action.

3 Q Where online would that be placed?

4 A We have a site from Nextel that's called  
5 inc and snc, and our indirect dealers can get it or our  
6 sales force can get it. They're customizable, again  
7 downloadable fliers.

8 Q Is there audio and video in those fliers?

9 A No.

10 Q Just video?

11 A No. It's actually just a printout.

12 Q Printed text?

13 A Yes.

14 Q Images?

15 A Yes.

16 Q What did you refer to when you mentioned  
17 point of purchase advertising?

18 A POP in a store environment, the posters and  
19 banners and so forth that are used within a Nextel  
20 retail store or authorized representative.

21 Q And promotional television and radio, is that  
22 simply TV and radio advertising?

23 A Yes. Promotional television is when there's  
24 a call to action. Again, there's a telephone number, a  
25 price point versus brand advertising that is more about

1 the brand itself.

2 Q What would be an example of call to action  
3 advertising?

4 A Call a certain 800 number, visit Nextel.com  
5 or visit a store near you.

6 Q Would that be for say a limited time offer?

7 A Sure. Yes.

8 Q What other types of call to action  
9 advertising would there be?

10 A That's mostly it. They're done monthly,  
11 quarterly, promoting the latest offer available.

12 Q Prior to accepting your position as director  
13 of promotions and retail marketing, did you have any  
14 other previous positions within Nextel?

15 A Absolutely.

16 Q And working backwards from your present  
17 position, what positions have you held?

18 A Prior to becoming director I was senior  
19 manager of advertising, and I was responsible for again  
20 the point of purchase materials in store as well as all  
21 advertising to support the purchase of our Nextel  
22 retail stores and the media plans for that.

23 Q When did you hold that position?

24 A Probably from 19 -- I'm sorry -- 2002 to  
25 2004, maybe 2001 to 2004.

1 Q Prior to senior marketing --

2 A Manager.

3 Q -- manager of advertising, any positions in  
4 Nextel prior to that?

5 A Yes. I was manager of trade shows, and I  
6 also developed collateral packaging, user guides, and I  
7 started with Nextel in December of 1997.

8 Q So you held that position from approximately  
9 '97 to 2000?

10 A I did trade shows and advertising for  
11 probably maybe a year and a half, two years, and then  
12 prior to that I did collateral and packaging when I  
13 joined.

14 Q When did you start with Nextel?

15 A December '97.

16 Q Where were you prior to Nextel?

17 A I worked at a marketing firm in Boston.

18 Q What was the name of that firm?

19 A Irma Mann, M-a-n-n, Strategic Marketing.

20 Q Did you go there from college?

21 A No. I went there after I started my career  
22 at MCI, and then I moved to Boston, and I worked at ITT  
23 Sheraton Hotels for two years. They had a layoff, and  
24 I went to work for an advertising agency which was Irma  
25 Mann Strategic Marketing.

1 Q How long were you with MCI?

2 A ~~Seven~~  
~~Eight~~ years, 1982 to 1989.

3 Q What positions did you hold there?

4 A Various marketing, advertising, sales support  
5 roles.

6 Q What did you do to prepare for today's  
7 deposition?

8 MR. JACOBS: I'll caution you, Miss O'Reilly,  
9 not to divulge any communications with counsel, but  
10 otherwise you can answer.

11 A Really just reviewed what I have -- what I'm  
12 aware of from a Nextel perspective.

13 Q Other than the lawyers, who did you speak  
14 with?

15 A I spoke to someone in our competitive  
16 intelligence group.

17 Q And who was that?

18 A Dennis Newton and Milan ~~Detweiler~~ <sup>Detweiler</sup>.

19 Q You spoke with those two individuals?

20 A Yes.

21 Q Anyone else?

22 A No.

23 Q Where is the competitive intelligence group  
24 located?

25 A Same address as me.

1 Q What does the competitive intelligence group  
2 do?

3 A They do a lot of tracking of information and  
4 research.

5 Q What sort of information and research?

6 A Tracking of advertising spent, current  
7 advertising, and marketing initiatives.

8 Q Because it's called competitive intelligence,  
9 I'm assuming it relates to competitors, is that  
10 correct?

11 A Yes.

12 Q Which competitors would that be?

13 A Carriers.

14 Q Can you give me some examples of carriers?

15 A Verizon, T-Mobile, Cingular.

16 Q Any hardware manufacturers?

17 A No.

18 Q Anything involving Motorola?

19 A No.

20 Q Why did you speak with them?

21 A I wanted to reconfirm exactly what they  
22 tracked to confirm that it was just carrier specific.

23 Q Did you exchange any correspondence, any  
24 e-mails with Mr. Newton or Mr. <sup>Detweiler</sup>~~Detwiler~~?

25 A No.

1 Q Telephone conversation?

2 A No.

3 Q In-person?

4 A Yes.

5 Q Did you take any notes?

6 A No.

7 Q How long was that conversation?

8 A 10, 15 minutes.

9 Q Did you review any documents?

10 A No.

11 Q How about backing up in preparing for today's  
12 deposition, did you review any documents?

13 A Just what was presented.

14 Q By your lawyer?

15 A Yes.

16 Q Do you recall what those were?

17 A The deposition document, my document with my  
18 name on it. I don't recall what that's called. And  
19 one other document that, I'm sorry, I don't recall.

20 Q Do you recall if it had a caption from this  
21 case on it?

22 A I believe it did.

23 Q Did you sign a release or any paperwork  
24 relating to a protective order in this case?

25 A I did not.



1 Q Did you review your files in preparing for  
2 today's deposition?

3 A What is my files?

4 Q Any files that you maintain in your office.

5 A I didn't have anything per se to review.

6 Q Did you give any documents to the lawyers?

7 A I did.

8 Q Do you recall what you gave them?

9 A Trade show information.

10 Q Anything else?

11 A And some names of some other people.

12 Q Do you recall those names?

13 A I don't off the top of my head.

14 Q Were they other Nextel employees?

15 A Yes.

16 Q Were they people in your group?

17 A Some, yes.

18 Q What type of trade show information did you  
19 give them?

20 A Trade shows that we attend as a company.

21 Q Were they brochures from the trade shows?

22 A No. They were just a list of trade shows, a  
23 calendar so to speak.

24 Q A calendar prepared by Nextel?

25 A Yes.

1 Q Do you recall which trade shows would have  
2 been listed on that calendar?

3 A It was the entire calendar, so it could have  
4 been transportation shows, any vertical markets that we  
5 support, manufacturing.

6 Q What was the time period for that calendar?

7 A I believe it was the last few years.

8 Q And when did you give that document to your  
9 lawyers?

10 A The spring of this year, March perhaps.

11 Q 2005?

12 A Yes.

13 Q Are you aware of Nextel's deposition of Mr.  
14 Klein for Motorola that occurred last week?

15 A I'm aware one occurred.

16 Q Who informed you of that?

17 A My lawyer.

18 Q Did you discuss it with anyone else?

19 A Absolutely not.

20 Q Did you read a copy of the transcript of that  
21 deposition?

22 A I did not.

23 Q Did you read any excerpts from that  
24 deposition?

25 A Nothing.

1 Q Any summaries?

2 A Nothing.

3 Q Did you exchange any e-mails or  
4 correspondence with the lawyers about that deposition?

5 A Nothing.

6 Q Did you watch a video of it?

7 A No.

8 MR. WILLIAMS: I'm going to mark this as the  
9 first exhibit.

10 (Deposition Exhibit 1 was marked for  
11 identification and was attached to the transcript.)

12 BY MR. WILLIAMS:

13 Q This is Applicant's Notice of Deposition of  
14 Miss Allison O'Reilly. Have you seen this document  
15 before?

16 A I believe I saw this yesterday.

17 Q This has been marked as Exhibit 1. Did you  
18 discuss it with anyone?

19 A No.

20 Q Did you discuss it with the lawyers?

21 A It wasn't really discussed. It was just  
22 presented, and I reviewed it.

23 Q By fax or e-mail?

24 A Face-to-face.

25 MR. WILLIAMS: I'm going to mark the second

1 exhibit. This will be Exhibit Number 2.

2 (Deposition Exhibit 2 was marked for  
3 identification and was attached to the transcript.)

4 BY MR. WILLIAMS:

5 Q This is Applicant's First Notice of  
6 Deposition of Opposer Pursuant to Federal Rule of Civil  
7 Procedure 30(b)(6). Have you seen this document  
8 before?

9 A I believe this is the document that I saw,  
10 yes.

11 Q When did you first see this?

12 A Sometime probably in March of 2005.

13 Q At the bottom of the first page you'll see a  
14 caption Deposition Categories. Do you see that?

15 A Yes.

16 Q Could you briefly review the paragraphs  
17 numbered 1 through 21.

18 A Yes.

19 Q Have you been designated to testify in  
20 Nextel's behalf with respect to each of these  
21 paragraphs?

22 A Yes.

23 Q Have you discussed these categories with  
24 anyone?

25 A No, other than the lawyers.

1 Q When did you have those discussions?

2 A Again, starting in March of 2005.

3 Q Did you do any research to prepare to testify  
4 in these categories?

5 A Again, I spoke to the competitive  
6 intelligence team, but other than that, just knowledge  
7 that I'm aware of.

8 Q Did you specifically refer to any documents  
9 in response to these 21 paragraphs?

10 A No.

11 Q You had conversations with the competitive  
12 intelligence people and the lawyers?

13 A Yes. If I had a question or something that I  
14 was not the expert at, I did reach out, but again did  
15 not share why I was looking for that information.

16 Q Who did you reach out to?

17 A The trade show team to gather the trade show  
18 information.

19 Q Anyone else?

20 A I don't believe so.

21 Q How about sales and advertising numbers, did  
22 you reach out to anyone to discuss those topics?

23 A Well, sales are not within my team. Yes, I  
24 did. I reached out to someone in finance, Janine  
25 Rubitski.

1 Q Did you have any correspondence with Janine?

2 A No correspondence other than a verbal request  
3 for it.

4 Q Did she give you any documents in response to  
5 that request?

6 A She sent an e-mail, yes.

7 Q What was contained in that e-mail?

8 A Units sold and revenue for the past three or  
9 four years.

10 Q When you say units sold --

11 A Handsets.

12 Q Handsets. Do you recall which models?

13 A It was all models and then a separate  
14 category for BlackBerry.

15 Q You said you spoke with someone on the trade  
16 show team, is that correct?

17 A It was just a verbal request asking for the  
18 trade shows, trade show schedule.

19 Q Who was that?

20 A I believe it was Andy <sup>Birkenstock</sup>~~Berkenstock~~. He's one  
21 of the people on the trade show team.

22 Q Anyone else?

23 A No. I did speak with the agency to gather  
24 spending on advertising per se.

25 Q What agency would that be?

1 A It was MindShare.

2 Q Did they give you any documents?

3 A They did.

4 Q What did those documents contain?

5 A Media spend by year.

6 Q Media spend for what products?

7 A Oh, again it's just Nextel in general. We  
8 don't categorize by product.

9 Q Does Nextel use any other advertising  
10 agencies other than MindShare?

11 A MindShare is our media agency. We have  
12 Chiat/Day which is our creative agency.

13 Q Did you speak with anyone from that agency?

14 A I did not.

15 Q Can you think of anyone else you would have  
16 spoke to or reached out to other than the sales and  
17 finance people, the trade show team, and the MindShare  
18 people?

19 A I may have reached out to the public sector  
20 team to understand their attendance at any shows which  
21 may not have been captured under trade shows.

22 Q Did you speak with the public sector team  
23 about anything other than trade shows?

24 A I did not.

25 Q Who did you speak to at the public sector

1 team?

2 A I believe it was Diana Bibb.

3 Q Is she at the same address?

4 A She is.

5 Q Did she give you any correspondence, any  
6 printed materials?

7 A A list of shows that we attend, that she  
8 attends.

9 Q Do you recall how far back that list  
10 stretched?

11 A I believe it was for the last two years.

12 Q Did you speak with her about anything other  
13 than the trade shows?

14 A I did not.

15 Q Did you ask her whether Motorola was at these  
16 trade shows?

17 A I did not.

18 Q Did you discuss Motorola with her at all?

19 A I did not.

20 Q When did you have that conversation with Miss  
21 Bibb?

22 A Most likely it was in the March time frame as  
23 well.

24 Q Is she still with the company to your  
25 knowledge?



1 A Yes.

2 MR. WILLIAMS: I'm going to mark another  
3 exhibit. This will be Exhibit 3.

4 (Deposition Exhibit 3 was marked for  
5 identification and was attached to the transcript.)

6 BY MR. WILLIAMS:

7 Q This is the Notice of Opposition. Have you  
8 seen this document before?

9 A I believe I have, yes.

10 Q When did you see this?

11 A Today.

12 Q Did you discuss it with anyone other than the  
13 lawyers?

14 A I did not.

15 Q Let me draw your attention to paragraph 1.  
16 Could you read that to yourself, and let me know when  
17 you're done.

18 A Yes.

19 Q What is meant by dispatch communications  
20 services?

21 A It's referred to as a two-way radio.

22 Q Now, what services would Nextel provide in  
23 relation to a two-way radio?

24 A Nextel Direct Connect walkie-talkie service.

25 Q What is that?

1 A It's the walkie-talkie that's built into  
2 every phone.

3 Q How does Nextel provide those services?

4 A It's built into every phone, and it's our key  
5 differentiator.

6 Q What do you mean by key differentiator?

7 A It's what makes Nextel different from other  
8 carriers and why most people choose Nextel.

9 Q Where are those products purchased?

10 A Through a variety of channels: direct sales,  
11 stores, web, telesales, authorized representatives,  
12 dealers.

13 Q How many Nextel products would carry the  
14 Direct Connect walkie-talkie service currently?

15 A Every handset that we sell, including the  
16 BlackBerry by <sup>RIM</sup> ~~REM~~.

17 Q Can you ballpark how many different products  
18 that would be?

19 A It varies by year and how many we launch. I  
20 believe now we may have 12 or 14 handsets out, but  
21 again it fluctuates based on when phones are launched.

22 Q So if a consumer purchases one of these  
23 Nextel Direct Connect walkie-talkie products, are they  
24 automatically hooked up with the network at the time of  
25 purchase?

1 A Well, it's also a cellular phone with a  
2 walkie-talkie built in and, yes, the phone comes with  
3 it. If they so choose a plan with a walkie-talkie,  
4 which most do, most of our plans have the service in  
5 there, they use the walkie-talkie service.

6 Q In paragraph 1 referring to Nextel, it says  
7 currently has over 12 million subscribers to its  
8 services nationwide. Of that 12 million how many would  
9 relate to the dispatch communications as opposed to the  
10 cellular telephone customers?

11 A Well, there are now 17 million. I really  
12 can't say. I would say that almost all of our  
13 subscribers use the walkie-talkie service as well as  
14 cellular.

15 Q So when you say the walkie-talkie service,  
16 would that refer to the dispatch communication service?

17 A Yes, but they also use cellular.

18 Q Can you use dispatch communication services  
19 without using cellular services?

20 A You can select a plan that turns off  
21 cellular, yes, but most customers don't, but there  
22 could be certain businesses that only want their  
23 customers or their employees, so to speak, to use  
24 dispatch with a two-way radio.

25 Q Can you think of any examples of businesses

1 that have chosen that option?

2 A It could be landscapers whose employers only  
3 want them to use the dispatch and not cellular to drive  
4 up the phone bills. It could be public sector. I  
5 really don't know. I'm not familiar.

6 Q I draw your attention to paragraph 2, if you  
7 would please read that to yourself and let me know when  
8 you're finished.

9 A Okay.

10 Q Does Motorola manufacture products for use  
11 with Nextel's dispatch services?

12 A Yes.

13 Q Which products?

14 A Again, all handsets.

15 Q Do any other manufacturers manufacture these  
16 handsets?

17 A No. There's a BlackBerry that has the  
18 two-way radio in it as well, and that's manufactured by

19 <sup>RIM</sup>  
~~REM.~~

20 Q Anyone other than Motorola or <sup>RIM</sup> ~~REM~~?

21 A Not for Nextel, no.

22 Q Who purchases these types of products?

23 A Can you clarify? From a customer's  
24 standpoint?

25 Q Yes.

1 A Anyone. It could be individuals, businesses,  
2 Fortune 500 companies. A variety of companies use  
3 Nextel.

4 Q And those same entities would also be the end  
5 users?

6 A Sure.

7 Q How long is the longstanding relationship  
8 referred to in paragraph 2?

9 A Well, I've been at Nextel since 1997, so it  
10 goes back I would say at least nine years ~~prior to me~~,  
11 but again I can't answer that with an exact date.

12 Q Please read paragraph 3 to yourself, and let  
13 me know when you've finished.

14 A Okay.

15 Q Who are the direct competitors referred to in  
16 paragraph 3?

17 A My assumption is they make phones for  
18 Verizon. They make some phones for Sprint and most  
19 likely other carriers. Those are the two that I know.

20 Q Verizon and Sprint would be considered  
21 competitors of Nextel?

22 A Yes.

23 Q Will you please read paragraph 4, and let me  
24 know when you've finished.

25 A Okay.

1 Q Do you understand what's meant by the 911  
2 tone application?

3 A I understand it's a tone, yes.

4 Q Do you understand it to be a tone claimed by  
5 Motorola to be a trademark in its filings with the  
6 Patent and Trademark Office?

7 A Yes.

8 Q Do you understand that Nextel has opposed  
9 that trademark application?

10 A Yes.

11 Q Now, the goods identified in that application  
12 referred to as two-way radios, what do you understand  
13 two-way radios to be?

14 A Two-way radios could be a true two-way radio  
15 or two-way radios could be a two-way radio that's built  
16 into every Nextel handset that we sell.

17 Q What do you mean when you say a true two-way  
18 radio?

19 A Two-way radio without cellular.

20 Q Does Nextel offer a true two-way radio?

21 A Not that I'm aware, no.

22 Q Are you aware of any Motorola true two-way  
23 radios?

24 A I'm aware Motorola has two-way radios, yes.

25 Q Do all Nextel cellular telephones have the

1 Direct Connect walkie-talkie service feature?

2 A Yes.

3 Q Have you heard the 911 tone that's referred  
4 to in that trademark application?

5 A I have not.

6 Q Do you understand what that tone is?

7 A I understand it's a tone, but I've never  
8 heard it, so I don't know.

9 Q Have you seen a Motorola two-way radio?

10 A Perhaps when I was down at Plantation, but  
11 not really a focus.

12 Q Have you seen one in operation?

13 A Perhaps I have just in general, but not one  
14 that was demonstrated per se directly to me.

15 Q So you've never heard the tone --

16 A No.

17 Q -- that emanates from that phone?

18 A No.

19 MR. JACOBS: You're referring to the two-way  
20 Motorola radios?

21 MR. WILLIAMS: Correct.

22 MR. JACOBS: Okay.

23 A No.

24 Q Does the Nextel Direct Connect walkie-talkie  
25 service emit any tones?

1 A Yes, it does.

2 Q How would you describe those tones?

3 A The Nextel chirp.

4 Q Do you have any other description of the  
5 Nextel chirp?

6 A No.

7 Q Do you know technically in terms of frequency  
8 what level that chirp is produced?

9 A I believe it's an 1800, but other than that  
10 we refer to it as the Nextel chirp. It's what you hear  
11 when you initiate a Direct Connect call.

12 Q How do you initiate a Direct Connect call?

13 A You hit the Alert button, a number is  
14 programmed in, you press the <sup>Button</sup>Alert, and it chirps.

15 Q Does the Nextel product make any other noises  
16 other than that 1800 chirp?

17 A It makes sounds if a call doesn't go through.  
18 It makes probably sounds when you punch in the buttons.

19 Q Any other sounds you can think of?

20 A Not specifically.

21 Q Going back to the Motorola 911 tone, have you  
22 discussed that tone with any customers or potential  
23 customers?

24 A Absolutely not.

25 Q Have you discussed that tone with anyone at



1 Motorola -- excuse me -- at Nextel?

2 A No.

3 Q Are you aware of anyone at Nextel discussing  
4 Motorola's 911 tone with any customers or potential  
5 customers?

6 A No, but I wouldn't be aware of other groups,  
7 but no one related to me.

8 Q What other groups could that possibly  
9 include?

10 A The only team I could think of was product,  
11 but again they are more focused on new products and not  
12 old products, but again doubtful.

13 Q Any other groups other than product?

14 A No.

15 Q Who is the head of the product group?

16 A ~~Blair~~ <sup>Blair</sup> Kutrow.

17 Q Do you know how to spell that last name?

18 A K-u-t-r-o-w.

19 Q Moving down to paragraph number 5, will you  
20 please read that to yourself, and let me know when  
21 you're finished.

22 A Okay.

23 Q Do you have any reason to doubt that that  
24 claimed first use date is accurate?

25 MR. JACOBS: I'm going to object to the

1 extent this question calls for a legal conclusion.

2 A I'm not aware of anything or have we seen  
3 anything noting use.

4 Q Are you aware of anyone at Nextel who has  
5 looked into that question?

6 A No.

7 Q Moving on to paragraph number 6, will you  
8 read that and let me know when you're finished.

9 A Okay.

10 Q Have you had occasion to read that office  
11 action?

12 A No.

13 Q Paragraph 7 refers to a response to that  
14 office action. Have you had a chance to read that  
15 response to the office action?

16 A No.

17 Q Will you please read paragraph 9, and let me  
18 know when you're finished.

19 MR. JACOBS: 9 you said?

20 MR. WILLIAMS: Yes.

21 A Okay.

22 Q Paragraph 9 states in part "Applicant has not  
23 used the 911 Hz tone in commerce in connection with the  
24 goods listed in the 911 Hz tone application." What is  
25 the factual basis for that statement?

1 MR. JACOBS: Object to the extent it calls  
2 for a legal conclusion, but you can answer.

3 A We've not seen or been made aware of any in  
4 commerce, again I'm following the language here, use in  
5 any marketing or advertising.

6 Q Has Nextel researched that?

7 A Not per se.

8 Q Has Nextel done any market studies on that  
9 topic?

10 A No other than attendance at trade shows or  
11 seen anything that would have been brought to the  
12 attention of the marketing communications group.

13 Q Has Nextel done any focus groups?

14 A No.

15 Q Any customer interviews?

16 MR. JACOBS: This is with respect to the  
17 tone, the 911 hertz tone?

18 MR. WILLIAMS: Correct.

19 A No.

20 Q Any survey work with respect to the 911 tone?

21 A No.

22 Q Have any experts been consulted with respect  
23 to the 911 survey tone?

24 MR. JACOBS: Objection to the extent it calls  
25 for attorney-client or work product communications, but

1 you can answer.

2 A Not that I'm aware, no.

3 Q Are you aware of any documents that relate to  
4 the claim made that applicant has not used the 911 tone  
5 in commerce?

6 A No.

7 Q Any correspondence that you're aware of on  
8 that topic?

9 A No.

10 Q Any e-mails?

11 A No.

12 Q Who would be the person at Nextel that would  
13 have knowledge regarding the trade shows where that 911  
14 tone may have been heard?

15 A Depending upon the market, the vertical  
16 market, if it was public sector, the public sector  
17 team. If it was transportation, the people that are  
18 responsible for transportation. It would vary by the  
19 show type and the product experts there.

20 Q Will you please read paragraph 10, and let me  
21 know when you're finished.

22 A Okay.

23 Q That paragraph states in part "The 911 Hz  
24 tone is not inherently distinctive." What's the  
25 factual basis for that statement?

1 MR. JACOBS: Objection to the extent it calls  
2 for a legal conclusion.

3 A Can you repeat the question?

4 Q What's the factual basis for the statement  
5 that the 911 Hz tone is not inherently distinctive?

6 A We don't know the difference.

7 Q We don't know the difference between what and  
8 what?

9 A I don't know the difference -- I don't know  
10 the sound of that tone.

11 Q What did you mean when you said the  
12 difference?

13 A Between a Nextel chirp and this 911 tone.

14 Q Are you aware of any research done by Nextel  
15 on that question?

16 A No.

17 Q Are you aware of any market studies to  
18 support that claim that the tone is not inherently  
19 distinctive?

20 MR. JACOBS: Objection to the extent it calls  
21 for a legal conclusion.

22 A No.

23 Q Are you aware of any focus groups that have  
24 been conducted on that question?

25 MR. JACOBS: Same objection.

1 A No.

2 Q Are you aware of any customer interviews that  
3 have occurred based on that question?

4 MR. JACOBS: Same objection.

5 A No.

6 Q Are you aware of any consumer survey work  
7 that's been done on that question?

8 MR. JACOBS: Same objection.

9 A No.

10 Q Has Nextel obtained any expert opinions on  
11 that question?

12 MR. JACOBS: Objection to the extent it calls  
13 for a legal conclusion and for work product  
14 information.

15 A No.

16 Q Further in paragraph 10 it states "The 911 Hz  
17 tone is not inherently distinctive and has not acquired  
18 distinctiveness." What is the factual basis for the  
19 statement that the 911 Hz tone has not acquired  
20 distinctiveness?

21 MR. JACOBS: Objection to the extent it calls  
22 for a legal conclusion.

23 A Again, I don't know the difference.

24 Q The difference between?

25 MR. JACOBS: Do you understand the question?

1 A No. I'm sorry. Can you clarify please?

2 Q In paragraph 10 it states that the tone,  
3 referring to the Motorola tone, has not acquired  
4 distinctiveness. I'm asking what the basis for  
5 Nextel's belief for that statement would be.

6 MR. JACOBS: Objection to the extent it calls  
7 for a legal conclusion.

8 A I guess we don't know it's inherently  
9 distinctive.

10 Q The second part to that statement refers to  
11 acquired distinctiveness. Do you know if it has  
12 acquired distinctiveness?

13 MR. JACOBS: Same objection.

14 A Not that I'm aware.

15 Q Has Nextel done any market studies on that  
16 question?

17 MR. JACOBS: Same objection.

18 A Not that I'm aware.

19 Q Has Nextel conducted any focus groups on that  
20 question?

21 MR. JACOBS: Same objection.

22 A Not that I'm aware.

23 Q Has Nextel conducted any customer interviews  
24 on that question?

25 MR. JACOBS: Same objection.

1 A Not that I'm aware.

2 Q Has any survey work been done on that  
3 question?

4 MR. JACOBS: Same objection.

5 A Not that I'm aware.

6 Q Has Nextel consulted with any experts on that  
7 question?

8 MR. JACOBS: Same objection and also an  
9 objection based on work product.

10 A Not that I'm aware.

11 Q Are you aware of any Nextel documents  
12 relating to that question?

13 MR. JACOBS: Objection to the extent it calls  
14 for a legal conclusion and may call for privileged  
15 documents.

16 A Not that I'm aware.

17 Q Moving on to paragraph 11, will you please  
18 read that and let me know when you're done.

19 A Okay.

20 Q Paragraph 11 states that Nextel is a  
21 purchaser and potential purchaser of communications  
22 devices incorporating two-way radio capabilities from  
23 applicant and other vendors. What would those  
24 communications devices be?

25 A Handsets and/or BlackBerry.



1 Q But the BlackBerry comes from <sup>RIM</sup>~~REM~~, correct?

2 A Correct.

3 Q Who are the other vendors referred to in  
4 paragraph 11?

5 A I can only say the other vendor being <sup>RIM</sup>~~REM~~.

6 Q And again, that's the BlackBerry model?

7 A Correct.

8 Q Who are Nextel's three largest customers for  
9 the communications devices referred to in paragraph 11?

10 A I'm sorry, who are our biggest customers?

11 Q Yes.

12 A That we sell handsets to?

13 Q Yes.

14 A I don't know. I'm not in sales. I don't  
15 have that information.

16 Q Who would have that information?

17 A Most likely VP of sales.

18 Q And who is that?

19 A Mark Angelino.

20 Q Paragraph 11 states that Nextel will be  
21 "damaged by the unjustified registration of applicant  
22 of the 911 Hz tone." Do you see that?

23 A Yes.

24 Q What's the factual basis for the claim that  
25 Nextel will be damaged?

1 MR. JACOBS: Objection to the extent it calls  
2 for a legal conclusion. Go ahead.

3 A Nextel uses tones to promote its features and  
4 services, and if Motorola gets the exclusive rights  
5 without showing that they've really used it, then it  
6 prevents Nextel from being able to use those tones in  
7 the future if they so wish.

8 Q When you said that Motorola hasn't used it,  
9 what do you mean by that?

10 A Well, again, we haven't seen usage in  
11 advertising or marketing initiatives promoting the  
12 tone.

13 Q Has Nextel looked for such usage?

14 A Not per se other than what people in certain  
15 departments would have shared with us of any  
16 information.

17 Q I believe you said that Nextel uses tones to  
18 promote its features and services, is that correct?

19 A Yes.

20 Q Which tones would those be?

21 A The Nextel chirp.

22 Q And that was the 1800 chirp you referred to?

23 A Yes.

24 Q And how does Nextel use those tones to  
25 promote its features and services?

1 A With an audible promotional television, brand  
2 television, radio. It's actually part of our tag line  
3 which is shown without the phone itself because it's a  
4 differentiator for us.

5 Q How long has Nextel been doing that?

6 A Since 1997. I'm sorry. 1997, yes.

7 Q The Nextel devices that emit that tone are  
8 manufactured by Motorola, is that correct?

9 A Correct.

10 Q And by <sup>RIM</sup> ~~REM~~?

11 A Yes.

12 Q The BlackBerry device also makes the 1800  
13 tone?

14 A I believe so. It's the same chirp sound.

15 Q Has Nextel conducted any market studies in  
16 connection with its chirp tone?

17 A Not on the chirp per se.

18 Q Has Nextel conducted any focus groups or  
19 consumer interviews relating to the chirp tone?

20 A No.

21 Q Any survey work that you're aware of?

22 A No, not that I'm aware.

23 Q So Nextel promotes its chirp tone through  
24 radio and television advertising?

25 A Brand and promotional television, yes.

1 Q What's the difference between brand and  
2 promotional television?

3 A Again, one has an offer, and one is more  
4 about the Nextel brand in general.

5 MR. WILLIAMS: Let's take a short break.

6 (Recess)

7 BY MR. WILLIAMS:

8 Q Can I draw your attention back to Exhibit 2  
9 please. This is the Notice of Deposition pursuant to  
10 Rule 30(b)(6). Will you please read paragraph 1 to  
11 yourself, and let me know when you're done.

12 A Yes.

13 Q Which facts does opposer base its contention  
14 that Motorola has not used the 911 tone in commerce in  
15 connection with its two-way radios?

16 MR. JACOBS: Objection to the extent it calls  
17 for a legal conclusion.

18 A We would have been in my role within Nextel  
19 and supporting a variety of marketing efforts, had  
20 Motorola been advertising and marketing the tone or the  
21 mark, we would have been made aware from the various  
22 groups, for example, the public sector group.

23 Q If you had to prove today that that tone  
24 wasn't used as a mark, what facts would you rely on?

25 MR. JACOBS: Objection to the extent it calls

1 for a legal conclusion.

2 A Other than it hasn't been brought to my  
3 attention, I haven't seen it in my almost eight years  
4 at Nextel.

5 Q So there's no particular piece of affirmative  
6 evidence that you would rely on?

7 MR. JACOBS: Same objection.

8 A Not that I've been made aware.

9 Q Can you please read number 2, and let me know  
10 when you're done.

11 A Okay.

12 Q Which facts does Nextel base its contention  
13 that Motorola's 911 tone is not inherently distinctive?

14 MR. JACOBS: Same objection.

15 A Can you please clarify?

16 Q Nextel claims that the Motorola 911 tone is  
17 not inherently distinctive. What's the factual basis  
18 for that claim?

19 MR. JACOBS: Same objection.

20 A Again, I'm not familiar with the 911 tone.

21 Q If you had to prove today that that tone was  
22 not inherently distinctive, "you" being Nextel, what  
23 would you rely on?

24 MR. JACOBS: Same objection.

25 A I'm sorry. One more time. If I had to --

1 Q If Nextel had to prove that Motorola's 911  
2 tone was not inherently distinctive, what evidence  
3 would you rely on to support that claim?

4 MR. JACOBS: Same objection.

5 A Again, I don't think I would say listening to  
6 the sound and do people know it's distinctive from a  
7 marketing perspective and reinforcing it.

8 Q Does Nextel have any evidence as to whether  
9 people know it's distinctive?

10 MR. JACOBS: Know what is distinctive?

11 MR. WILLIAMS: The Motorola tone.

12 A I don't believe so.

13 Q Will you please read paragraph number 3, and  
14 let me know when you're done.

15 A Okay.

16 Q Which facts does Nextel base its contention  
17 that Motorola's 911 tone has not acquired  
18 distinctiveness?

19 MR. JACOBS: Objection to the extent it calls  
20 for a legal conclusion.

21 A Again, it's the usage of promoting it so that  
22 people come to learn and understand that tone is  
23 connected.

24 Q And has Nextel studied whether people have  
25 come to learn that that tone is connected to Motorola?

1 A Not that I'm aware.

2 Q Moving on to number 4, will you read that and  
3 let me know when you're finished.

4 A Yes.

5 Q On which facts does Nextel base its  
6 contention that it will be damaged if Motorola's 911  
7 tone is registered?

8 A Again, Nextel uses tones to promote its  
9 features and services, and if Motorola were to get  
10 exclusive rights to this sound, it would prohibit us to  
11 use this sound in the future should we so wish.

12 Q Does Nextel believe those tones are similar,  
13 the Motorola tone and the Nextel chirp?

14 MR. JACOBS: Objection to the extent it calls  
15 for a legal conclusion.

16 A I believe it's the sound in general without  
17 showing usage.

18 Q Well, you're not saying that all sounds sound  
19 similar, are you?

20 A No.

21 Q What is it about this Motorola sound that  
22 troubles you, "you" being Nextel?

23 A I think it's just a sound in general. If  
24 exclusive rights were given to this sound, it would  
25 prohibit us perhaps from using it in the future.

1 Q When you say using it in the future, what are  
2 you referring to?

3 A Well, for example, we use a sound today. We  
4 use a few sounds, mostly the Nextel chirp.

5 Q What other sounds are you referring to other  
6 than the chirp?

7 A There could be a sound in GPS, but the sound  
8 we use most is the Nextel chirp.

9 Q Are there other sounds on the drawing board  
10 to your knowledge?

11 A No.

12 Q Moving on to paragraph 5, will you read that  
13 and let me know when you're finished.

14 A Okay.

15 Q Who do you understand to be the purchasers of  
16 Motorola's products that emit the 911 tone?

17 A I believe it would be the public sector,  
18 police, fire departments.

19 Q How do you know that?

20 A Because you see those people using them.

21 Q Did you talk to anyone about that?

22 A No.

23 Q Are there any Nextel documents that you're  
24 aware of relating to Motorola purchasers for the  
25 two-way radio products?



1 A Not that I'm aware.

2 Q Moving on to paragraph 6, will you read that  
3 paragraph to yourself, and let me know when you're  
4 finished.

5 A Okay.

6 Q Are you aware of any opinion of counsel  
7 relating to Motorola's 911 tone?

8 MR. JACOBS: I'll instruct you not to divulge  
9 any privileged communications.

10 A I'm sorry. I'm not clear of the question.

11 Q Without telling me what it says if it exists,  
12 are you aware of any opinions or memorandums written by  
13 the lawyers relating to Motorola's 911 tone?

14 A No.

15 Q Are you aware of any opinion from any other  
16 expert relating to Motorola's 911 tone?

17 A No.

18 Q Are you aware of any opinion or any comments  
19 from anyone relating to Motorola's 911 tone?

20 A No.

21 Q Will you please read number 7, and let me  
22 know when you're done.

23 A Okay.

24 Q If I understand your previous testimony, you  
25 said that Nextel doesn't make two-way radios, correct?

1 A Correct.

2 Q But the Nextel handsets have that Direct  
3 Connect feature?

4 A Yes. We purchase phones from Motorola that  
5 include a two-way radio.

6 Q Would you call those products a two-way  
7 radio?

8 A No.

9 Q Would you call it a handset?

10 A We call it a handset or a phone that happens  
11 to have other capabilities.

12 Q Does Nextel market their handsets to the  
13 public sector?

14 A Yes.

15 Q How does it do that?

16 A Again, I'm not in sales, but trade shows. We  
17 run ads in magazines, but again I'm not in sales.

18 Q Do you know any particular magazines?

19 A I don't.

20 Q Any particular trade shows?

21 A I don't per se, no.

22 Q Does Nextel have in-house representatives who  
23 would speak with public sector customers?

24 A Salespeople.

25 Q And would they go directly to a public sector

1 purchaser and do a presentation?

2 A Most likely, yes.

3 Q What department are those salespeople in?

4 A They're under most likely the government  
5 sales.

6 Q Who's the head of that department?

7 A Leon Frasier. He's the VP.

8 Q Is he at the same address as you, business  
9 address?

10 A He might be at 2001 Edmund Halley or he might  
11 be at the McLean office, I don't know, but he's in the  
12 Washington, D.C. area.

13 Q Okay. Moving on to paragraph 8, will you  
14 please read that and let me know when you're finished.

15 A Okay.

16 Q When did Nextel first become aware of  
17 Motorola's 911 tone?

18 MR. JACOBS: Mr. Williams, we'll stipulate  
19 here that Nextel first learned of the application  
20 number that's referred to in topic number 8 from  
21 counsel in March of 2004, and I'll ask Miss O'Reilly  
22 not to divulge any communications with counsel  
23 regarding those issues.

24 BY MR. WILLIAMS:

25 Q Other than the communications with counsel,

1 when did Nextel first become aware of the tone itself,  
2 the Motorola 911 tone?

3 A I didn't become aware until speaking with  
4 counsel.

5 Q Apart from yourself as an individual, do you  
6 know when Nextel as a company became aware of that  
7 tone?

8 A I do not.

9 Q Moving on to paragraph 9, will you read that  
10 and let me know when you're finished.

11 A Okay.

12 Q Do you think that it's likely that consumers  
13 would be confused as to the source of a two-way radio  
14 or cellular product based on the chirp sound that it  
15 emits?

16 MR. JACOBS: Objection to the extent it calls  
17 for a legal conclusion and also objection to the use of  
18 the word chirp. Are you referring to the 911 hertz  
19 tone?

20 MR. WILLIAMS: Any tone.

21 A I'm not aware.

22 Q Do you think it's likely that that would  
23 occur?

24 MR. JACOBS: Same objection.

25 A Again, I don't know what the 911 sounds like,

1 so I don't know.

2 Q Is it likely that a consumer would hear a  
3 particular tone emanating from a phone or a two-way  
4 radio product and associate the phone with a particular  
5 source?

6 MR. JACOBS: Same objection.

7 A It's possible, but I don't know.

8 Q What makes you say that it's possible?

9 MR. JACOBS: Same objection.

10 A Again, I have not heard the tone, so I don't  
11 know.

12 Q You've heard the Nextel chirp, correct?

13 A Yes.

14 Q Is it likely that consumers would hear that  
15 chirp and associate that tone with a particular  
16 manufacturer or service provider?

17 A Are we referring to a two-way radio or  
18 referring to a phone?

19 Q Either one.

20 A If it's used in advertising and marketing and  
21 people come to understand its association, it's  
22 possible. Similar to the chirp within the phones that  
23 Nextel sells and how it is referred to as the Nextel  
24 chirp.

25 Q When people hear the Nextel chirp, do they

1 associate that tone with Nextel?

2 A Yes.

3 Q And how do you know that?

4 A Focus groups, people talking.

5 Q Have such focus groups been conducted?

6 A Not per se on that, but focus groups where  
7 Nextel customers are there, that is how they refer to  
8 them.

9 Q Who would have knowledge about those focus  
10 groups and what's gone on?

11 A Dennis Newton.

12 Q And who is Dennis Newton?

13 A He is in charge of research.

14 Q You also mentioned people talking as a source  
15 of that information. What were you referring to when  
16 you said people talking?

17 A Just when you meet other people who have  
18 Nextel, their familiarity with the product. It is  
19 referred to as the Nextel chirp just in casual  
20 conversation in how people refer to their phone.

21 Q Are you aware of any competitor's products  
22 that make a similar chirp noise?

23 MR. JACOBS: Objection to the extent it calls  
24 for a legal conclusion.

25 A Verizon has come out with a handset, but I

1 have not heard their two-way radio sound.

2 Q How about their handset, Verizon's handset,  
3 does that make a chirp?

4 A It makes a sound because it has a  
5 walkie-talkie, but I'm not familiar with that sound.

6 Q Are your competitive intelligence people  
7 looking at that?

8 A I'm sure they are.

9 Q But you haven't heard that sound?

10 A I have not.

11 Q Anyone other than Verizon?

12 A Sprint has a product, and it may make a  
13 sound. I don't know. It has a walkie-talkie feature  
14 in it, but I don't know that sound either.

15 Q Are you aware of any consumer who's been  
16 confused as to the source of a product because of the  
17 sound that it makes?

18 MR. JACOBS: Objection to the extent it calls  
19 for a legal conclusion.

20 A Not that I'm aware of.

21 Q What's Nextel's annual advertising budget?

22 A In the hundreds of millions, \$150 million  
23 perhaps.

24 Q Do you know how that's allocated out  
25 approximately?

1 A What do you mean by allocation?

2 Q A certain amount to trade shows, a certain  
3 amount to radio, a certain amount to television, for  
4 example.

5 A It varies by year. Trade shows are separate.  
6 Media is one group.

7 Q But that would all include the \$150 million?

8 A Yes. Again, I'd have to get accurate  
9 numbers.

10 Q Of that \$150 million, what percentage of that  
11 would be allocated to advertising where the Nextel  
12 chirp would be audible?

13 A Again, I'd have to go back and get accurate  
14 information, but that would include promo television,  
15 brand, and radio which is audible.

16 Q In the Nextel advertising where the 1800  
17 chirp tone is audible, are there any other tones that  
18 are audible?

19 MR. JACOBS: Are you referring to a specific  
20 commercial?

21 MR. WILLIAMS: Any form of advertising that  
22 Nextel uses.

23 A Most of it is focused on the Nextel chirp.  
24 Other products and features might be advertised, but  
25 they perhaps don't come with a sound.



1 Q I think you said that the handsets may make a  
2 tone when buttons are pressed, for example.

3 A Yes.

4 Q Is there any Nextel advertising where those  
5 tones are heard?

6 A Not that I can recall because we don't show a  
7 cellular call being made. We focus on our  
8 differentiators which would be the walkie-talkie.

9 Q Do any of your competitors offer a  
10 walkie-talkie?

11 A Yes.

12 Q Who?

13 A Verizon has a walkie-talkie, and Sprint has I  
14 believe one handset with a walkie-talkie.

15 Q Do you know how many different Nextel  
16 advertisements have played the Nextel chirp?

17 MR. JACOBS: Mr. Williams, I think we're  
18 starting to get off topic here from the 30(b)(6)  
19 notice. I'll let Miss O'Reilly answer a couple more  
20 questions here, but I think we should probably get back  
21 on topic.

22 A I'd have to gather the information. It would  
23 go all the way back to 1997.

24 Q Would you look at paragraph 20, and let me  
25 know when you've read that.

1 A Okay.

2 Q Does Nextel have a document retention policy?

3 A Not that I'm aware.

4 Q Are there any instructions as to how long you  
5 can keep your e-mail?

6 A Not that I'm aware.

7 Q Are you aware of your In boxes being purged  
8 at periodic intervals?

9 A Not that I'm aware.

10 Q Is Nextel aware of any other companies other  
11 than Motorola who use a 911 hertz tone?

12 A Again, not that I'm aware.

13 MR. WILLIAMS: Let's move on to another  
14 exhibit.

15 (Deposition Exhibit 4 was marked for  
16 identification and was attached to the transcript.)

17 BY MR. WILLIAMS:

18 Q We've marked as Exhibit 4 Opposer's Response  
19 to Applicant's First Set of Requests for Production of  
20 Documents and Things. I'll give you a minute to peruse  
21 this, and I'm going to ask you if you've seen this  
22 before?

23 A Okay.

24 Q Have you seen this document before?

25 A I don't believe so.

1 Q Did anyone ask you to look for documents in  
2 connection with this case?

3 A No.

4 MR. WILLIAMS: I'm going to mark the next  
5 exhibit.

6 (Deposition Exhibit 5 was marked for  
7 identification and was attached to the transcript.)

8 BY MR. WILLIAMS:

9 Q I've just marked as Exhibit 5 what was  
10 produced to us by Nextel's lawyers in response to our  
11 request for documents. Have you seen these papers  
12 before?

13 A No.

14 Q Are you aware of any other documents Nextel  
15 intends to produce in response to Motorola's request  
16 for documents?

17 A Not that I'm aware.

18 Q Are you aware of any other documents that  
19 Nextel intends to rely upon in these proceedings?

20 A Not that I'm aware.

21 MR. WILLIAMS: I'm going to mark another  
22 exhibit.

23 (Deposition Exhibit 6 was marked for  
24 identification and was attached to the transcript.)

25 BY MR. WILLIAMS:

1 Q I've just marked as Exhibit 6 Opposer's  
2 Response to Applicant's First Set of Interrogatories.  
3 Can you take a moment to review that please.

4 A Okay.

5 Q Have you seen that document before?

6 A I have seen it but not studied it.

7 Q When did you see that?

8 A When I met with counsel.

9 Q How long ago was that?

10 A April/May time frame.

11 Q April/May of 2005?

12 A Yes.

13 Q Did you assist in preparing Nextel's  
14 responses that are set forth in this document?

15 A No.

16 MR. WILLIAMS: Let's take a short break, and  
17 I think I can wrap this up fairly soon.

18 (Recess)

19 A Before we start, if I may, I think I may have  
20 misspoken on something, and I just wanted to clarify.

21 Q What would that be?

22 A Exhibit 4. You had asked me if I had been  
23 asked to look for any documents. I did, but nothing  
24 was found. So I just wanted to clarify that.

25 Q Exhibit 4 is Opposer's Response to

1 Applicant's First Set of Requests for Production of  
2 Documents and Things?

3 A Yes.

4 Q When were you asked?

5 A Most likely the first time we met which was  
6 March or April of 2005.

7 Q And you were asked by counsel?

8 A Yes, but I did not find any information.

9 Q Did you look for information?

10 A I did.

11 Q Where did you look?

12 A E-mails and just asking a few individuals,  
13 but nothing was found, and my conversations were very  
14 broad, nothing about what I was looking for other than  
15 just questions that were asked face-to-face with  
16 people.

17 Q Who were those people?

18 A Again, the trade show team, the competitive  
19 intelligence group. That was I believe it.

20 Q And you said you didn't locate any documents?

21 A Correct.

22 Q Did those people locate any documents, the  
23 trade show team or the competitive intelligence group?

24 A No. There were no documents found.

25 Q Did you do anything else?

1 A No.

2 Q Which e-mails did you review?

3 A E-mails?

4 Q I thought you said you looked through  
5 e-mails.

6 A Oh, I just looked in my e-mail box, but I did  
7 not have anything related to it because I wasn't aware  
8 of this.

9 Q "This" being?

10 A The 911, until it was brought to our  
11 attention.

12 Q Will you please look at Exhibit 6, paragraph  
13 number 10.

14 A On page 6?

15 Q At the top of page 7 actually.

16 A Exhibit 6?

17 Q Yes.

18 A Right here? Okay.

19 Q Do you see where it says "opposer and  
20 applicant are business partners"?

21 A Yes.

22 Q What's meant by that?

23 A We purchase our phones from Motorola.

24 Q Do you have any factual reason to believe  
25 that Motorola would assert its trademark rights in the

1 911 tone against Nextel?

2 A Sorry. I need clarification.

3 Q Well, you stated that Nextel and Motorola are  
4 business partners. As business partners --

5 MR. JACOBS: The interrogatory response said  
6 that. She didn't state it.

7 BY MR. WILLIAMS:

8 Q As business partners do you have any factual  
9 reason to believe that Motorola would assert its 911  
10 tone against Nextel?

11 A I'm not involved. I really don't have an  
12 answer here.

13 Q But you're not aware of any reason?

14 A I'm sorry. One more time.

15 Q You're not aware of any reason why Motorola  
16 would assert its trademark rights against Nextel in  
17 connection with this 911 tone?

18 A I'm not aware.

19 MR. WILLIAMS: I'm going to mark another  
20 exhibit.

21 (Deposition Exhibit 7 was marked for  
22 identification and was attached to the transcript.)

23 BY MR. WILLIAMS:

24 Q I've just marked as Exhibit Number 7 a  
25 printout from the Patent and Trademark Office

1 electronic database covering the Nextel CHRRRP word  
2 mark. This is serial number 78/547,268. Were you  
3 aware that Nextel filed an application for this word  
4 mark?

5 A No, I was not.

6 MR. JACOBS: Just to make it clear, the mark  
7 that Mr. Williams or the document that Mr. Williams  
8 handed you, the mark is listed as CHRRRP.

9 A I'm not aware.

10 Q You're not aware of this application?

11 A No.

12 Q Do you know whether this mark CHRRRP has been  
13 used by Nextel?

14 A Not that I'm aware in advertising, no.

15 Q Are you aware of any plans to use that mark  
16 in advertising?

17 A I can't say for the future, but at this time  
18 I'm not aware.

19 MR. WILLIAMS: I have nothing further.

20 MR. JACOBS: Okay. Before we go off the  
21 record, I just want to confirm that this will be  
22 designated as Confidential - Attorneys' Eyes Only as  
23 stated in the protective order.

24 (Signature having not been waived, the deposition  
25 of Allison O'Reilly was concluded at 11:15 a.m.)



1 ACKNOWLEDGMENT OF DEPONENT

2 I, Allison O'Reilly, do hereby acknowledge  
3 that I have read and examined the foregoing testimony,  
4 and the same is a true, correct and complete  
5 transcription of the testimony given by me and any  
6 corrections appear on the attached Errata Sheet signed  
7 by me.

8

9

10

(DATE)

(SIGNATURE)

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1 CERTIFICATE OF SHORTHAND REPORTER - NOTARY PUBLIC

2

3

I, Nancy Bond Rowland, Registered

4

Professional Reporter, the officer before whom the

5

foregoing proceedings were taken, do hereby certify

6

that the foregoing transcript is a true and correct

7

record of the proceedings; that said proceedings were

8

taken by me stenographically and thereafter reduced to

9

typewriting under my supervision; and that I am nether

10

counsel for, related to, nor employed by any of the

11

parties to this case and have no interest, financial or

12

otherwise, in its outcome.

13

IN WITNESS WHEREOF, I have hereunto set my

14

hand and affixed my notarial seal this 31st day of July

15

2005.

16

17

18

19

My commission expires:

20

October 31, 2009

21

22

*Nancy Bond Rowland*

23

24

NOTARY PUBLIC IN AND FOR THE

25

DISTRICT OF COLUMBIA

1 E R R A T A S H E E T  
2 IN RE: Nextel v. Motorola  
3

4 RETURN BY: \_\_\_\_\_  
5

6	PAGE	LINE	CORRECTION AND REASON
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25 (DATE) (SIGNATURE)

1 ERRATA SHEET CONTINUED

2 IN RE: Nextel v. Motorola

3

4 RETURN BY: \_\_\_\_\_

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25 (DATE)

(SIGNATURE)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

-----X

NEXTEL COMMUNICATIONS, INC., :

Opposer :

v. : App. No. 78/235,618

MOTOROLA, INC., :

Applicant :

-----X

I, Allison O'Reilly, being first duly sworn, on oath say that I am the deponent in the aforesaid deposition taken July 26, 2005, that I have read the foregoing transcript of the deposition, consisting of pages 1 to 65 inclusive, and affix my signature to same.

\_\_\_\_\_  
Allison O'Reilly

Subscribed and sworn to  
Before me this \_\_\_\_ day of  
\_\_\_\_\_, 2005

\_\_\_\_\_  
Notary Public

CASE: Nextel Communications, Inc. vs. Motorola, Inc.  
DEPONENT: Allison O'Reilly  
DATE TAKEN: July 26, 2005

PAGE      LINE                  ERRATA SHEET

[illegible]

(SIGNED) \_\_\_\_\_ DATE \_\_\_\_\_

REPORTER: Nancy Bond Rowland

LEGALINK – CHICAGO  
230 W. MONROE STREET – SUITE 1500  
CHICAGO, ILLINOIS 60606

August 9, 2005

Allison O'Reilly  
c/o Michael H. Jacobs, Esq.  
Crowell & Moring  
1001 Pennsylvania Ave. N.W.  
Washington, DC 20004

Case: Nextel Communications, Inc. vs. Motorola, Inc.  
Deponent: Allison O'Reilly  
Date Taken: July 26, 2005

Dear Allison O'Reilly:

Enclosed is your copy of the deposition transcript, along with the original signature page and errata sheet.

Pursuant to the court rules in this matter, the transcript is to be read and then signed under penalty of perjury.

If any corrections / changes are to be made, please TYPE or PRINT them on the attached errata sheet, giving the page and line number, desired correction / change, and reason.

Please arrange for accomplishment of same and transmittal of the original signature page and errata sheet back to our office within 30 days from the date of this letter.

Upon failure to comply within 30 days, we shall forward an appropriate affidavit of noncompliance to counsel without further notice.

Very truly yours,

LegaLink – Chicago

Cc: Thomas M. Williams, Esq. @ Brinks, Hofer, Gilson & Lione

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

-----X

NEXTEL COMMUNICATIONS, INC., :

Opposer :

v. : App. No. 78/235,618

MOTOROLA, INC., :

Applicant :

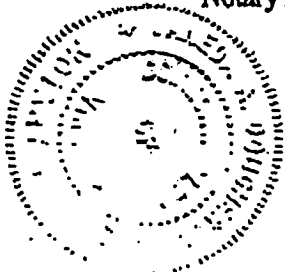
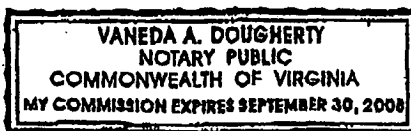
-----X

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Allison O'Reilly  
Allison O'Reilly

Subscribed and sworn to  
Before me this 9 day of  
September, 2005

Vaneda A. Dougherty  
Notary Public





### ERRATA

Deposition of: Allison O'Reilly

I wish to make the following changes for the following reasons:

<u>Page</u>	<u>Line</u>	
✓✓ 11	2	Change: eight - seven Reason: Correction
✓✓ 11	18	Change: Detwiler - Detweiler Reason: Spelling Error
✓✓ 12	24	Change: Detwiler - Detweiler Reason: Spelling Error
✓✓ 19	20	Change: Berkenstock - Birkenstock Reason: Spelling Error
✓✓ 23	16	Change: REM - RIM Reason: Spelling Error
✓✓ 25	19	Change: REM - RIM Reason: Spelling Error
✓✓ 25	20	Change: REM - RIM Reason: Spelling Error
✓✓ 26	10	Change: Delete "prior to me" Reason: Clarification
✓✓ 29	14	Change: Alert - Button Reason: Clarification

Page

Line

✓ 30

16

Change: Blaire - Blair

Reason: Spelling Error

✓ 38

1

Change: REM - RIM

Reason: Spelling Error

✓ 38

5

Change: REM - RIM

Reason: Spelling Error

✓ 40

6

Change: REM - RIM

Reason: Spelling Error

Signed:

*this change  
is on line  
10 and  
line 6.*  
Alison O'Reilly

Dated:

9/9/05